Supreme Court of the United States,

APPEAL FROM THE CIRCUIT COURT FOR NORTHERN DISTRICT OF NEW YORK.

IN EQUITY.

No. 135.

NATHAN C. RUSSELL

v.

SAMUEL DODGE ET AL.

RESPONDENTS' BRIEF.

T. L. WAKEMAN, Counsel.

PHILADELPHIA BAR ASSOCIATION

BOSTON:
ALFRED MUDGE & SON, PRINTERS, 34 SCHOOL STREET.
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The questions involved in this controversy relate wholly to the *first claim* in the patent, as there was no evidence or pretence of an infringement of the *second claim*.

The hearing before the learned judge at the Circuit involved, —

1*st*. The *construction* of the first claim of the patent. The complainant claimed that his patent is for the use of "fat liquor" in a *heated state;* and the defendants claimed that the patent covers and includes the use of "fat liquor," generally, without reference to the condition in which it may be.

2*d*. The *validity* of the patent which was contested by the defendants upon the following ground, to wit: —

(1.) By reason of want of novelty.

(2.) Because the alleged invention had been in public use or on sale in this country for more than two years before the application for a patent, or had

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(1.) By reason of want of novelty.

(2.) Because the alleged invention had been in public use or on sale in this country for more than two years before the application for a patent, or had

been abandoned to the public, and was void under the fifth subdivision of Sect. 61 of the patent law of 1870.

(3.) Because the reissued Letters Patent are void, not having been granted so far as relates to the first claim *for the same invention.*

3*d*. That the specification does not contain the whole truth, but contains more than is necessary to produce the described effect, and conceals the fact established by the evidence, that fat liquor alone had long been used for softening bark-tanned skins, as well known by the patentee, done for the purpose of deceiving the public, which makes the patent void.

Stat. 1870, Ch. 230, Sect. 61.

4*th*. The question of infringement; the defendants claiming *they had not infringed.*

(1.) That if the construction asked by the defendants should be given to the patent, the *evidence of want of novelty* in the alleged invention was overwhelming, and the patent being void, the plaintiff had no rights under it to be infringed.

(2.) And that if the construction claimed by the complainant should be given, the defendants have never infringed by using heated fat liquor which had been heated to or near the boiling point, nor otherwise than they and others had been accustomed to use it for many years prior to the alleged invention of complainant.

The decision and findings on questions of fact of the learned judge who heard the cases at circuit.

1. The Court gave the construction to the patent asked by the defendants, that the patent by its terms covers and includes the use of fat liquor generally, without reference to the conditon in which it may be; "in other words, the

patent secures the exclusive use of fat liquor in any state or condition " for the purpose named in the patent.

Judge Hunt's opinion, pp. 416, 417, 418, 419, 420. marg. from 485 to 492, printed in Record, against Dodge *et al.*

2. Upon the question of *want of novelty* the Court, under the construction given to the patent, found *as a question of fact* that the use of fat liquor in treating bark-tanned skins had been employed by manufacturers, intelligently comprehending its purpose and effect, for many years prior to the complainant's alleged invention, and that the patent as to first claim was void for want of novelty.

Opinion of Judge Hunt, pp. 420, 421, 422, 423, marg. 492 to 497.

3. The Court found as a question of fact that the alleged invention, under the construction given to the patent, had been in public use or on sale in this country for more than two years before the application for a patent, and had been abandoned to the public.

Opinion of Judge Hunt, pp. 423, 424, marg. 498.

4. Upon the question submitted, that the reissued patent is void because it was not for the same invention as the original patent, the Court says " as the points already discussed by me must lead to a decision adverse to the complainant, it is not necessary I should pass upon this point. If the case is taken to a higher tribunal for reconsideration, this with other points will necessarily be passed upon."

Opinion *ante*, p. 424, marg. 498.

5. Upon this question whether the patentee in his specification set forth more than was necessary to produce the required effect, and concealed the fact that fat liquor alone had been used for softening such skins long before his

alleged invention, with his knowledge, for the purpose of deceiving the public, the Court made no finding and gave no opinion.

6. The cases having been thus disposed of by His Honor Judge Hunt, upon the construction of the patent stated, the Court made no finding, and gave no opinion upon *the question of fact* raised by the defendants in the event of a construction being given to the patent as claimed by the complainant, that his patent is for the use of fat liquor in a heated state, having been heated to or near the boiling point, either as to infringement by defendants, or want of novelty in the alleged invention with such construction.

In the light of the state of the art, the evidence and findings of fact in this case, which did not appear in the case of Klein *v.* Russell, in which this Court has given a construction to the patent, we pray for a reconsideration by this Court upon the construction of the patent and to be heard thereon.

I.

The construction. — What is the alleged invention secured by the patent?

1. The patent declares that it is for an "Improvement in the treatment of leather." The patentee states in the specification that he has invented a "new and useful improvement in the preparation of leather," and that his "invention consists in a novel treatment of what is known as bark-tanned lamb or sheep skins;" and claims, —

1st, "The employment of fat liquor in the treatment of leather substantially as specified."

2d, "The process, substantially as described, of treating bark-tanned lamb or sheep skins by means of a compound composed and applied essentially as specified."

2. The *first claim* is for the employment of fat liquor

alone generally, either cold or hot, at any desired temperature, in the state in which it comes from the mill, in the treatment of leather substantially as described.

Booth *v.* Kennard, 1 Hurst & N. p. 527.
O'Reilly *v.* Morse, 15 How. ~~149.~~ 119
Stevens *v.* Keating, 2 Web. Pat. Cas. 172.
Curtis, sec. ~~238.~~ 142 - 3

(1) The patentee states that the principal feature of his invention consists in the *employment of fat liquor*, describing how it is obtained.

(2) Then says, that in treating with fat liquor, it is *desirable*, not essential, to heat it to or near the boiling point.

(3) That it is "*preferred*," not necessary; it is preferred to use the same in connection with other ingredients as stated; and closing with the claim of "the employment of fat liquor" in treating leather.

3. The second claim is the treatment of bark-tanned lamb or sheep skins by means of the *compound* as described.

(1) Under this claim, the heating of the fat liquor which is mixed with the other ingredients as described, to or near the boiling point, is essential.

(*a*) In describing the compound, the patentee says, "there may be added to each ten gallons of *such heated fat liquor*," the other ingredients making up the compound.

(*b*) The manner of applying the fat liquor or the compound is not a material element; it is enough substantially to *saturate* the leather or skins by dipping them into the liquor, or rubbing it into the skin or leather, or otherwise.

4. The *effect* produced upon the leather or skin by either treatment is not the subject of a patent.

Howe *v.* Abbott, 2 Story, 190, 193.
Curtis on Pat. § 56, and notes (3d ed.)

5. And the article produced by the treatment is not patented or claimed as a new article of manufacture.

If a construction should be given to the first claim, that the application of heat to the fat liquor, and the use of the liquor as described while in a heated state, and that such liquor should be heated to or near the boiling point, it must follow, either that it is to be applied at that temperature, *in which case it is pernicious, and will spoil the skin*, and the patent is void for want of utility; or that it must cool before use, in which case *no limit* is made as to the temperature to which it should cool before use. And this must be learned by *experiment* by every operator, and the patent is void for uncertainty and ambiguity.

Wood *v.* Underhill, 5 How. 4.

6. The proportions of such compound are not fixed, but are in all respects indefinite and uncertain, to be ascertained only by trial; and the process of preparing leather by means of such compound is not patentable.

Tyler *v.* Boston, 7 Wal. 327.
Wood *v.* Underhill, 5 How. 1.
Parker *v.* Stiles, 5 McLean, 54.

II.

The reissued Letters Patent are void, because they were not granted for the *same invention* as that embodied in the original Letters Patent.

1. Whenever any patent is inoperative or invalid by reason of a defective or insufficient description or specification, if the error arose by inadvertency, accident or mistake, and without any fraudulent or deceptive intention, it is lawful for the commissioner, upon the surrender to him of such patent, and the payment, etc., to cause a new patent to be

issued to the inventor for *the same invention* for the residue of the term then unexpired, in accordance with the patentee's corrected description and specification.

5 Stat. at Large, 122.

(1) Reissued Letters Patent must, by the express words of the statute, be *for the same invention;* and consequently, when it appears, on a comparison of the two patents as matter of legal construction, that the reissued patent is not for the same invention as that embraced and secured in the original patent, the reissued patent is invalid, as that state of facts shows that the commissioner, in granting the new patent, exceeded his jurisdiction. Interpolations of new features, ingredients or devices, which were neither described, suggested nor indicated in the original patent or Patent Office model, are not allowed, as it is clear that the commissioner has no jurisdiction to grant a reissue unless it be for the same invention as that embodied in the original Letters Patent.

Seymour *v.* Osborn, 11 Wallace, 544, 545, 546.
Battin *v.* Taggert, 17 How. 83.
Sickles *v.* Evans *et al.*, 2 Clifford, 203, 222.
O'Reilly *v.* Morse, 15 How. 111, 112.
Allen *v.* Blunt, 3 Story, 744.

(2) Whether a reissued patent is for the same invention as that embodied in the original patent, or for a different one, is a question for the Court in an equity suit, to be determined as a matter of *construction* on a comparison of the two instruments.

Seymour *v.* Osborne, *ante.*
Sickles *v.* Evans *et al.*, *ante.*
Rubber Co. *v.* Goodyear, 9 Wal. 796.

2. Upon the face of the original and reissued patents, upon comparison it appears as matter of law that they are not for the same invention, and hence the reissued patent is void.

(1) The original patent had but one claim, substantially the same as the second claim in the reissued patent.

(2) This was for the treatment of bark-tanned lamb and sheep skins (not leather) with the same compound as in the reissue.

(3) The patentee states in his original specification that it is "a full, clear and exact description" of the invention. That "his invention consists in a novel treatment of bark-tanned lamb or sheep skins." That "the process he adopts and which constitutes his invention, is as follows:" — here stating the ingredients of the compound and proportions substantially as stated in the reissue, and describing only the mode of applying the compound to the skin, of brushing it into the skin, as described in the reissue; closing with the claim stated.

(*a*) In the comparison it will be seen that the original claimed only the treatment of bark-tanned lamb and sheep skins with the specific compound brushed or rubbed on, — neither describing, suggesting nor indicating the treatment of leather generally at all, nor such skins with fat liquor alone without said ingredients, nor the saturating by dripping. Upon the face of the two patents, the old was for treatment with the *compound* alone; and the reissue is primarily for treatment with *simple fat liquor* alone, stating only that the patentee "*preferred* to use the same in connection with other ingredients"; and, after describing the compound, stating that "this forms a good treating mixture or compound," and closing with the second claim. It is simply for such treatment with simple fat liquor as it comes from the mill (which is in no way indicated in the original), interpo-

lated with the sole treatment and sole claim specified in the original, which is now suggested only as a "preferable" way, and secondary to that of fat liquor alone.

3. The specification does not contain the whole truth, but contains more than is necessary to produce the described effect, which fully appears to have been made for the purpose of deceiving the public; and on that account the patent is void.

Stat. 1870, ch. 230, § 61.

(1) It conceals the fact established by the evidence as well known in the trade, that fat liquor alone had been long used for softening leather, as found by the Court at Circuit.

(2) It conceals the fact that complainant knew generally of the use of fat liquor for said purpose long before obtaining his original patent.

(*a*) And with such knowledge he obtained his patent for treatment with the compound only.

(*b*) Then, finding that simple fat liquor alone would accomplish the same results as his compound, he sought a reissue, making the treatment with simple fat liquor, with or without heat, the basis of his invention and first claim, into which is interpolated as "desirable" and "preferred" the treatment with the heated compound which constituted the entire subject and claim of the original patent.

(*c*) This claim, that the new matter in the reissue which was not in the original patent was a part of the same original invention, was fraudulent, for the purpose of deceiving the public, and the patent void.

(*d*) The complainant, in surrendering the original patent and procuring the reissue, made oath that the original patent was *inoperative and invalid* by reason of a defective or insufficient specification; whereby he is estopped from now claiming that the same identical thing, repeated in the specifi-

cation and second claim of the reissue, standing independent of all additional or new matter, is valid.

(*e*) Between the date of the original patent, Aug. 17, 1869, and the application for the reissue, Jan. 12, 1870, and just previous to such application, Mr. Fulton, the partner and son-in-law of complainant, and the one who applies for complainant his alleged process, visited the factory of defendants Place twice, to observe carefully the method of treatment of bark-tanned lamb and sheep skins with fat liquor; saw them treated by *dipping*, etc., with the same identical process set out in the specification, filed Jan. 12, 1870, for the reissued patent.

Dep. of C. B. Wessels, pp. 265 to 266 inclusive, marginal 313 —

Dep. of John W. Place, pp. 261–263, marginal 309, 310.

These visits were, one the last of December, 1869; the other in the fore part of January, 1870.

Wessels, p. 265, marginal 313.

J. W. Place, p. 261, marg. 309.

John Fulton, as to first visit Dec. 31, 1869, p. 275, marg. 325, p. 277, 278, marginal 327–28.

Fulton was there, without apparent business, a quarter to half hour each time.

Dep. of Wessels, p. 265, 266, marg. 313.

Dep. of J. W. Place, pp. 261, 262, marg. 309.

Dep. of Fulton, pp. 277, 278, marg. 327–8.

Defendant suggests, as further evidence of such purpose of deceiving the public, that it was then and there, through his son-in-law, partner and operator, that the complainant learned of the defendants Place the specific process de-

scribed in his first and additional claim in the reissued patent.

(*f*) Mr. Fulton is called in rebuttal, and replies, (1) that one of his visits to said Places' factory was after the 1st of February, 1870, when the reissue was dated; (2) that his purpose was to learn whether or not defendants Place were infringing, claiming to confirm his evidence by a memorandum book, and by a statement that complainant used and employed the same process only after the reissue as before.

Page 275, marg. 325.

(1) The purpose in going there, as stated by Mr. Fulton, viz. to see if the defendants Place were infringing the patent, is improbable, if that was while the complainant believed his original patent was inoperative and invalid for the reasons stated, and sworn to only two weeks after for the purpose of obtaining the reissue.

(*a*) He had heard previously said defendants were treating such skins with *fat liquor*.

Dep. of Fulton, p. 278, marg. 328.

(*b*) But suppose the alleged was the true purpose of that first visit, Dec. 31, 1869, to said defendants' factory.

He did not find said defendants infringing, but using only *fat liquor*.

Fulton, p. 277, marg. 327.

(*c*) We submit complainant had heard that defendants Place were treating skins with fat liquor alone, and this son-in-law and partner went there to learn as to the fact and the method of doing it, and in two weeks thereafter surrendered his old patent, and made the new additional claim for treatment with fat liquor alone, by dipping, etc. He has stolen

said defendants' business, and incorporated it into his patent, and now brings suit againt them for infringement by continuing their said business.

(*d*) He had *experimented* with fat liquor alone, by dipping, etc., from 1866 to spring of 1869, when he claimed to have perfected his invention, and applied for his patent with his specification and claim for the compound only.

Dep. of Fulton, pp. 32–36, marg. 63, 64, 65, 66.

(*e*) His treatment during this time was therefore claimed as only experimental with fat liquor alone till spring of 1869, when it was discarded, and the treatment with the compound then ripened into invention, and was alone used till Fulton witnessed the treatment by defendants Place, Dec. 31, 1869, when, thereupon, in two weeks thereafter, without further experiment, his previous experiments with fat liquor alone had ripened suddenly into invention, and the original patent was surrendered as inoperative, and this newly fledged invention of the use of fat liquor alone made the primary invention, and the compound barely secondary.

Dep. of Fulton, pp. 35, 36, marg. 66, 67.

(*f*) The complainant practically used the second claim, viz. treatment with the compound, as his invention.

Dep. of Fulton, pp. 35, 36, *ante*.
Dep. of Fulton, p. 284, marg. 334, 335.
Dep of Fulton, p. 287, marg. 337, 338.

(2) The memorandum book on which he bases his contradiction of defendants' witnesses in part, is suspicious, both from *inspection* and witness' statement in relation to it.

Pages 278–282, marg. 328–333.

Only two occasions are noted on the book, although he was there several other times; and thirty blank leaves occur immediately preceding the entry, and ten leaves following, of dates from Aug. 1868 to Feb. 1871, while the previous memoranda of fourteen leaves cover the time from Nov. 1869 to Sept. 1872. The year is not entered with the entry of Feb. 14, and this is the only memorandum book or diary witness had kept since 1867 to the time of giving his evidence.

All appears to be written at once with the same pen and same ink.

(3) The other ground of alleged confirmation of his evidence is, that plaintiff made no change in his process or mode of treatment of bark-tanned sheep and lamb skins after his first application for a patent in 1869, and before the reissue in 1870.

Dep. of Fulton, p. 275, marg. 325; and this treatment was with the compound by brushing.

(*a*) If this be so, when did his discarded experiments with fat liquor alone, applied by dipping, mature into invention previous to his application for a reissue?

III.

The complainant, patentee, was not the original and first inventor or discoverer of any material and substantial part of the thing patented.

(1) The use of fat liquor alone in the treatment was a material and substantial part of the thing patented; and if this was in prior use and not new with the plaintiff, his patent was void.

Pitts *v.* Hall, 2 Blatch. 234.

Parker v. Stiles, 5 McLean 54; Laws' Dig. 528.

Parker *v.* Sears, 1 Fisher, 99; Laws' Dig. 530.529
Smith *v.* Downing, 1 Fisher, 70; " 530.529
Evans *v.* Eaton, 7 Wheat. 434.
U. S. Stat. 1870, ch. 230, § 61.

(2) The evidence is clear and uncontradicted that the use of fat liquor for the purpose of softening leather generally, in the manner substantially set forth in the Letters Patent, had been known and in almost universal use among manufacturers of leather for many years prior to complainant's alleged invention.

Dep. of James Christie, pp. 56 to 63, marg. 91 to 99.
Dep. of Jonathan Ricketts, pp. 74, 75, marg. 112, 113, inclusive; pp. 78, 79, marg. 117; p. 80, 81, marg. 119, 120.
Dep. of Aaron Simmons, pp. 135, 136, 137, marg. 177, 178, 179, 180.
Dep. of Isaac V. Place, pp. 150, 151, 152, marg. 195, 196, 197.

This use included treatment of the Indian tanned skins.

Dep. of James F. Place, p. 251–2, marg. 298, 299.
Dep. of Ricketts, p. 78, 79, marg. 117; and p. 83, marg. 123.
Dep. of Aaron Simmons, who so treated them fifteen or eighteen years ago, p. 135–6, marg. 177, 178, 179, 180.

1. *If fat liquor alone had been used for more than two years prior to plaintiff's alleged invention in the manner indicated for the purpose of rendering any kind of leather soft and pliable, the patent cannot be sustained, even if it had not before been applied to bark-tanned lamb and sheep skins.*

(1) It would be the specific treatment and invention

claimed in the first claim of the patent, and such prior use would invalidate the patent.

(2) If the patent be construed as limiting the treatment to bark-tanned sheep and lamb skins, it would then be *only a substitution, or the application of an old thing to a new purpose* -- a double use which is not the subject of a patent.

(3) "A mere application of an old contrivance in the old way to an analogous subject, without any novelty or invention in the mode of applying such old contrivance to the new purpose, is not a valid subject matter of a patent."

Harwood *v.* Great Northern Railway, 11 H. of Lds. Cas. 654, 667, 673, 682, 684.
Same in 2 Best & Smith, 222, 224, etc.

The subject-matter of the patent in question in that case was the application of a grooved plate, known as a "fish," to the sides of two contiguous rails of a railway for the purpose of binding together their abutting ends; and it was held to have been anticipated as a patentable novelty by the previous application of a channelled iron plate underneath the abutting ends of two contiguous bridge timbers, the purpose served by each being to resist vertical strain and to receive the heads of the bolts into the grooves or channels.

Lord Chancellor Westbury said: "It would be an idle thing, if it were possible, to take a well-known mechanical contrivance, and by applying it to a subject to which it has not hitherto been applied, to constitute that application the subject of a patent to be granted as for a new invention."

Mr. Justice Blackburn, in a dissenting opinion upon the facts, laid down the same principles of law as unquestioned; and says: "In every case arises a question of fact whether the contrivance before in use was so similar to that which the patentee claims that there is no invention in the differences, if any, between the old contrivance and that for which the

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(2) The evidence is clear and uncontradicted that the use of fat liquor for the purpose of softening leather generally, in the manner substantially set forth in the Letters Patent, had been known and in almost universal use among manufacturers of leather for many years prior to complainant's alleged invention.

Dep. of James Christie, pp. 56 to 63, marg. 91 to 99.
Dep. of Jonathan Ricketts, pp. 74, 75, marg. 112, 113, inclusive; pp. 78, 79, marg. 117; p. 80, 81, marg. 119, 120.
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patent claims a monopoly; and if there is none, there arises the further question of fact, viz., whether the purpose to which the contrivance was before applied and the new purpose are so *analogous* or *cognate* that there is no discovery or invention in the new application."

In the case at bar it is established as fact, and undisputed by evidence, that fat liquor had been used many years, at least thirty, before the alleged invention by the patentee, generally in the trade to make skins and leather, including bark-tanned skins of some kinds, soft and pliable, and was applied in substantially the same way described in the specification and for the same purpose.

And this claim rests solely on the alleged new application of fat liquor to bark tanned sheep and lamb skins.

(*a*) In this case it is manifest that the *new purpose*, viz. the application of fat liquor to bark-tanned lamb and sheep skins, is so analogous and cognate to that of such prior purpose and use that it falls within the rule, and is not patentable.

In Hotchkis *v.* Greenwood, 11 How. 248, 264, the same doctrine is stated.

The facts presented were in substance that a knob of potter's clay was applied to or combined with its shank and spindle by means of a dovetailed cavity and an infusion of melted metal, and knobs of metal and wood had been previously combined with the same kinds of shank and spindle in the same way.

It was held that such a substitution of one well-known material for another was not patentable, although there might be utility and a certain degree of novelty attained.

In the case at bar, the only change in the patent from the prior use is the application of fat liquor to bark-tanned lamb and sheep skins, instead of making the same application to other leather, and even other bark-tanned skins, for the same purpose.

The case of Bean *v.* Smallwood, 2 Story, 408, 411, enunciates the same rule.

The question was whether the application of certain locking devices to a well-known form of a rocking-chair, by means of which the reclining back of the seat could be fastened at any desired inclination, was a subject of a patent, it appearing that such devices were old and had been applied to purposes of a similar nature in other machines, although not to chairs. Judge Story held that the application of the locking devices to the chair was merely the application of an old mechanical contrivance to a new purpose, which was not patentable. Such an application he compared to the use of a coffee-mill to grind corn.

In Winans *v.* Boston & Providence R. R., 2 Story, 412, 415, the main question in issue was whether the application of axle-boxes outside of the wheels of railway carriages — the axles being extended beyond the wheels for that purpose — could be the subject of a valid patent, it being proved that the application had previously been made to other wheeled carriages; and Judge Story held that the patent could not be maintained.

In Losh *v.* Hague, Web. Pat. Cases, 202, 207, 208, the patent was for the application of a certain wrought-iron wheel to railway carriages, such wheels having been previously used on other carriages. Lord Abinger says, in substance, "If this wheel has been constructed long before the plaintiff's patent, that although there were no railroads then to apply them to and no demand for such wheels, yet that the application of them to railroads by Mr. Losh will not give effect to his patent if part of that which is claimed as a new improvement by him is in fact an old improvement invented by other people and used for other purposes."

In Regina *v.* Cutler, 3 Carr. & Kir. 215, 228, 230, 234, the third claim of the patent was as follows: "I claim the

application of either iron or steel tubes when coated with copper, brass, or other alloys of copper, in the construction of tubular flues for steam boilers." Lord Denman, C. J., said, "With regard to the third of those claims, in which the defendant Cutler claims application of tubes in the construction of tubular flues, it appears to me that he has no right to take out a patent for the mere application of particular things to any particular purpose. If he had made a new combination, that might have been a new discovery and a proper subject of a patent; but I think Lord Abinger's illustration is a striking one and applicable to the present case; it is like sweeping a carpet of a new manufacture with an old broom." He further said, "And in general terms, I think the application of an article to produce any particular result, the party having no claim either to the mode of producing the article or to the mode of applying it for attaining that result, forms no ground of a patent. The coated tubes mentioned in the specification are not new, and I think, therefore, that the third part of the invention which is claimed in this specification cannot be made the subject of a patent."

In Jordan *v.* Moore, L. R. & C. P. 624, 635, the patentee claimed the construction of ships and other vessels that navigate on water with an iron frame, combined with an extra covering of timber planking for the sides, bilges and bottoms, it appearing that wood had been previously used for the same purpose. Mr. Justice Byles, in delivering the opinion of the Court, said, in substance, "It is the substitution of one well-known analogous material for another, that is, wood for iron, to effect the same purpose on an iron vessel"; and held it was not the subject of a patent.

In Brook *v.* Aston, 8 El. & Bl. 478, 485, it was held that the application of a machine for polishing cotton or linen thread to the new purpose of burnishing yarns of wool or hair was not the subject of a patent.

The same doctrine was applied by Judge Story in Howe *v.* Abbott, 2 Story, 190, 193, 194. The question in issue was whether there was any patentable novelty in twisting and curling palm leaf for mattresses and cushions by the same process that had previously been used in twisting and curling hair for the same purpose. The Court held it was not the subject of a patent.

See Phillips *v.* Page, 24 How. 164, 167.
Bottle Envelope Co. *v.* Seymer, 5 C. B. (N. S.) 164.
Bush *v.* Fox, 5 H. of Lds. Cas. 707, 715–6.
Leroy *v.* Latham, 14 How. 177.
Russell *v.* Klein, charge, p. 148, fol. 726.
Baulton *v.* Bull, 2 H. Bl. 487.

It is no answer to this view of the case and fatal result to the patent, that the fat liquor acting upon oil-tanned skins combines differently, either chemically or mechanically, with the tissues of the skin, than when acting upon a bark-tanned skin, as claimed or suggested by Dr. Porter; since he states, with all others, that the general effect upon the leather or skins, to make them soft or pliable, is the same.

Dep. of Chas. H. Porter, pp. 392–3, marg. 457.
" " p. 393, marg. 458.
" " pp. 398–399, marg. 464, near end.

This alleged difference, as stated by Dr. Porter, *is not in the process, but in the material subjected to the process.*

Dep. of Porter, p. 399, marg. 465.

But the same treatment had been applied to other kinds of bark-tanned skins.

Dep. of I. V. Place, p. 163, marg. 208.
" Uriel Case, p. 167, marg. 213.

2. *If a construction should be given to the first claim of the patent, that as a requisite element of the invention the fat liquor must be heated to or near the boiling point before use, then the defendants have never infringed the patent, because they have never so heated the liquor.*

Dep. of Samuel Dodge, Sen., pp. 197, 198, marg. 244, 245; and p. 229, marg. 277.
Dep. of I. V. Place, p. 152, marg. 196–7.
" J. W. Place, p. 181, marg. 227, end.

It is confirmed by the fact that the defendants in both cases deem heating the liquor to or near the boiling point before use, to be very injurious.

3. Heating the fat liquor to or near the boiling point has no utility, and is positively injurious in the treatment of the skins. If applied hot it spoils, and if allowed to cool, spots and stripes them (by reason of the emulsion not being perfectly restored). If an essential element, it avoids the patent for want of utility.

Isaac V. Place, pp. 410, 411, marg. 478.
Samuel Dodge, Sen., p. 405, marg. 472–3.
" " " p. 222, marg 270.

Charles H. Porter says the heat separates the oily matters, etc., but by warming and agitating the liquor an emulsion was obtained *apparently similar* to that which previously existed in the fat liquor.

Dep. of Porter, p. 394, marg. 459, near end.

On the other hand, Isaac V. Place and Samuel Dodge, Sen., speaking as practical men, say the oily spots or streaks in the mixture will spot or stripe the skin.

And if applied hot it spoils the skin.

Dep. of Porter, p. 400, marg. 467.
" I. V. Place and Samuel Dodge, *ante*.

(*a*) If the alleged infringement in this
was by mixing hot water with cold fat lic il

(1) That is not the process indicated

(2) It is in no sense heating the fat liquor to or near the boiling point.

(3) The defendants heated the fat liquor for the purpose, so as to be comfortably worked in with the hands, *which was generally done and well known prior to the alleged invention.*

Dep. of Aaron Simmons, p. 135, marg. 177, at end.
" Isaac V. Place, pp. 151, 152, marg. 196.
" Ricketts, p. 73, marg. 112.
" Filmer, p. 85, marg. 124.
" S. Dodge, Sen., p. 191, marg. 238.
" " " p. 192, " 239.
" " " p. 192, " 240.
" " " pp. 193 to 197 inclusive, marg. 240, 241 to 244 inclusive.
" J. L. Northrup, p. 66, marg. 102 and 103.
" Heacock, p. 119, marg. 159.
" Hull, p. 121, marg. 163.
" Chapman, p. 130, marg. 172.
" Uriel Case, p. 166, marg. 212.
" J. W. Place, p. 180, marg. 227.
" Samuel Dodge, Jr., p. 234, marg. 282, 283.
" Whiting, for complainants, p. 43, marg. 75.
" Green, for complainants, p. 52, marg. 85.
" Putman, p. 55, marg. 89.

Moreover, in preparing the fat liquor by defendants Dodge, the warm water was first prepared in the tub used for the treatment, then after that the fat liquor put in.

Dep. of S. Dodge, Sen., p. 193 to 197, marg. 240 to 244 inclusive.

2. *If a construction should be given to the first claim of the patent, that as a requisite element of the invention the fat liquor must be heated to or near the boiling point before use, then the defendants have never infringed the patent, because they have never so heated the liquor.*

Dep. of Samuel Dodge, Sen., pp. 197, 198, marg. 244, 245; and p. 229, marg. 277.
Dep. of I. V. Place, p. 152, marg. 196–7.
" J. W. Place, p. 181, marg. 227, end.

It is confirmed by the fact that the defendants in both cases deem heating the liquor to or near the boiling point before use, to be very injurious.

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On the other hand, Isaac V. Place and Samuel Dodge, Sen., speaking as practical men, say the oily spots or streaks in the mixture will spot or stripe the skin.

And if applied hot it spoils the skin.

Dep. of Porter, p. 400, marg. 467.
" I. V. Place and Samuel Dodge, *ante*.

(*a*) If the alleged infringement in this particular of heating was by mixing hot water with cold fat liquor, —

(1) That is not the process indicated in the patent.

(2) It is in no sense heating the fat liquor to or near the boiling point.

(3) The defendants heated the fat liquor for the purpose, so as to be comfortably worked in with the hands, *which was generally done and well known prior to the alleged invention.*

Dep. of Aaron Simmons, p. 135, marg. 177, at end.
" Isaac V. Place, pp. 151, 152, marg. 196.
" Ricketts, p. 73, marg. 112.
" Filmer, p. 85, marg. 124.
" S. Dodge, Sen., p. 191, marg. 238.
" " " p. 192, " 239.
" " " p. 192, " 240.
" " " pp. 193 to 197 inclusive, marg. 240, 241 to 244 inclusive.
" J. L. Northrup, p. 66, marg. 102 and 103.
" Heacock, p. 119, marg. 159.
" Hull, p. 121, marg. 163.
" Chapman, p. 130, marg. 172.
" Uriel Case, p. 166, marg. 212.
" J. W. Place, p. 180, marg. 227.
" Samuel Dodge, Jr., p. 234, marg. 282, 283.
" Whiting, for complainants, p. 43, marg. 75.
" Green, for complainants, p. 52, marg. 85.
" Putman, p. 55, marg. 89.

Moreover, in preparing the fat liquor by defendants Dodge, the warm water was first prepared in the tub used for the treatment, then after that the fat liquor put in.

Dep. of S. Dodge, Sen., p. 193 to 197, marg. 240 to 244 inclusive.

(4) Increasing the degree of heat is not patentable; it is a mere colorable variation, and is a matter of degree, and not of principle.

But there was no change as to heating after the patent.

Dep. of Dodge, p. 208, marg. 256.

(5) But if it be held as matter of law that the application of the same treatment to bark-tanned lamb and sheep skins as had been applied long before the complainants alleged invention to other kinds of skins and leather is the subject of a valid patent, the patent is still invalid for *want of novelty*.

(*a*) The evidence is full and conclusive of such treatment for the same purpose of bark-tanned lamb and sheep skins prior to the alleged invention of the patentee.

Samuel Dodge, Sen., a kid-dresser and finisher, of thorough English training for fourteen years preparatory in learning his trade, and with great experience in the practical business, testifies plainly and fully upon this point.

His dep. p. 190, marg. 237–238.

He has been acquainted with fat liquor used in dressing leather for mittens and gloves for at least fifty years, and first used it in this country in Johnstown, Fulton County, N. Y., twenty-three or twenty-four years ago, for Jonathan Ricketts.

His dep. p. 191, marg. 238.

He treated for Mr. Ricketts 300 or 400 dozen of such skins, of which about three fourths were treated with simple fat liquor alone; the liquor was warmed to about blood-heat, and the skins were dipped into it and saturated with it.

His dep. pp. 191–192, marg. 238–239.
" pp. 209 to 215, marg. 258 to 264.

He selected out about one fourth from those he did for Ricketts, such skins as were "too heavy, and what we call bark-bound, tanned in too warm liquor, and dissolved some carbonate of ammonia, and put the skins into it"; then, after drying, mixed up a liquor for them of "oil, eggs and warm water," and saturated them in it, and then dried them. These were so selected and treated because the fat liquor alone would not do for that class of skins.

His dep. pp. 191–192, marginal 239.
" pp. 213–214, " 262.
" p. 213, " 261.

These were made soft and pliable, suitable for mittens and gloves, with the squeak removed.

Jonathan Ricketts confirms Mr. Dodge upon this point of his evidence. It was in 1850 or 1851 he did first lot.

His dep. pp. 73, 74–75, marg. 111 to 114.
" pp. 75–76–77, marg. 114–115–116.

John Filmer also confirms.this evidence as to second lot in 1852.

His dep. pp. 84, 85, marg. 123, 124.

Mr. Dodge treated bark-tanned sheep and lamb skins with fat liquor alone for Messrs. Churchill, in Gloversville, about twenty years ago in the same way, for the same purpose of softening, etc., and with the same effect in 1852 and 1853.

His dep. p. 192, marg. 239.
" p. 217, marg. 265.

He treated some with the same process, for the same purpose and with the same effect, for David Spaulding, of Gloversville, about twenty years ago.

His dep. pp. 192, marg. 240.

He applied the same process, for the same purpose, etc., for Edward Dunson, of Gloversville, about sixteen or seventeen years ago.

His dep. p. 193, marg. 240.
" pp. 217, 218, marg. 266.

He applied the same process, with like effect, for Samuel Gilchrist, in Gloversville, about twenty years ago.

His dep. p. 193, marg. 240.
" p. 218–19, marg. 267, 268.

He treated in like manner, with same effect, for Chapman & Warring, of Amsterdam, and Logan & Warring, also, about fifteen years ago.

His dep. pp. 193, marg. 240, 241.
" p. 220, marg. 268.

Upon this occasion Mr. Dodge is confirmed by *James B. Chapman*. It was in 1857.

His dep. p. 130, marg. 172–3.
" p. 134, marg. 176.

Mr. Dodge applied the same process, with same effect, for Daniel B. Judson, of Gloversville, about fifteen years ago.

His dep. p. 194, marg. 241.
" p. 220, marg. 268.

Mr. Dodge is confirmed in this evidence by Daniel B. Judson.

Dep. of Judson, p. 259, marg. 306.

Also, for Philander and David Heacock, of Kingsboro', about fourteen years ago.

His dep. p. 194, marg. 241.

Philander C. Heacock confirms Mr. Dodge in this evidence.

Dep. of Heacock, p. 119, marg. 160.

He is also confirmed by his son, Samuel Dodge, Jr., as to the application of this same process for Messrs. Heacock, D. B. Judson, Mr. Dunson and Mr. Gilchrist.

Dep. of Samuel Dodge, Jr., p. 236, marg. 283.
" " " p. 237, 238, marg. 285–6.

Mr. Dodge treated in like manner such skins for Mr. Nickerson about thirteen years ago.

His dep. p. 194, marg. 242.

Also for Daniel B. Judson in 1869.

His dep. p. 195, marg. 242.
" p. 221, marg. 269.
" p. 200, marg. 248.

Confirmed in this by Daniel B. Judson.

His dep. p. 259, 260, marg. 306, 307.

He treated several different lots for said persons and firms, and at different times.

His dep. p. 201, marg. 249.

Mr. Dodge's process of preparing the liquor and treatment with fat liquor alone such bark-tanned sheep and lamb skins as were found suitable by him for such treatment, the last two years, or since the patent.

His dep. 196, marg. 243.
" 198, marg. 245–6.

This treatment the same since the patent as before.

His dep. p. 196, marg. 243.

He also manufactured his fat liquor sometimes, when wanted, of a different quality or degree, of alkaline strength, to adapt it to the skin.

His dep. p. 200, marg. 247.
" pp. 196, 197, marg. 244.
" pp. 224, 225, marg. 272.

This is called by kid dressers, "*gum.*"

His dep. p. 225, marg. 272.

Mr. Dodge told James Chapman how to treat such skins with fat liquor fifteen years ago.

His dep. p. 202, marg. 250.

He was the same Chapman that testified in this case.

His dep. p. 230, marg. 278.

He also told Mr. Russell, the complainant, how to treat them eight or nine years ago.

His dep. p. 202, marg. 249–250.
" pp. 225–6, marg. 275.

Those treated by the fat-liquor process, during the many years as stated, were as soft and pliable and as suitable for gloves as the exhibits produced by the defendants. Nos. 3, 4, 5 and 6, treated in the same manner, according to the quality of the skin.

His dep. p. 205, marg. 253.

And as to the treatment of said exhibits, see his evidence, pp. 203, 204, marg. 251–252.

From the various quantities of such skins furnished him by different manufacturers to be softened and made suitable

for gloves, he selected those unsuitable for any cause for such treatment, and treated them differently according to the requirement, viz. with a "*solution of carbonate of ammonia*," when the skins are tanned in hot liquor, and are drawn up, or bark-bound, as they call it.

His dep. p. 230, marg. 277.
" p. 191, marg. 230.

With "carbonate of ammonia, oil of vitriol, and common salt," referred to as his secret process, with or without eggs, to the hardest and thickest kinds.

His dep. p. 206–207, marg. 255.
" p. 230, marg. 277–8.

Kid skins with alum, salt and eggs.

His dep. p. 200, marg. 248.

With sal-soda and soap when the liquor is sour.

His dep. p. 230, marg. 277.

The manufactured fat liquor to be applied when the liquor from the mills had too much alkali for the particular skins to be treated, made of neats-foot oil, sal-soda and soap.

His dep. p. 231, marg. 278.
" p. 231, marg. 279.
" p. 196, marg. 244.

Kid skins are tanned with alum and salt, and are treated with this manufactured fat liquor.

His dep. p. 200, marg. 247–248.

He made this fat liquor first in this country twenty-seven years ago, and nearly every year since.

His dep. p. 200, marg. 247.

The discrimination as to the method of applying the fat liquor to the skins, was made by him according to the condition of the skin, or use to be made of the leather.

His dep. p. 231, marg. 278-279.

Hence, when he used the various ingredients combined and applied differently, as in his dep. pp. 232, 233, marg. 280, each different combination and application was determined on by him according to the character and condition of the skin, and the use to be made of it; and the process was varied to meet the varying qualities and conditions of the skins.

In the evidence given at Utica by him, relating to his treatment of such skins, he stated, generally, the different ingredients used, and was not inquired of generally under what conditions and circumstances the different elements were differently combined and applied. See his evidence as reported by Mr. Tinsley, if competent, pp. 304 to end of 311, marg. 357–365.

The qualities and conditions of the skins varied greatly according to the animal from which taken, the time of year they were taken off, the treatment in tanning, etc.

Dep. of I. V. Place, p. 152, marg. 197.
Dep. of Gillette, pp. 330, 331, marg. 386.
Pages 336, 337, marg. 393, end.

And as before stated in dep. of Samuel Dodge, Sen., and undisputed.

Isaac V. Place, of great experience in the business of dressing leather and manufacturing gloves and mittens, doing an extensive business for nearly forty years at Gloversville, also testified on this point.

He has used fat liquor in dressing skins every year, more

or less, since 1835, and has well known during all that time of the purpose and effect of such use of fat liquor to make the skins soft to which it was applied and suitable for gloves.

His dep. pp. 150–153, marg. 195–198.

He first learned the use of fat liquor to soften glove leather thirty-nine years ago, and soon after applied it to bark-tanned sheep and lamb skins, fixing the first *definite* time in 1856.

His dep. p. 151, marg. 195.
" p. 152, marg. 197.

In 1856 he applied the process of treating such skins with fat liquor, and procured the same effect described in the patent.

His dep. p. 151, marg. 195.

In 1857 he applied the same process with similar effect.

1858, the same.

His dep. p. 151, marg. 196.
Dep. of J. W. Place, p. 181, marg. 228.

His evidence as to those treated in 1857, he is confirmed by Henry E. Krause.

Dep. of I. V. Place, p. 152, marg. 196.
" " " p. 157, marg. 202.
" " " p. 153, marg. 198.
Dep. of Krause, p. 108, marg. 148.
" " p. 112, marg. 153.
Also by Uriel Case, p. 167, marg. 213.

These were assorted and used, a part for mittens and part for gloves.

Dep. of Krause, p. 114, marg. 155.

Also confirmed by James F. Place.

His Dep. pp. 247–249, marg. 294, 295, 296.
" pp. 256, 257, marg. 303, 304.

In 1862 I. V. Place so treated such skins with like effect, about four hundred dozen.

His dep. pp. 151, 152, marg. 196.
" pp. 157, 158, marg. 202, 203, verified by his books.

The circumstances which enable him to fix the time in 1862.

His dep. p. 163, marg. 209.

He also used the same process in the softening bark-tanned skins of other animals with the same effect.

His dep. p. 152, marg 197.
" p. 156, marg. 201.
" p. 159, " 204.
" p. 165, " 211.

James L. Northrup treated bark-tanned sheep and lamb skins with the same process and effect as claimed in the patent, at Broadalbin.

First in 1854 and 1855, about fifty dozen.

His dep. pp. 65, 66, marg. 102, 103.

Also in 1856 and 1857.

His dep. pp. 66, 67, marg. 103.

He had known of such use of fat liquor by one Laufer for him in the year 1849 and 1850.

His dep. p. 70, marg. 108.
" pp. 72, 73, marg. 110, 111.

Mr. Northrup fully understood the effect of such treatment and the kind and quality of skins to which it should be applied alone, and to what with other ingredients, and applied it warm.

His dep. pp. 65, 66, marg. 102, 103.
" pp. 67, 68, " 104, 105.

About one third with fat liquor alone and two thirds with fat liquor and other ingredients, viz. soft soap or salt or alum or oil, as the skins required.

His dep. p. 67, marg. 104.

He prepared for and assisted P. C. and D. G. Heacock in preparing fat liquor and treating such skins with this process.

His dep. p. 67, marg. 103, end.
" pp. 69, 70, marg. 106, 107.

He sold goods made from such skins treated by the same process, and found them in market.

His dep. p. 68, marg. 105.
" pp. 69, 70, marg. 107.

Mr. Northrup is confirmed by James B. Chapman.

His dep. pp. 130, 131, marg. 172, 173.

He saw Mr. Northrup treat some with fat liquor alone, and some with that and other ingredients.

His dep. p. 130, marg. 172.
" p. 134, " 176, end.
" p. 133, " 175, "

He sold gloves made from leather so treated, for I. V. and J. W. Place, defendants, for some ten years.

His dep. p. 131, marg. 173.

Mr. Northrup is confirmed by P. C. Heacock.

His dep. p. 119, marg. 160.

Philander C. Heacock treated such skins with same process and effect — commencing in 1862, 1863.

His dep. p. 119, marg. 159, 160.

Some were treated with fat liquor alone, and some with fat liquor, sal-soda, eggs and soap.

His dep. p. 120, marg. 161.

James L. Northrup instructed him in this process.

Dep. p. 119, marg. 160.

He is confirmed by Mr. Northrup.

His dep. p. 67, marg. 103; p. 69, marg. 106, 107.

In rebuttal, —

Hiram Freeman *did not know it* — except the use of eggs and soap.

His dep. pp. 384-5, marg. 448,

which in no way affects Mr. Heacock's evidence.

Wm. H. Monroe applied the same process with like effect, in Dedham, Mass. (about twelve years), and in Gloversville (about fifteen years), from 1851 to 1869.

His dep. pp. 86, 87, 88, marg. 126, 127.

He treated them with fat liquor alone, and with oil and soap, and with salt, alum and eggs.

His dep. pp. 86, 87, marg. 126, 127.

The fat liquor used at Dedham was made by oil and alkali.

His dep. p. 96, marg. 136.

Same as one kind named in the specification of the patent.

Page 16, marg. 40.

It was a well-known process to him, and had been for eighteen or twenty years.

His dep. pp. 87-8, marg. 127.

Mr. Monroe is confirmed by the plaintiff's witness, *Mr. Gillette.*

Dep. of Monroe, p. 86, marg. 126.
" Gillette, p. 320, marg. 374.

And with other ingredients.

Gillette's dep. p. 320, marg. 374.

The "dampening down," so called, may take the squeak out.

Dep. of Gillette, p. 322, marg. 376.

Mr. Gillette, a lawyer and leather dresser, having examined the patent and used the process, defines the "Russell process" to be "the application of fat liquor, with a portion of salt, sal-soda and soap dissolved in it, and heat to or near the boiling point, and when sufficiently cooled, applied with a brush or by immersion."

Dep. of Gillette, p. 324, marg. 379.
" " p. 331, marg. 387.

In 1865, Gillette treated such skins with a process Mr.

Monroe gave him, etc.; to wit, "with fat liquor, neats-foot oil, soap, salt and something else," — he don't remember; and this process made the skins soft in some degree; it was understood between them it would soften and remove the squeak.

His ev. p. 326, marg. 381.

With this process he was indefinite as to proportions, and had to experiment to get it right.

His dep. p. 335. marg. 391.

" pp. 331, 332, marg. 387, 388.

He treated same with fat liquor and water in 1867.

His dep. p. 327, marg. 383, end.

And would not swear he did not in 1865.

His dep. p. 326, marg. 382.

Also the same in 1868 — fifty dozen.

His dep. pp. 327–328, marg. 383.

Some rubbed on, and some immersed and softened.

Page 328, marg. 383.

Mr. Gillette used the eggs and water merely to dampen.

His dep. p. 328, marg. 384.

And the salt and water to improve them, as Mr. Monroe said.

His dep. p. 328, marg. 384.

Mr. Monroe gave him the "fat liquor process" in 1865, to improve the skins and remove the squeak.

Gillette's dep. p. 328, marg. 384.

So with the other processes.

Page 334, marg. 391.

On comparing his application of the fat liquor process given him by Monroe, and the Russell process, he shows no diversity except only in *degree*.

His dep. p. 333 and 334, marg. 389, 390.

The quality of skins differs, and the effect of a given treatment differs accordingly.

Gillette, p. 330, 331, marg. 386.
" p. 334–5, marg. 391.

Mr. Gillette testified in the suit at Albany, between this plaintiff and defendants Place, that the effect is the same whether the liquor is cold or warm.

His dep. p. 335–6, marg. 392, end.

And that he used simple fat liquor, warm, etc., in 1865.

His dep. p. 336, marg. 393.

And that he had produced leather by using heated fat liquor, as good as samples treated by Russell's process.

His dep. pp. 336, m. 393.

The squeak is not all removed by "Russell's process" always.

His dep. p. 337, marg. 394.

Samuel Dodge, Jr., also confirms Mr. Monroe.

His dep. pp. 235, 236, marg. 283, 284.
" pp. 239, 240, marg. 286, 287.

Mr. John E. Smith's evidence, offered to rebut, shows,

(1) That he *does not know* of Monroe's using fat liquor upon skins of his firm.

(2) That their skins were treated to a solution of soap in water, which must be very like the fat liquor plaintiff names in his patent, made of alkali and oil, and such as Monroe says he used there.

It was a question of *effect* produced by the treatments, and of degree, not of principle. Mr. Smith means the fat liquor from the mills. Mr. Monroe means the fat liquor made of alkali and soap, as stated by him.

John W. Place, in 1856, treated such skins with simple fat liquor process, on two hundred dozen, producing the same effect.

His dep. p. 180, 181, marg. 226, 227.

Time fixed by the closing his business in 1857.
And this was before that.

His dep. p. 180, marg. 226.

Again in 1869.

Page 180, 181, marg. 227.

This treatment was with fat liquor alone; he never heated the liquor to or near the boiling point, nor used any other ingredients.

His dep. p. 181, marg, 227, end.

He sold gloves made from such skins, treated with this fat liquor process, for his brother, I. V. Place, in Wisconsin, in 1858.

His dep. pp. 181 – 2, marg. 228.

Henry Hull used same process with same effect, warm and cold.

His dep. pp. 121–122, marg. 162, 163.

He saw Adam Quackenbush treat such skins in same way, and with like effect.

His dep. p. 122, marg. 163.

He used eggs, soap, soda and oil sometimes, and sometimes simple fat liquor.

His dep. p. 128, marg. 169.

The fat liquor alone was used on lamb skins, because they are lighter skins, softer and more pliable.

His dep. p. 128, marg. 169.

Those hard, etc., he treated with eggs, oil, sal-soda and soap.

His dep. p. 128, marg. 170.

Has used fat liquor on such skins, the same since the patent as before.

His dep. p. 129, marg. 171, end.

Uriel Case used the same process of fat liquor alone, upon such skins, with the same effect, eighteen or nineteen years ago.

His dep. p. 166, marg. 212.

He treated bark-tanned deer skins in same way, twenty-five years ago.

His dep. p. 167, marg. 213.

James F. Place used the same, with like effect, 1858, and 1859 or 1860.

His dep. p. 249, marg. 296,
" p. 255, marg. 302.

He also knew his brother, I. V. Place, used it in 1855-56 and 1857, and in 1860.

His dep. pp. 248 – 9, marg. 295 – 6.
" p. 251, marg. 298.
" p. 252, marg. 299 – 300.

Also in 1855.

His dep. p. 254, marg. 301.

Sidney S. Plummer also applied the same process for the same purpose and with the same result.

His dep. pp. 146 – 7. marg. 190 – 191.
" pp. 148 – 9, marg. 192 – 3.

He first knew the effect of fat liquor upon bark-tanned sheep and lamb skins twenty years ago.

His dep. p. 150, marg. 194.
Dep. of Porter, witness for plaintiffs, pp. 367 – 8, marg. 429 – 30, in 1866 and 1868.
,, p. 368, marg. 430, and to end.

Such skins and gloves made from them, softened by this process, were generally in the market before the alleged invention for Russell.

See evidence cited as to what witnesses had treated to such process, manufactured and sold.

Also, —

Dep. of Northrup, pp. 68 – 9, marg. 105 – 6.
" Northrup, pp. 69 – 70, marg. 107 – 108.
" Hull, p. 121, marg, 162 – 3.
" Monroe, pp. 87 – 8, marg. 127.
" J. W. Place, p. 181, marg. 228.
" I. V. Place, pp. 152 – 3, marg. 197 – 8.
" I. V. Place, pp. 161 – 2, marg. 206 – 7.

Mr. Russell, the complainant, knew all he ever knew, before his instruction derived from Fulton's visit to Places's mill to see the process first, Dec. 31, 1869, about treating such skins with fat liquor alone as early as 1864, or several years before his alleged invention.

Mr. Dodge told him.

His dep. p. 202. marg. 244–250.
" p. 225. marg. 273.

Mr. Russell does not contradict it. Why does he not testify? Such skins, apparently so treated, were seen hanging upon Russell's lines and fences and in his shop during that time.

Dep. of Porter, p. 368, marg. 429.
" I. V. Place, pp. 159, 160, 161, marg. 204–5–6.
" Combes, for plaintiff, p. 352, marg. 411.

Is not his silence an admission?

John Fulton says that they used fat liquor for such purpose, p. 32–33–4, marg. 63–4–5, beginning in 1866, and using it in various ways.

This defence of want of novelty is not met with the usual oath and evidence of the patentee, but is placed upon some pretended conflict between their evidence on a former suit at Utica and that given here.

First. By the minutes as taken and reported by Mr. Tinsley, with his oath.

(1) Upon this piece of evidence we pray your Honor's judgment as to its competency.

The evidence was taken in short-hand, copied into English in part by another; on which copy the witness *depends* for the alleged evidence he testifies to.

Tinsley's dep. p. 292, marg. 343–4.
" " p. 297, marg. 349.

Mr. Tinsley has no recollection, even after reading over his minutes of the evidence so as to enable him to testify, nor can he swear that the notes are entirely accurate.

His dep. p. 297–marg. 349.

(2) If it is competent, it does not substantially conflict, but confirms.

(*a*) The infirmities of the faculties of speech and hearing require such evidence at best to be carefully scrutinized.

(*b*) This evidence involves the correctness of the witness in hearing the question, the power of the witness to express himself plainly, clearly and intelligently, the accuracy of the reporter in hearing and reporting the evidence; and further, in this case the witness' *recollection is not refreshed*, and a part of the evidence was not taken from the short hand by him.

Second. By raising some points of conflict in the evidence of particular witnesses.

For instance, it is suggested argumentatively that the defendants Dodge could not have known of the fat liquor process in 1867 or 1868, because they conferred with Messrs. Gillette and Combes on their "oat-meal" process, and did not mention the use of fat liquor to take out the squeak.

Dep. of Gillette, p. 319, marg. 373.

" " on cross-examination, p. 329–330, marg. 384–5–6.

" Wm. H. Combes, p. 352–3, marg. 412.

From which it appears that the substance of the transaction was, that Gillette had procured a *receipt* for treating such skins, of one Smith, in South Dedham, and made trial of it at Mr. Dodge's shop, with casual remarks relating to it.

The *silence* of Messrs. Dodge on the occasion as to the use of fat liquor has no weight in the direction intended, of impeaching their evidence.

Moreover, Gillette and Combes were both familiar with the use of fat liquor for the purpose of softening such leather and removing the squeak, some *two or three years before* this trial of their oat-meal process at Dodge's.

Dep. of Gillette, p. 326, marg. 381.
" " p. 327, marg. 382.
" Combes p. 352, marg. 411.

Mr. Dodge is *confirmed* as to such treatment in 1858 by witness for the plaintiff.

Hevey, pp. 375–6, marg. 438.
" pp. 377–8, marg. 440.

Pretending the purpose of the treatment was to make the skins blacker in coloring. The fact of the treatment is shown by Mr. Dodge also; but the purpose shown to be, to *soften* and *not color*.

Dodge's dep. p. 404, marg. 471.
" pp. 408, 409, marg. 476.

The simple, straightforward, honest evidence of Samuel Dodge, Sen., will not stand impeached by such evidence; nor will his thorough early training, and long subsequent experience of nearly fifty years in the art of kid dressing and finishing, suffer greatly in the comparison with that of the complainant, whose silence deprives us of any information in relation to it; and, at the same time, it conceals from us any want or deficiency therein which might otherwise be exposed; nor with that of his son-in-law, Mr. Fulton, his operator, who left his clerkship in a store in 1865, and entered directly into business, and upon his "experiments" in 1866.

Dep. of Nath'l Bentley, pp. 139, 140, marg. 182, 183.
" J. H. Bentley, pp. 145, 146, marg. 188, 189.

Dep. of Fulton, p. 274, marg. 323–end.
" Plummer, pp. 147, 148, marg. 191, 192.

And those who say they did not know of such process prior to the patent cannot testify it was not in use. *Their evidence is merely negative.*

Brownell, p. 382, marg. 445.
Cuyler, p. 384, marg. 447.
Richardson, pp. 379–381, marg. 442, 443, who confirms rather than rebuts.
Welch, pp. 371, 372, marg. 433, 434, who does only $1,000 to $2,000 worth a year.

The attempt to impeach or rebut the testimony of James L. Northrup utterly fails,—

1st. Because it is only negative, and hardly that in some cases.

2d. Because the witnesses had no adequate knowledge.

Dep. of Newton, p. 389, marg. 453.
" Earle, pp. 385, 386, marg. 449, 450.

The fact that less of such skins were used from 1862 to 1870, or that bark-tanned sheep and lamb skins in the bark-tanned state were used, does not impeach the defendants' evidence of prior use.

The demand for use in the army required them in the bark-tanned state.

Dep. of Cuyler, plaintiff's witness, pp. 383, 384, marg. 447.
" Heacock, p. 120, marg. 160.

The trade in the mitten and glove business has increased four fold in ten years; and great improvement in dressing skins

Dep. of Cuyler, p. 384, marg. 447–end.
" Porter, p. 369, marg. 431.
" " p. 370, marg. 432.

4. This process of employing fat liquor alone in the treatment of leather, including bark-tanned lamb and sheep skins, substantially as described in the patent, prior to the complainant's discovery or invention, was not *experimental; but those who used it had an intelligent comprehension of its character and effects produced.*

This is manifest from the *discrimination between the different qualities and conditions of the skins for treatment with fat liquor alone, or fat liquor with other ingredients adapted to the skin.*

Dep. of Dodge, pp. 191, 192, marg. 328, 329.
" " pp. 196, 197, marg. 244.
" " p. 207, marg. 256; and pp. 213, 214, marg. 262.
" " pp. 230, 231, marg. 277, 278, 279.

And mainly throughout his deposition.

Dep. of Monroe, pp. 103, 104, marg. 143.
" Christie, p. 61, marg. 96, 97.
" Northrup, pp. 67, 68, marg. 104, 105.
" I. V. Place, p. 151, marg. 195.
" Plummer, p. 150, marg. 194.

And others before cited.

It is noticeable that in almost every instance where a witness has indicated by his answer that he had "*experimented*" with such treatment, that the word *experimenting* was adroitly woven into the *question*, and not found in the answer itself; thus eliciting an answer to a technical term, while the witness manifestly intended simply that he employed that treatment in making trial of leather thus finished upon the market; especially in the reported evidence taken at Utica. His experiments were not to test the mode

of operation, and the effect of fat liquor upon the skin, for that was well known; but to test the trade with such gloves.

In applying what they call the Russell process it is a matter of experiment as to quantities and proportions.

Dep. of Gillette, pp. 332, marg. 388-9.

5. It is not a material question whether the result of the use of the process was as perfect prior to said alleged invention as it is now. The vital question is, whether substantially the same process of treatment by fat liquor alone was used prior to said invention.

(1) If the principle and idea is embodied, the invention is perfect. The question is not in regard to the perfection of the *product*, but the substantial identity of the process by which the result is produced.

(2) The perfection of the product is a question of *degree* and not of principle, if the process of treatment is substantially the same, and does not affect the question of priority of invention.

Russell *v.* Klein, p. 146, fol. 717, Hall, J.

(3) It is no part of the invention secured by the patent that the alleged process should remove the "squeak" from the skins.

(*a*) That is one of the alleged *effects* produced by the process, which is not the subject of a patent.

(*b*) It only goes to the question of *degree*, and not to the essence of the invention.

(*c*) Moreover, in the very sample treated by complainants' and introduced in evidence as complainants' "Exhibit No. 1," the *squeak was not removed.*

Hewlett's ev. pp. 290, 291, marg. 341.

IV.

If it be claimed that the matter of the second clause in the reissue is a *material* and *substantial part* of the invention, and this suit can be maintained for a violation of that claim, we reply, —

1. That the defendants have never infringed that claim, and there is no evidence to establish such infringement.

(1) They have never used the compound for such treatment.

Dep. of Whiting for compl'ts, pp. 43, 44, marg. 75, 76.
" Whiting for compl'ts, p. 50, 51, marg. 83, 84.
" Fred'k S. Green for compl'ts, p. 52, marg. 85.
" Putman for compl'ts, p. 55, marg. 89.
" Samuel Dodge, Sen., p. 197, marg. 244, end, and 245.
" I. V. Place, p. 152, marg. 196.

(2) They have never heated the fat liquor to or near the boiling point for such use.

Dep. of S. Dodge, Sen., p. 229, marg. 277.
" " p. 197, marg. 244; and p. 205, marg. 253, 254.
" I. V. Place, p. 152, marg. 196.

(3) *In fact, the application of heat to fat liquor for the purposes mentioned in the patent was well known and in general use prior to the alleged invention of complainant, but without its having been heated to or near the boiling point.*

See reference to evidence under third sub-division of the third general point, p. 23 of this brief.

(4) But the application of heat in any way to the compound of the second claim defendants never employed, as they never used the compound.

(1) Any use that defendant, Samuel Dodge, Sen., may have made of the ingredients of said compound was the same before the alleged invention as after.

2. *The patent cannot be sustained upon the second claim as matter of law.*

(1) The patentee in his oath accompanying the applicatoin for reissued Letters Patent declares "that he verily believes that by reason of an insufficient and defective specification his aforesaid Letters Patent are inoperative and invalid"; and the specification in the reissued patent is substantially in all respects the same as the original so far as relates to the second claim. See p. 271, marg. 319, 320 (the oath).

(*a*) The only condition on which the reissue can be obtained and jurisdiction in the commissioner to act upon it, is that the original patent is inoperative or invalid by reason of such insufficient and defective specification. The proceeding is therefore equivalent to a distinct admission made under the solemnity of an oath, that the original patent (and hence the second claim in the reissue) has no validity in the sense of entitling a patentee to an action for an infringement.

Moffitt *v.* Garr, MS., Leavitt, J., Ohio, 1860.
Laws' Dig. p. 616, § 49.

(2) If the use of fat liquor alone as described in the specification is a material and substantial part of the invention, and essential on that account to making the second claim operative and valid, then the second claim is invalid because the use of fat liquor alone is old.

(3) Because the proportions of the elements are indefinite, as stated under first point.

And for the reasons before stated.

(4) In the case at bar it cannot be held that the claim in the reissued patent of the use of fat liquor alone in such process was made through inadvertence, accident or mistake, so that he might disclaim it under the statute § 54 chap. 230 of Acts of 1870, since it is the only and distinctive new matter interpolated into the old patent by the reissue.

V.

If the complainant used his alleged invention under either claim more than two years before he applied for his patent for dressing bark-tanned lamb and sheep skins which he put upon the market, this amounted to an abandonment of his right to a patent, and he cannot recover.

(1) He did so use it, as well as he knew, until he learned of Place, Dec. 31, 1869.

Dep. of Uriel Case, pp. 168, 169, 170, marg. 214, 215.
" " pp. 174, 175, marg. 220, 221.
" Isaac V. Place, pp. 159, 160, 161, marg. 204, 205, 206.
" Fulton, p. 32, marg. 63.
" Combes, p. 352, marg. 411, 412.
" Dodge, p. 202, marg. 249, 250.
" Porter, pp. 368, 369, marg. 429, 430.
Law. U. S. Stat. at large, p. 208, Acts 1869 and 1870, ch. 230, § 61, 5th sub-division.

It is significant that the complainant, though competent as a witness and present at taking of evidence, did not offer himself as a witness to deny or contradict the evidence of Dodge, Monroe and others, as to giving to plaintiff his information of the alleged improvement.

It should be considered therefore not only as uncontra-

dicted but as admitted by plaintiff; and it shows clearly that he was not the first and original inventor of the process.

VI.

Complainant's counsel denies such prior use of his alleged process, and attempts to contradict or impeach the evidence of defendants, but fails in the attempt.

1. It is suggested by complainant in argument, that his alleged process must be new, from the consideration that such treatment of bark-tanned lamb and sheep skins for the purpose of making them soft and suitable for gloves is more generally in use than before the patent.

(1) This argument does not define or discriminate between the two claims as to which process or treatment under the respective claims has recently gone into more general use.

(2) The complainant claims that the treatment under the second claim is especially *his process.*

Dep. of Gillette, p. 324, marg. 379.
" Fulton, pp. 35–36, marg. 66–67.

(3) There is no evidence that such increased number of bark-tanned lamb and sheep skins, softened and used for gloves, were so softened by the process described in the second claim of the patent, except those treated by Russell & Co. and by Gillette.

(*a*) While the evidence is positive that fat liquor alone was used by defendants in the same manner substantially as they had done many years prior to complainant's invention, and if that had gone into more general use, it was but a greater *demand* and use of an old thing.

See evidence before cited under head of Want of Novelty.

(4) The laws of trade, of demand and supply, regulate the amount required of a particular article for use.

(*a*) The demands of trade are regulated greatly by the supply of the varied materials for manufacture to meet such demand.

And also by the varying fancies of style and fashion.

(*b*) The public might have but slight call for gloves under the plain, honest name of *bark-tanned sheep or lamb skins*, yet crowd the market places for the same article under the fancy name of *dog-skin* gloves.

(*c*) Again, the state of the art as to degree of finish given a particular article affects the demands.

If bark-tanned sheep and lamb skins treated with said process alike were at one time made only into a coarser style of gloves for men and boys, and at another into nice button tops or ladies' gauntlets, under the style of dog-skin gloves, the demand for them would be widely different.

(5) The glove trade, both in style and material for manufacture, has greatly changed in Gloversville, and the trade generally within a few years.

Dep. of Cuyler, p. 384, marg. 448.
" Porter, p. 369, marg. 431.

Hence we submit that the circumstances of such increased use of such skins treated with fat liquor ought not to *impeach*, witnesses like James L. Northrup, Philander Heacock, Henry E. Krause, Samuel Dodge, Sen., Isaac V. Place, James F. Place, James B. Chapman, Jonathan Ricketts, Samuel Dodge, Jr., Wm. H. Monroe, Uriel Case, Henry Hull, John W. Place, and the others to whose evidence reference has been made.

(2) The next offer of impeaching evidence against and in reply to defendants' proofs of want of novelty, is to show that if the skin be permitted to remain in the fat liquor as

long as stated by some of the witnesses, it would spoil the skin; and that but one dipping, and of short time in the liquor, is the method under the Russell process.

John Fulton, pp. 272, 273, 274, marg. 322, 323, 324.

(1) The time which it is safe to allow the skins to remain in the fat liquor depends upon the alkaline strength of the liquor.

Samuel Dodge, Sen., p. 405, marg. 473.
Isaac V. Place, pp. 410, marg. 478, end.

(2) The strength of fat liquor varies according to the time it is taken out in the scouring of deer skins, the kind and condition of the skin when taken, and the degree of reduction by water afterwards.

Christie, p. 59, marg. 94.
Dodge, p. 205, marg. 253.

No cast-iron rule as to time can be established, but the time the skin may remain in the liquor must be determined by the skill of the operator, depending upon the strength of the liquor, its temperature, and the quality of the skin.

Instance. — Those of Jeffries & Co., tried unsuccessfully by Russell & Co., and afterwards successfully by Dodge.

Dep. of Bentley, pp. 139, 140, marg. 182, 183.
" " pp. 145, 146, marg. 188, 189.

(3) Neither the length of time the skins are to remain in the fat liquor when so dipped, nor the strength of the fat liquor to be used, are stated or defined by the patent; and if those elements are essential to the process, such omission is fatal to the validity of the patent.

If such elements are so uncertain and indefinite as to require

trial and experiment to make the alleged invention practicable, the patent is void.

Wood *v.* Underhill, 5 How. 1.
Tyler *v.* Boston, 7 Wal. 327.
Parker *v.* Stiles, 5 McLean, 54.

The specification is not in such full, clear, concise and exact terms as to enable any person skilled in the art to use said alleged invention as stated in the *second* claim, as required by statute, ch. 230, § 26, Acts of 1870.

Dep. of Gillette, p. 335, marg. 391.
" " pp. 331–2, marg. 387.
" Fulton, pp. 284, 285, marg. 335, 336.

And this is what he calls the Russell process.

Fulton's dep. pp. 33, 34, marg. 64–65.
" " p. 55, marg. 66, 67.
" " p. 287, marg. 338.
Gillette's dep. pp. 331, 332, marg. 387, 388.

The specification expressly states that the proportions of the ingredients may be more or less varied.

The "principal feature of the invention" consists in the *employment of fat liquor.*

The fat liquor is made from an oil cut with a suitable alkali, or obtained by "scouring deer skins after tanning in oil."

See specification, p. 16, marg. 40.

And the fat liquor procured from scouring deer skins consists of oil, alkali and water.

Dep. of Fulton, p. 36, marg. 67.

Soap has the same constituents.

Dep. of Fulton, p. 36, marg. 67.

Salt only makes the leather moist and preserves it.

Dep. of Fulton, p. 36, marg. 67.

Mr. Dodge says if his fat liquor is mostly out and he wants to make more, he "*adds soap, sal-soda and water*" to make it more.

It requires the skill, in the business, of a man like Mr. Dodge to proportion and apply said ingredients, as the skin requires, to make it useful.

Hence, if the compound is anything in fact and effect more than fat liquor, the great latitude of proportions in the specification, and utter absence of "clear, concise and exact terms," so as to enable a person skilled in the art to prepare and apply the so-called Russell process from the specification alone, invalidates the patent.

And if the compound is only in substance and effect the same as fat liquor, then the description and distinct claim for the compound invalidates the patent.

T. L. WAKEFIELD,
of Counsel.

IN THE

SUPREME COURT

—OF THE—

UNITED STATES.

IN EQUITY NOS. 134 AND 135.

APPEAL FROM THE CIRCUIT COURT OF THE UNITED STATES, FOR THE NORTHERN DISTRICT OF NEW YORK.

NATHAN C. RUSSELL, Appellant,

v.

ISAAC V. PLACE, et al.

NATHAN C. RUSSELL, Appellant.

v.

SAMUEL DODGE, Sen. et al.

APPELLANT'S BRIEF.

HORACE E. SMITH, Solicitor,

and of Counsel for Appellant,

Johnstown, N. Y.

GLOVERSVILLE:

"TIMES" STEAM POWER PRESS PRINTING HOUSE.

1876.

IN THE

SUPREME COURT

OF THE

UNITED STATES.

NATHAN C. RUSSELL, Appellant, *vs.* ISAAC V. PLACE, and JOHN W. PLACE. } ***No. 134.***

NATHAN C. RUSSELL, Appellant, *vs.* SAMUEL DODGE, Sen. & SAMUEL DODGE, Jun. } ***No. 135.***

STATEMENT OF CASE.

These are suits for infringement of complainant's patent for the treatment of leather; and come before this court on appeal from the Circuit Court of the United States for the Northern District of New York, by whose judgment and decree complainant's bills were dismissed.

Most of the proofs were taken in the last named suit; but by stipulation, so much of the testimony as might be admissible in the first, was to be deemed and used as evidence therein; and the two causes were argued together in the Circuit Court.

By stipulation, also, all proper grounds of objection to questions and evidence were left open for the hearing. (Printed Record in No. 135, p. 25, fol. 52. For convenience, this record is adopted for all the references, except when No. 134 is specified.)

Complainant's patented invention consists in a process for preparing bark-tanned sheep and lamb skins for gloves, by the agency mainly of "fat liquor," an article produced by scouring deer skins after tanning in oil. Bark-tanned leather, before treatment is harsh, squeaky, and unfit for gloves; but the patented process removes the "squeak," and renders it soft and pliable, and suitable for a fine glove.

This treatment, costing only from twelve to twenty-five cents per dozen skins, enhances their value two dollars per dozen, at least, and furnishes a cheaper material for gloves than any other in the market, of the same quality and value.

For many years prior to this invention, there had been a scarcity of suitable materials for gloves, and, although the bark-tanned sheep and lamb skins were plenty and cheap, they were used for that purpose to a very limited extent only. But on the publication of complainant's patent, this improved leather immediately came into general use, and the business was to a large extent, revolutionized.

The patentee claims, and has patented two things:

1. A novel treatment of bark-tanned sheep or lamb-skins, by *heated fat liquor*, substantially as described in the specification; and,

2. The treatment of such skins with a heated compound, composed and applied substantially as specified.

PLEADINGS.

The bills of complaint, filed January 18th and 29th 1872, set up.

1. The invention by complainant, and the issuing to him of letters-patent, bearing date August 17th, 1869.

2. The surrender of said letters-patent, on account of defective and insufficient description, specification and claim, and the issuing of new letters-patent for the same invention, bearing date the 1st day of February, 1870.

3. The infringement by defendants since the re-issue.

4. An action at law by complainant against the above named Isaac V. Place and John W. Place, of Johnstown, for a violation of the re-issued patent, in which defendants pleaded the general issue, and gave notice of special matter impugning the validity of said

patent on account of prior knowledge and use, and otherwise; a trial thereof by jury on the 11th and 12th days of October, 1870, before Judge Woodruff, and a verdict for plaintiff.

That a motion for a new trial was made therein, and overruled on the merits, and judgment rendered for plaintiff, against said defendants, on the 4th day of November, 1871, for $1,200 damages besides costs.

5. An action at law by complainant against Albert Klein, of Johnstown, for a violation of said re-issued patent, in which defendant pleaded the general issue, and gave notice of special matter impugning the validity of the patent on the ground of prior knowledge and use, and otherwise; a trial thereof by jury before Judge Hall, in March, 1871, and a verdict for plaintiff.

That a motion for a new trial made therein and overruled, and judgment rendered for plaintiff, October 10th, 1871.

6. That on the trial of these actions, Samuel Dodge, Sen., one of these defendants, was called by and examined as a witness for the defendants, and was fully cognizant of all the proceedings in said actions.

7. Complainant's request of defendants, to refrain from further infringements, and to account and pay damages and profits, &c.; defendants' neglect and refusal to comply with such request, and their combination with the said Place and Klein, and others, to violate said patent, and deprive complainant of his rights thereunder.

8. Prayer for an accounting, for damages, and an injunction.

(P. p. 1 to 6. fols. 5 to 11. inclusive; and in No. 134 p. p. 1. to 5. fols. 5 to 10. inclusive.)

THE ANSWERS OF DEFENDANTS.

1. Admit the granting of the original letters-patent to complainant; but denies that he was the first or original inventor, &c.; and denies that the same had not been known and used before the alleged invention or discovery thereof by complainant.

2. Admits that complainant did obtain new and re-issued letters-patent; but denies that he was the first or original inventor, &c.; and denies that the same had not been known and used before the alleged invention by complainant.

3. Aver that defendants have no knowledge, and cannot say whether or not the description and specification in the original patent were defective or insufficient; but denies that the same were defective or insufficient through inadvertance or mistake, and without any fraudulent intention.

4. Deny that the complaint complied with the requirements of law in respect to procuring re-issued letters-patent; denying that the amended specification was in such clear, full or exact terms as to enable any

person skilled in the art, &c., to make and use the same; that the re-issued letters-patent were granted according to law; or that by virtue of the grant thereof complainant became the sole and exclusive owner of the rights and privileges alleged to be secured thereby.

5. Allege, on information and belief, that the original letters-patent were invalid and void. That the same were not surrendered to correct any mistake or inadvertance, &c., but to claim other alleged inventions or improvements, not made, invented, or discovered by complainant; that they were surrendered with the fraudulent intention to deceive and mislead the public, and that so far as they differ from the original, they are not for the same alleged invention or improvement.

6. Allege that the original letters-patent were not inoperative or invalid by reason of defective specification; and denies upon information and belief, that complainant, in his application for such re-issue, complied with the requirements of law; and aver that complainant, under pretense of a defective specification, in fact obtained his re-issued patent upon the same specification contained in the original letters-patent, without any material or substantial variation therefrom, except in the addition of the first claim, which was not new.

7. Allege that the specification in the re-issue contains less than the whole truth, and more than was

necessary to produce the desired effect; and this for the purpose of deceiving the public.

8. Allege that the patented process had been in use and on sale more than two years before complainant's application for a patent, with his knowledge and consent, and had been abandoned to the public.

9. Admit the actions at law and trials as mentioned in the bill of complaint, and that the defendant, Samuel Dodge, Sen., was sworn and examined as a witness on said trials; but deny knowledge of defendants as to the issues framed or tried in said causes. And allege that in the case against Klein, a writ of error to the Supreme Court of the United States had been prosecuted, and was then pending and undetermined.

10. Deny infringement by defendants; but say that for many years prior to complainant's alleged invention, defendants had and still were engaged in dressing, treating and preparing skins and leather,—including bark-tanned sheep skins,—for gloves and mittens; and for that purpose had used a process well known to them and others, for more than two years prior to complainant's alleged invention, and that unless the process so used and known is substantially the same patented by complainant, defendants have not used said patented process.

11. Allege the prior knowledge and use of the patented process, giving names and places.

12. Allege that said patented process was, before the alleged invention or discovery thereof by complainant, described in the following named printed publication, viz: "Chemistry as applied to arts and manufactures," by Dr. Sheridan Muspratt, Vol. 2, pages 491, &c.

13. Allege that the patented process is an old and well known process to those engaged and skilled in the trade and business with which it is connected, and had been in public and familiar use for a great number of years before complainant's alleged invention or discovery.

14. Deny all manner of unlawful combination and conspiracy.

(P. p. 6 to 10, fols. 12 to 18, inclustve; and in No. 134 p. p. 5 to 9; fols. 11 to 16 inclusive.)

To the answer complainant interposed the usual replication.

(P. 11, fol. 19; and in No. 134, p. 10, fol. 18.)

ASSIGNMENT OF ERRORS.

I. The Circuit Court erred in its construction of complainant's patent, to-wit; in holding and deciding that it covered and claimed the use of *cold* fat liquor,

pure and simple; and that the patented process did not require *heated* fat liquor.

(P. p. 418 and 419.)

II. The Circuit Court erred in giving judgment for defendants for a dismissal of the bill of complaint; whereas by the law of the land, the judgment and decree ought to have been given for complainant, against defendants.

(P. 13, fol. 29; and p. 424, fol. 498; and in No. 134, p. 11, fol. 28; p. 418, fols. 489 and 490.)

III. The Circuit Court erred in denying complainant's motion to strike out from the evidence of the witness Nathaniel Bentley, that portion of his evidence which related to a conversation between his brother and John Fulton, not heard by witness, and to which he testified from hearsay.

(P. 140, fol. 184.)

IV. The Circuit Court erred in denying complainant's motion to strike out the testimony of James F. Place, a witness called by defendant to sustain his answer of prior knowledge and use, his name not appearing in the answer, and no notice of his production as a witness having been given, in compliance with the statue.

(P. 249, fol. 296.)

V. The Circuit Court erred in permitting the witness, Nathaniel Bentley, notwithstanding complainant's objection and exception, to testify to the compara-

tive condition and quality of certain lots of skins treated for him by complainant and defendants, respectively.

(P. p. 140 and 141, fols, 183, 184, and 185.)

VI. The Circuit Court erred in permitting the witness, Sidney S. Plummer, notwithstanding complainant's objection and exception, to testify to the comparative condition and quality of skins treated for him by complainant and defendants, respectively.

(P. p. 147 and 148; fols, 191 and 192.)

VII. The Circuit Court erred in permitting the defendants notwithstanding the objection and exception of complainant, to ask and receive answers to the following questions, to-wit:

1. To the witness, William H. Monroe: "State, if you know, whether or not the application of fat liquor to bark tanned sheep and lamb skins, has been used as a process to render such skins soft and pliable, and to remove the squeak from them; and if so, for what length of time, and by whom?"

(P. 86, fol. 126.)

2. To the same witness: "State whether or not the use of fat liquor upon bark-tanned sheep and lamb skins has been understood and adopted by you in the manner stated by you, as a process for rendering such skins soft and pliable and removing the squeak therefrom, for any number of years; and if so, for how many years?"

(P. 87, fol. 127.)

3. To the same witness: "State, if you know, whether the application of fat liquor to bark-tanned sheep and lamb skins has been a well known and perfected process for softening such skins and making them pliable, and removing the squeak from them; and if so, for how long a time have you known and understood such process?"

(P. 87, fol. 127.)

4. To the witness Henry Hull: "State whether or not, in the use of fat liquor by you since 1869, you used it in substantially the same manner as you did that used by you prior to 1869?"

(P. 129, fol. 171.)

5. To same witness: "State, if you know, whether or not it produced substantially the same effect upon the skins?"

(P. 129, fol. 171.)

5. To the witness, Uriel Case: "State, if you know, whether or not Russell, the plaintiff, has, ever since he removed from Fulton street on Bleecker street, used in his business the same kind of skins, treated in the same manner as those you saw on the fences, heretofore mentioned by you in your testimony in this case?"

(P. 169, fol. 215.)

7. To the same witness: "State, if you know, whether the plaintiff, Russell, about the time of the commencement of the war and prior thereto, manufactur-

ed gloves, extensively or otherwise, from the kind of skins you saw on the fences on Fulton street, as detailed by you, and treated as those were?"

(P. 170, fol. 216.)

8. To witness, Samuel Dodge, Sen.: "Has your treatment of bark-tanned sheep and lamb skins for two years past with fat liquor been the same, or substantially the same, in each instance?"

(P. 146, fol. 213.)

9. To the same witness: "Did you learn from an examination of your books on Saturday last the number of bark-tanned sheep and lamb skins you treated for Daniel B. Judson about that time; and if so, state the number?"

(P. 200, fol. 248.)

10. To the witness, Charles G. Tinsley: "In ouyr answer, on your direct examination, to interrogatory No. 21, did you give the question asked the witness and his answer thereto in full? And if you did not, please do so, together with the four following questions and answers?"

(P. 298, fol. 350.)

11. To the same witness: "Please give the next four questions and answers of the witness following the answer given by you on your direct to interrogatory No. 54?"

(P. 299, fol. 351.)

12. To the witness, George W. Gillette: "About how many dozen pair of gloves did you make in 1865 from bark-tanned sheep and lamb skins, treated in the manner you have stated by the fat liquor process given to you by Monroe in that year?"

(P. 327, fol. 382.)

VIII. The Circuit Court erred in holding and deciding that the trial and judgment in the action at law, between this complainant as plaintiff and the Places as defendants, was not a bar, or conclusive evidence between the same parties upon the issues involved and litigated in said action, covering the questions touching the validity of the patent.

(Record in No. 134, p. 418, fol. 489.)

HISTORY OF THE PATENT, AND LITIGATION UNDER IT.

The original letters-patent bear date, August 17th, 1869.

(P. 2. fol. 6; and p. 269. fol. 317.)

The application was made five or six weeks prior to that time.

(P. 37, fol. 68.)

For several years prior to the application, complainant had been experimenting with fat liquor in various ways, seeking a cheap and reliable process by which bark-tanned sheep and lamb skins could be rendered suitable for gloves, but he did not perfect the invention until about the time of his application for a patent.

(P. p. 37, 38, and 39, fols. 68, 69 and 70.)

Complainant subsequently surrendered his original letters-patent on account of a defective specification and claim, and received a re-issue for the same invention, bearing date, February 1st, 1870.

(P. p. 15 and 16, fols, 38 to 41; p. p. 269 to 272, inclusive.)

On the 20th day of June, 1870, complainant commenced two ~~suits~~ actions at law for an infringement of his patent; one against Isaac V. and John W. Place, defendants in the ~~second~~ first of the suits at bar, and the other against Albert Klein.

(P. 17, fols, 41 and 42; p. 25, fol. 53.)

The first named ~~suit~~ action was tried before Judge Woodruff, and a jury, at Albany in October, 1870, and resulted in a verdict for the plaintiff.

(P. 21, fol. 47.)

The second was tried before Judge Hall, (in place of Judge Woodruff.) and a jury at Utica, in March, 1871, and also resulted in a verdict for the plaintiff.

(P. 28, fol. 57.)

In both these ~~suits~~ action the defences of a want of novelty and prior use, together with other special matters here in issue, were set up; and the question of prior knowledge and use was the prominent one mooted on the respective trials. This will appear from the judgment rolls, and also from the opinions of Judge Woodruff on the motions for a new trial.

(P. p. 19 and 20, fols, 45 to 47; p. p. 27 and 28, fols. 56 and 57; p. p. 22 to 25, fols. 49 to 52, inclusive; p. p. 29 and 30, fols. 59 and 60.)

A motion for a new trial in each of these cases, on various grounds, was made and argued before Judge Woodruff at Canandaigua, in March, 1871.

(P. p. 21 to 24 inclusive; and p. p. 28, 29 and 30.)

At the following October term, the decisions were announced. In the Place suit, motion was denied upon all the grounds of alleged error except that of excessive damages. On this point, the court found that the verdict exceeded the actual damages proved; and for this reason ordered a new trial, unless plaintiff would remit the excess; in which case, it was ordered that judgment be entered for $1,200, and costs, under the provisions of the statute authorizing the court to award increased damages. The plaintiff elected to remit, and judgment was entered accordingly, November 4th, 1871.

(P. p. 22, 23 and 24; p. 21, fol. 47.)

In the Klein case the motion was denied uncon-

ditionally, and judgment perfected upon the verdict, March 18th, 1872.

(P. p. 29 and 30.)

After the decision of the motions for a new trial, the defendants in the respective actions applied to the court for leave to turn the cases into bills of exception or special verdict, with a view of prosecuting a writ of error to this court. The motion was denied in the case of Place, but granted in the Klein case.

(P. 21, fol. 47; p. 29, fol. 59.)

The suits now before the court were commenced, the first above entitled, January 29th, 1872; and the second, January 18th, 1872.

(P. 1, fol. 1; and in No. 134, p. 1, fol. 1.)

The Klein case above named was then pending in this court on writ of error, and was not decided till after decision of the cases at bar in the court below.

The decision of this court in the Klein case was announced in March, 1874, and is reported in 19 Wall. 433.

POINTS AND PROOFS.

The question mooted upon the trial, and argument in the court below, and to which most of defendant's evidence and contention were directed, were three: 1, prior knowledge and use of the patented process; 2, abandonment to the public by complainant; and, 3, invalidity of the re-issued patent.

The proofs to which it becomes necessary to call the attention of the court, can, it is believed, be most conveniently presented and examined in connection with the discussion of these questions, and in considering some of the alleged errors of the court below.

I

THE UTILITY AND VALUE OF THE PATENTED PROCESS.

The evidence shows conclusively—

First. That Gloversville is the principal place in the United States for the manufacture of leather gloves and mittens, having over a hundred manufactories in the village, and doing a large business annually; and that the business has been and is gradually and constantly increasing.

(Dep. of John Fulton, p. p. 31 and 32, fols, 60 and 61; and dep. of Samuel Dodge, Sen. p. p. 226 and 227, fol. 274.)

Second. That the demand for suitable stock drives manufacturers to all parts of the world for a supply, and to the use of almost every known kind of skins.

(Dep. of John Fulton, p. 31, fol. 62.)

Third. That sheep and lamb skins, in the bark-tanned state, are cheap and plenty compared with other materials used; but, from their harsh and squeaky character while in that state, are wholly unfit for gloves.

(Dep. of John Fulton, p. 31, fols. 61 and 62; and Dep. of Daniel S. Hulett, p. 289, fol. 340.)

Fourth. That the complainant's patented process, at a very small expense, converts this class of skins into a suitable and profitable material for a fine, good glove.

That, at an expense of from twelve to twenty-five cents, it enhances the value of the skins, at least, $2.00 per dozen.

That, when thus treated, these skins are worth considerably more for glove purposes than any other material in use of the same cost.

(Dep. of John Fulton, p. 31, fol. 61 and 62; p. p. 274 and 275, fol. 324; and dep. of Geo. W. Gillette. p. p. 318 and 319, fol. 372.)

Fifth. That, during the entire history of the glove

business in Gloversville and vicinity, prior to this patent, there was felt a want of, and a search for some process by which bark-tanned skins could be made available; but no process sufficiently cheap was found that met the want.

This is apparent from the tenor and scope of the whole evidence; but it is particularly and very clearly demonstrated by the defendants in the crude experiments they have shown, scattered all along the history of the business, as will be seen in the further discussion of the case.

Sixth. That no such leather as is produced by the patented process, was made from bark-tanned sheep and lamb skins prior to the date, or about the date of the patent.

All the specimens of leather suitable for a good glove, made from bark-tanned sheep or lamb skins, shown or known to have existed prior to complainant's invention, were produced by some other, more expensive, and less satisfactory treatment, than the patented process.

Seventh. That immediately following the publication of complainant's invention, it was extensively adopted and largely used by the manufacturers; and that goods made from leather treated according to his process were, and still are in great demand.

Moreover, a combination among manufacturers was formed to break down the patent, and the discovery

was suddenly made by the conspirators, that they had always understood the process.

(Dep. of John Fulton, p. p. 31 and 32, fols, 61 and 62, and references under following points.)

These several propositions are also established by other evidence, scattered through the case.

II.

COMBINATION AND CONSPIRACY.

The evidence shows, clearly enough, a combination and conspiracy on the part of these defendant's and others, to break down the patent.

First. In the ~~suits~~ actions at law, before mentioned, Samuel Dodge, Sen., one of the defendants, was a witness for the defence, and testified to his prior use of fat liquor.

(Dep. of John Fulton, p. 32, fol. 62; and Dep. of Samuel Dodge, Sen., p. 206, fol. 254.)

Second. At the trial of the Place suit in Albany, Klein, defendant in the other action at law before mentioned, was present, though not subpœnaed or sworn as a witness.

(Dep. of Isaac V. Place; p. 153, fol. 198.)

Third. Seeing the result of the Place trial, Klein

was disposed to refrain from further opposition to the patent, and settle with Russell.

Place, on learning this, went to Klein, dissuaded him from a settlement, and entered into an agreement with him to join in defending their actions, and share the expense.

(Dep. of Isaac V. Place, p. 154, fol. 199.)

Fourth. Place employed counsel to try the Klein case, was present at the trial with witnesses subpœnaed and paid by him, and afterwards caused it to be removed to this court by writ of error, and prosecuted by his own counsel.

(Dep. of Isaac V. Place, p. 154, fol. 199; and Dep. of John W. Place, p. 185, fol. 232.)

Fifth. Immediately after the commencement of the suits at bar, Place conferred with other manufacturers in relation to raising funds for the purpose, and joining to defend against Russell's patent.

In pursuance of this scheme, he prepared and circulated a subscription paper, and it was signed by Samuel Dodge, Sen., one of these defendants.

(Dep. of Isaac V. Place, p. p. 155 and 156, fols. 200 and 201.)

Sixth. On the same day these suits were commenced, or the next, Place and Dodge had a conference in regard to the defence; and Place looked up, subpœnaed and paid witnesses in the suit against Dodge, employed and paid counsel, attended the examinations, *and testified as a witness.*

(Dep. of Isaac V. Place, p. p. 154–5, fol 201.)

It is impossible to determine the extent and power of this combination, for an early exposure suggested caution and secrecy to the parties; but enough appears in the evidence, directly and inferentially to show that it is formidable.

It encouraged infringements, and, to a large extent, deprived complainant of the benefit of his patent. At the hearing of these causes, there were fourteen persons and firms in Gloversville engaged in the piratical manufacture and sale of gloves made from the improved leather in question, known to one witness; and this use of the patented process depreciated the market price of such gloves, to the extent of $3 per dozen.

(Dep. of John Fulton, p. 64, fol. 100.)

This combination was felt on the hearings, and will be seen in the evidence of some of defendants' witnesses, when their swift and wholesale statements on the direct, are contrasted with the "lame and impotent conclusions" of their evidence on the cross examination.

III.

INFRINGEMENT BY DEFENDANTS, DODGE.

The proofs upon this point are as follows:—

First. *Marvin J. Whiting*, testifies that he was in defendants' employment from January, 1867, to the last

day of December, 1870, four years. That they *commenced* the use of fat liquor in the fall of 1870; *they had not used it about their business prior to that time,* to his knowledge, and he had ample opportunity of knowing what processes and materials they had used.

That they treated about two lots, of from thirty-five to sixty dozen each every fortnight for the space of two or three months.

That a barrel of fat liquor, as used by them, would treat from thirty-five to forty dozen skins.

That they heated the fat liquor by pouring hot water into it, until the mixture was raised to a temperature described by the witness as "hand bearable."

That they then immersed the skins in the heated liquor, allowing them to remain in from three to five minutes.

That prior to this treatment the skins were squeaky, not pliable, and not suitable for gloves; but after dipping, they were soft and pliable, the squeak was gone from them, and they were suitable for gloves.

This witness further testifies that, on different occasions while defendants were thus treating skins, Samuel Dodge, Jr., told him not to allow Mr. Russell's boy, a young man about 18 years old, or strangers, near the inclosure where they were at work; and that they did not, on other occasions, manifest any desire to keep strangers from any part of their business premises.

That, on one occasion while they were dipping skins as described, Samuel Dodge, Jr., said, *"that Mr. Russell could go to hell with his patent; he has got to find out how we do it."*

Samuel Dodge, Jr., was afterwards examined as a witness for defendants, but did not venture to contradict Whiting in regard to either of these statements.

(Dep. of Whiting, p. p. 42 to 45, fols. 74 to 78, inclusive. Dep. of Samuel Dodge, Jr., p. p. 234 to 237, fols. 282, 283 and 284.)

Second. Frederick S. Green, testifies that he was in the employment of defendants from the fall of 1868, till January, 1871, something over two years.

That they *commenced* the use of fat liquor on bark-tanned sheep and lamb skins in the summer of 1870, and continued it up to the time he left; that he had previously had free access to all parts of their business premises, and never saw any fat liquor there previous to this in the summer of 1870.

His description of their mode of preparing the liquor and treating the skins, is substantially the same as that of Whiting.

He estimates that from June, 1870, to January, 1871, they treated on an average, a lot of about fifty dozens each week; and that a barrel of fat liquor would treat, as they did it, about 20 dozen skins.

(Dep. of Green, p. p. 51 and 52, fols. 84 and 85.)

Third. *Morgan Putman*, one of defendant's employees at the time of the hearing, and who had then been with them for the last seven years, testifies that they *commenced* the use of fat liquor for the treatment of bark-tanned skins in 1870, and had continued it ever since; and that they did not, to his knowledge, use it prior to the summer of 1870.

That they had since averaged with this treatment about two batches of forty dozens each, a week, making eighty dozens per week.

That defendants observed secrecy in their use of this process, manifested by excluding persons from the room in which, and during the time the skins were being so treated; while at all other times they had free access to that room, and to all parts of the premises.

(Dep. of Putman, p. p. 54 and 55, fols. 88 and 89.)

It seems that defendants, after treating the skins with fat liquor as described by their workmen, revolved them in a drum for about five minutes, and then put them into warm water to smooth them out.

But this process merely supplemented the fat liquor treatment, and had no necessary connection with it.

(Dep. of Whiting, p. p. 48 and 49, fols. 81 and 82; and
Dep. of Green, p. 51, fols. 84 and 85.)

Fourth. It appears from the evidence of *Dr. Charles H. Porter*, a distinguished chemist of Albany, that heating fat liquor with hot water, as practised by defendants,

is substantially the same in effect as by heating with fire applied directly to the containing vessel.

This witness had experimented carefully with fat liquor in reference to this patent, both at the request of Mr. Russell, and of Isaac V. Place, one of defendants.

(Dep. of Dr. Porter, p. 394, fol. 460; p. 392, fol. 457; and p. 395, fols. 460 and 461.)

Fifth. *James Christie*, who had been producing fat liquor in his oil dressing skin mill for the last 25 years, testified that he commenced selling fat liquor to defendants in 1869 or 1870.

Between February, 1870, and February, 1872, he furnished them four barrels; and considerably more in 1872, down to the date of his examination in August of that year; but the quantity he was not able to state definitely.

(Dep. of Christie, p. 56, fol. 91.)

Sixth. *Lewis P. Johnson*, another skin dresser, sold defendants 150 forty gallon casks of fat liquor, between February, 1870, and February, 1872.

(Dep. of Johnson, p. 65, fol. 101.)

Seventh. *John W. Place*, one of defendants, testifies that since February, 1871, defendants Dodge had treated bark-tanned sheep and lamb skins for defendants Place, as many as a thousand dozen; that he could not swear the number was not as large as 1,500 dozens; and 2,000 dozens was the lowest number he would

fix as a limit, which he was willing to swear the number did not succeed.

(Dep. of John W. Place, p. p. 186 and 7, fol. 233.

Eighth. *Samuel Dodge, Jr.*, testifies that since 1869, they had treated from 1,200 to 1,800 dozens per year with fat liquor, as described, and he will not swear that the average per year has not been as high as 2,000 dozens; and that the number has been increasing each year.

(Dep. of Samuel Dodge, Jr., p. p. 246 and 247, fols. 293 and 294.)

Ninth. *Samuel Dodge, Sen.*, testifies that since about two years ago, they had treated about 40 dozens per week.

(Dep. of Dodge: Sen., p. 196, fol. 243.)

Tenth. *Daniel B. Judson*, testifies that defendants treated 497 3-12 dozens for him in 1870; 777 4-12 dozens for him in 1871; and he estimates from 600 to 800 dozens in the year 1872.

(Dep. of Judson, p. 260, fols. 307 and 8.)

Eleventh. But the defendants say that, in their treatment, they subject the skins twice to the fat liquor.

1. This is probably not true, except in cases where they fat liquor for "dampening down" the skins preparatory to shaving.

All skins that require shaving are subjected to a preparatory dampening process, as will more fully appear in further references to the evidence, and cold fat liquor is some times used for the purpose. And some of the skins treated by defendants, while the witnesses Whiting and Green were with them had, and others had not been shaved before coming to their hands.

These witnesses, on being recalled after defendants were examined, both testified that defendants did not subject the skins more than once to fat liquor, when they had been previously shaved.

(Dep. of Whiting, p. p. 356 and 7, fol. 416; and Dep. of Green, p. 364, fol. 425.)

2. It is none the less an infringment, however, if they did repeat the dipping, even if both immersions were for the purpose of improving the leather after shaving.

The evidence now collated on this point, shows very clearly,

First. That defendants have extensively infringed the patent.

Second. That they have done it willfully and deliberately, knowing that their use of the patented process was piratical.

Third. That they intended to conceal their use of it from conplainant by secrecy, and to avoid responsibility by unsubstantial variations from the formula of the specification.

Fourth. That the pretence of their prior knowledge of the process, is wholly false.

Neither of the three witnesses taken from their factory, had known of its use by them prior to 1870; and it was about that time that their purchase of fat liquor commenced. From 1870, up to the time of their examination, they had been using it largely, and increasingly from year to year.

They do not, in their testimony, pretend that they used fat liquor to any considerable extent prior to complainant's patent; nor do they assign any reason for their greatly increased use of it after publication of the patent, consistent with the hypothesis of prior knowledge.

But what is conclusive against them on this point is, *the consciousness of wrong doing* manifested by them in 1870, when they commenced their infringements.

Had the patented process been familiar to the public for years, as is claimed; and, especially, had defendants understood and practised it, as is also claimed, they would have used it openly and boldly, without fear of Russell or the consequences.

IV.

DAMAGES IN THE DODGE SUIT.

There are several methods of estimating damages, either of which is warranted by the proofs; but none of which will measure the full loss of complainant.

All skins that require shaving are subjected to a preparatory dampening process, as will more fully appear in further references to the evidence, and cold fat liquor is some times used for the purpose. And some of the skins treated by defendants, while the witnesses Whiting and Green were with them had, and others had not been shaved before coming to their hands.

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DAMAGES IN THE DODGE SUIT.

There are several methods of estimating damages, either of which is warranted by the proofs; but none of which will measure the full loss of complainant.

First. The proofs show at the lowest estimate, 192 barrels of fat liquor sold defendants by Christie and Johnson, between the date of patent and the hearing. See references under point III.

Taking 30 dozens as the number of skins treated with each barrel,—that being the mean of the extremes given by the witnesses, Whiting and Green,—and it gives 5,760 dozens as the total treated by defendants under the patented process.

The proof show that the enhanced value of the skins by virtue of this process, after deducting the whole expense of treatment, is, at the lowest estimate, $1.75 per dozen.

P. 31, fols. 61 and 62; p. p. 274 and 275, fol. 324; p. p. 318 and 319, fol. 372.)

The whole number treated, 5,760 dozens multiplied by $1.75, gives as a result $10,080.

Second. The witness Putman's estimate of the number of dozens per week treated by defendants, is 40. (P. 56, fol. 90.) This for two years and a half, the time covered by their infringments, makes an aggregate of 10,400 dozens; which multiplied by $1.75, gives as a result, $18,200.

Third. Taking the estimate of Samuel Dodge, Jr., 1,800 dozens per year, and it gives for two and a half years 4,500 dozens treated by defendants. (P. 246, fol. 293.) This, multiplied by $1.75, gives as a result $7,875.

It is propable, however, that Putman's estimate of 40 dozens per week is nearer the truth. He was in the employment and interest of defendants at the time of his examination, but seemed to be an intelligent and candid witness.

On his first examination he placed the number per week considerably higher; but upon reflection after going home, he feared that he might have placed it too high, and voluntarily returned to make the correction.

(P. 56, fols. 90 and 91.)

Fourth. But, none of these estimates show the full extent of complainant's damage; and hence the highest permitted by the proofs should be adopted as the measure.

Reference has already been made to the fact, under point II., that at the time of John Fulton's examination as a witness in this suit, August, 1872, there were, to his knowledge, 14 persons or firms manufacturing and selling gloves made from this leather in Gloversville and vicinity, besides Russell & Co., and those supplied by them, or authorized to use the invention.

Some of these parties were doing an extensive business; and for more or less of them, doubtless, defendants treated the skins.

And since the spring of 1870, there had been a depreciation in the market price of gloves made from this leather, on an average of $3 per dozen; and this

without known cause, other than the competition created by this unauthorized use of the patent.

(Dep. of John Fulton, p. 64, fol. 100.)

Fifth As defendants' infringements have been willfull and persistent, judgment should be rendered against them for treble damages,

V.

INFRINGEMENT BY DEFENDANTS, PLACE.

The former action at law against the defendants Place, was commenced June 20th, 1870, and the claim in this suit is for infringements since that date only.

(Record in No. 134, p. 13, fol. 36.)

First. William B. Mills, the only witness examined in this suit, testifies that he was in defendants' employment from January, 1871, till into January, 1872. That from January 1st to April 1st, 1871, they treated about 15 dozens of bark-tanned sheep and lamb skins each and every week, with *warm* fat liquor, heating the liquor, and the skins in substantially the same way as practised by complainant under his patent.

(Record in No. 134, p. 13, fols. 36 and 37.)

Second. John W. Place, one of defendants, testified in the Dodge suit that they continued to treat bark-

tanned sheep and lamb skins as he had described, (i. e. with *warm* fat liquor,) down to February, 1871.

(Record in No. 135, p. 184. fol. 231,)

That since that date, they had employed Samuel Dodge & Son, to do it for them; and he is not willing to swear that the Dodges had not, at the date of his examination, December 20th, 1872, treated more than 1,500 dozens for them since February 1st, 1871.

(Dep. of John W. Place, p. p. 186 and 187, fol. 233.)

The manner in which the skins were treated by the Dodges, has already been shown, and will further appear in their depositions, showing clearly a violation of the patent.

VI.

DAMAGES IN THE PLACE SUIT.

First. The 600 dozens sworn to by Mills are shown, —and all that are definitely shown,—by the proofs, to have been treated by defendants between the commencement of the action at law and the time they employed the Dodges in the spring of 1872.

Add the 1,500 dozens as the number treated for them since, by the Dodges, down to December 20th, 1871, and it gives a total of 2,100 dozens.

These, at $1.75 per dozen, amount to the sum of $3,675.

This estimate of the number of dozens treated, is undoubtedly below the real number; for John W. Place was not disposed to over estimate the extent of their infringements; and there is a space of time from the 20th of June, 1870, the commencement of the former action, and the first of January, 1871, when Mills commenced work for defendants, wholly unaccounted for. It is by no means probable that defendants were idle during these six months.

Second. Whatever the amount of actual damages the court may assess, the judgment should be for three times the amount so found; because the infringements by these defendants have been willful, persistent, and peculiarly aggravated.

Not content with infringing themselves, they have stimulated and encouraged others to do the same, and been unwearied in their efforts to break down the patent.

By the act of July 8th, 1870, sec. 55, it is provided that in equity suits for infringements, the claimant, in addition to the profits to be accounted for by the defendant, shall be entitled to recover damages, and the court

may assess the same; and the court shall have the same power to increase the damages as in actions upon the case.

VII.

CONSTRUCTION OF THE PATENT.

The Circuit Court erred in its construction of the patent, in holding that it claimed and covered the use of *cold* fat liquor, pure and simple; and that the patented process did not require *heated* fat liquor.

First. Historically, this question stands thus: On the trial of the action at law against the Places, before Judge Woodruff, defendants claimed, and the court held, that the patent required *heated* fat liquor. The defendants then insisted that they had never used *heated* fat liquor, and hence had not infringed. On the trial of the action against Klein, before Judge Hall, defendant claimed, and the court held, that the patent covered the use of *cold* fat liquor. Next in order of time, the cases at bar came on for hearing and argument, and the Circuit Court, Justice Hunt presiding, adopted Judge Hall's construction. Subsequently, the Klein case came before this court for argument, on writ of error; the question of construction was argued,

carefully considered by the court, and decided in accordance with Judge Woodruff's construction.

Klein v. Russell, 19 Wall. 433.

Second. The construction of the patent having been authoritatively settled by this court, that question is not open for discussion on these appeals.

The decision of these cases in the court below was expressly based upon the erroneous interpretation, that the patent covered the use of fat liquor generally, both cold and heated.

The presiding Justice, in his opinion says:—"The complainant insists that his patent is for the use of this liquor in its heated state. The defendants insist that the patent by its terms covers and includes the use of fat liquor generally, without reference to the condition in which it may be.

The solution of this question is of vital importance, as the complainant now states and argues that the use of the liquor under his patent differs from the use thereof made by himself for twelve or fifteen years before obtaining his patent, and by Dodge for thirty years at intervals, and by various other persons named in the evidence, in the circumstance that the patent provides for the use of the liquor in its heated state as distinguished from the liquor in its natural condition."

(P. 416, fol. 486.)

Again he says:—"I cannot resist the conclusion that

the re-issued patent reserves to the patentee the exclusive use of fat liquor in the improvement of bark-tanned skins, whether the liquor shall be heated or whether it is used without having been heated. In other words, any manufacturer using cold fat liquor in the improving of bark-tanned skins (prior use or want of novelty not being alleged) would be an infringer of the complainant's re-issued patent."

(P. 419, fol. 490.)

Again, after discussing the question of construction, he says:

"Assuming the patent to cover the use of fat liquor generally for the purposes indicated, can it be sustained? The objection of want of novelty is interposed, and in support of it numerous witnesses have been examined."

(P. 420, fol. 492.)

Again, in discussing complainant's criticism upon the evidence of defendants upon this point, he says:—"It is said that the fat liquor thus applied was always used in a cold state, and was not therefore an infringement on complainant's patent. If I have correctly construed the complainant's re-issued patent, it prohibits to others the use of fat liquor when applied to bark-tanned skins, whether such liquor be cold or hot. This objection goes to the main question of construction upon which I have already given my opinion."

(P. 422, fol. 496.)

Third. Had the Circuit Court felt at liberty to adopt the other construction contended for, and since approved by this court, it cannot be doubted that judgment would have been given for complainant.

This we must assume, because,—

1. It is evident from the opinion of the presiding Justice that he considered the question of construction a vital and turning point in the cases; that he based his decision upon a wrong construction; and no intimation is given in the opinion that the decision would not have been different under the other construction, but the contrary is clearly implied.

2. A large proportion of the evidence by defendants to establish want of novelty, relates to the use of fat liquor in a *cold* state; other portions relate to its use in a manner, and for purposes not covered by the patent; and no reliable evidence was furnished of a prior knowledge, or intelligent use of the patented process.

3. The complainant had two verdicts and judgments in actions at law sustaining his patent, when the same questions here involved touching its validity were in issue, and mooted by the same defendants; the verdicts were followed by motions for a new trial, which were argued, carefully considered by the court, and overruled; and under such circumstances, it is not to be presumed that the court, in

these cases, would have given a judgment in validating the patent upon the same grounds before contested, except from a necessity created by the erroneous construction adopted.

VIII.

FAILURE OF DEFENCES.

The Circuit Court erred in dismissing the bills of complaint.

The complainant made a perfect case, both of title and infringement; and all the attempted defences signally failed.

These defences will now be considered in their order; and, first,—

WANT OF NOVELTY.

The patent as construed by this court consists, in brief, of a novel treatment of bark-tanned sheep or lamb skins, by the use of *heated* fat liquor substantially as set forth in the specification and claim; by means of which, this class of leather, *already tanned*,—but which,

in the bark-tanned state, is too harsh and squeaky for gloves,—is rendered soft and pliable, and suitable for a glove of the first quality.

Before examining the question of prior knowledge and use, there are certain matters to be eliminated, and general propositions to be considered, the elimination and consideration of which will greatly simplify the question, and materially aid in eliciting the truth.

First. Six of the witnesses who spoke of the prior use of fat liquor applied it in a *cold* state, to wit :—

James Christie, (p. 57, fol. 92.)
Frederick S. Green, (p. 53, fol 87.)
Lewis P. Johnson, (p. 346, fol. 405.)
Sidney S. Plummer, (p. 149, fol. 193.)
James F. Place, (p. 263. fol. 300.)

The testimony of these witnesses, therefore, so far as it bears upon the defence of want of novelty, is to be stricken out.

Second. Much of the testimony for the defence, on this point, relates to what is known in the business as "oil tanning," and "Indian dressing," both of which are entirely different in character, manner, and purpose from the patented fat liquor process.

During the entire history of the glove business, in Gloversville and vicinity, deer and other skins, mostly deer, have been *tanned from the raw in oil*, called, "oil dressing or tanning;" and they have also been *tanned from the raw in fat liquor*, called "Indian tanning or dressing."

And in some instances fat liquor has been applied to imperfectly oil-dressed skins, to complete the tanning process,

(Dep. of Lewis P. Johnson, p. 345, fol. 403; dep. of James Christie, p. 59, fols. 94 and 95; and p. p. 61 and 62, fols. 97 and 98.)

The following propositions, illustrating the essential difference between the use of fat liquor in these cases, and in the patented process, are abundantly established by the evidence, viz :—

1. In oil and Indian dressing the fat liquor is used for the purpose of *tanning the pelt*, or in other words of *converting it into leather from the raw state;* while in the patented process, the fat liquor is applied to a skin *already tanned*, and for the purpose of adding new properties to it.

   It is not designed to, and does not in fact *tan* the skin, for that work has already been done by the agency of ~~to~~gallic acid in the bark process; but, applied to such leather, it changes its character. The difference in the two cases is explained by the chemist, Dr. Porter, and appears, also, from the testimony of skin dressers.

   (Dep. of Dr. Porter, p. p. 392 and 393, fols, 457 and 458.)

The whole process of tanning in oil is described by James Christie, and in fat liquor, by Aaron Simmons.

(Dep. of Christie, p. 58, fol, 93; dep. of Simmons, p. p. 135 and 136, fols. 177, 178 and 179.)

See, also, the testimony of Johnson, (p. 346, fols. 244 and 245.)

2. In oil dressing, fat liquor is never used when the ordinary process is perfect; and when used, it is simply for the purpose of remedying the defects of oil dressing, and perfecting the process of *tanning*.

(Dep. of Christie, p. p. 61 and 62, fol. 97; dep. of Ricketts, p. 83, fol. 122.

3. In these cases of imperfect oil dressing, re-milling in oil would accomplish the same purpose; but fat liquor is sometimes used instead, because it is less expensive.

This shows that the fat liquor is used in these cases for the same purpose as the oil, which is to *tan* or *make leather* of the skin.

(Dep. of Christie, p. 57, fol. 92; p. 59 fol. 94.)

4. When fat liquor is applied to imperfectly oil dressed skins, all the surplus oil, not used in the tanning process, is subsequently removed from the leather before it is fit for use; while in the patented process it is left in the skin.

This shows, also, that the purpose and effect in the two cases are different.

(Dep. of Christie, p. 57, fol 92; p. 59, fol. 94; dep. of Simmons, p. 136, fol. 179; dep of Johnson, p. 346. fol. 404.)

5. There is no "squeak" in the oil dressed and Indian tanned leather when the fat liquor is applied; whereas, "squeak" is one of the characteristics, and principal defects of a bark-tanned skin as a glove material; and, one of the objects and benefits of the patented process, is to remove this "squeak."

(Dep. of Simmons, p. 137, fol. 180; dep. of Christie, p. 59, fol. 94; and dep. of Johnson, p. 347, fol. 106.)

6. A cheaper and better article for gloves is produced by first bark-tanning the skin, and then supplementing with the patented process, than by tanning from the raw with oil or fat liquor; cheaper from four to six shillings per dozen, and better from two to four dollars per dozen.

(Dep. of Gillette, p. p. 322 and 323, fol. 377; p. p. 318 and 319, fol. 372; dep. of Fulton, p. 31, fol. 62; p. p. 274 and 275, fol. 324; dep. of Johnson, p. p. 347 and 348, fol. 406; p. 345, fol. 403; dep. of Simmons, p. 137, fol. 179; p. 138, fol. 181.)

7. The fat liquor used for Indian dressing, and for perfecting the leather in oil tanning, was applied in a *cold* state, and hence not the patented process.

(Dep. of Christie, p. 57, fol. 92; dep. of Johnson, p. 346, fol. 405; and dep of Green, p. 52, fol. 86; p. 53, fol. 87.)

Third. Some of the testimony for the defence relates

to the use of fat liquor for "dampening down" leather, as it is termed, preparatory to shaving and staking.

During the whole history of the glove business, or, at least till very recently, it has been customary to prepare all kinds of skins for staking, by dampening them in some manner.

Various materials have been used for the purpose, including water, soap suds, and fat liquor.

It is done by rubbing the face, or flesh side of the skin with water, or other material employed, and then folding it up and laying it away in a box or barrel, until it is sufficiently dampened for staking.

The purpose of this process is, *simply to fit the skin for staking;* it is not designed to, nor does it in fact take the "squeak" out, or fit the skin for gloves.

(Dep. of Gillette, p. 322, fol. 376; dep. of James F. Place, p. p. 252 and 253; fols. 299 and 300. Dep. of John W. Place, p. 182, fol. 229.)

Fat liquor was, also, sometimes used as a preparation for shaving.

This process consisted in a slight wetting or dampening of the skin, to fit it for shaving, and for this purpose only was it designed. Soap suds was more generally used for this purpose.

But, when fat liquor was employed, either as a preparation for staking or shaving, it was always applied in a *cold* state, and does not, therefore, touch the patent.

(See reference last above.)

Fourth. In the examination of their witnesses on the point of prior knowledge and use, defendants put such questions as this:—"State, if you know, whether the application of fat liquor to bark-tanned sheep and lamb skins, has been a well known and perfected process for softening such skins and making them pliable and removing the squeak from them; and if so, for how long a time have you known and understood such process?"

This question, involving the issue of prior knowledge and use, and calling for the judgment and conclusion of the witness upon it, is a specimen of the questions put, both in relation to the use of fat liquor upon bark-tanned, and other skins.

These questions were addressed to willing witnesses, those engaged in the conspiracy already referred to, and otherwise interested to break down the patent, and were generally answered in a wholesale manner, satisfactorily to defendants.

This style of interrogatory rendered long and minute cross-examinations necessary, in order to elicit the truth; but it turned out that many of the answers on

the direct examination, broad enough in terms to cover the patented process, had reference only to the use of fat liquor in oil tanning, Indian dressing, dampening down, or as applied in a *cold* state to bark-tanned skins; all of which uses did not touch the patent.

This wholesale, indiscriminate and unfair method of putting in testimony, creates some embarrassment in presenting the case for appellant, inasmuch as it imposes the necessity of a more careful and minute examination of the proofs than can reasonably be expected of this court, under its great pressure of official duties.

Fifth. There is another difficulty of the same character requiring notice.

For many years prior to the patent, attempts had been made to utilize bark-tanned skins in the glove business, and numerous processes were employed for the purpose, and with varied fortune, from utter failure to partial success. But none of them met the want, and all differed essentially from the patented process.

Yet, defendants' witnesses, under the mode of examination before noticed, when speaking of leather and gloves made of leather prior to the patent, which was dressed by some of these various processes, did not hesitate to characterize it as leather prepared according to the patent.

The following are some of the experimental processes

referred to, showing the materials employed in different modes and combinations, viz:—

Cold fat liquor, soap, sal soda and salt.

(Dep. of Fulton, p. p. 32 and 33, fols. 63 and 64.)

Water, eggs, neat's foot oil, soft soap, alum and salt.

(Dep. of Northrup, p. 65, fol. 102.)

Fat liquor, eggs and soap.

(Dep. of Ricketts, p. 73, fol 112.)

Alum, salt, eggs, flour and a gum.

(Dep. of Ricketts, p. 75, fol. 113.)

Oil and soap; and a dozen different processes.

(Dep. of Monroe, p. 92, fol. 132; and p. 101, fol. 140.)

Sal soda, eggs, soap and fat liquor.

(Dep. of Heacock, p. 120, fol. 161.)

Soap, oil and eggs, and sometimes with fat liquor.

(Dep. of Hull, p. 121, fol. 162.)

Eggs, oil, soap and sal soda.

(Dep. of Hull, p. 125, fol. 167.)

Soap alone, and sometimes with other ingredients.

(Dep. of Hull, p. 164. fol. 210.)

Soap suds.

(Dep. of John W. Place, p. 181, fol. 227.)

Carbonate of ammonia, eggs and oil.

(Dep. of Dodge, Sen., p. 191, fols. 238 and 239.)

Carbonate of ammonia, oil of vitriol, and common salt, then use eggs, oil and warm water; and lastly revolve the skins in a drum.

(Dep. of Dodge, Sen., p. 230, fols. 227 and 228.)

Oat meal, lard oil, yolk of eggs and soap.

(Dep. of Gillette, p. 319, fol. 373.)

Fat liquor, castile soap, and common salt.

(Dep. of Gillette, p. 320, fol. 374.)

Alum, eggs, and neat's foot oil.

(Dep. of Gillette, p. 320, fol. 374.)

Extract of tannin, and a composition called "stuffing."

(Dep. of Gillette, p. 320, fol. 374.)

Here are sixteen different processes, besides the doz-

en others which Monroe says he practiced, yet these are not all the varieties mentioned in the proofs.

From this presentation it will appear :—

1. That with all the modes of treating bark-tanned skins prior to the patent, in some of which the leather produced strongly resembled complainant's product, there is no reliance to to be placed upon testimony of the prior existence of leather treated according to the patented process, when the witnesses speak from inspection alone, and comparison by memory. An honest witness might easily mistake and a dishonest one could falsify with impunity.

2. These numerous and varied efforts disclose a felt want in the business for some process, by which bark-tanned sheep and lamb skins could be made available for gloves ; and at the same time show, from the fact of their variety and dissimilarity, that the objective point was not reached, or the want supplied. This will more fully appear in further discussion of the evidence ; and especially from the facts that, prior to the patent, bark-tanned skins were used to a very limited extent only, whereas, immediately upon the publication of complainant's invention, his leather came into general use, and revolutionized the business.

3. That all these different processes might have existed prior to complainant's patent, and all made leather suitable for gloves, without affecting

its validity. Between any one of them and complainant's process, there is abundant room for a patent.

The question is not whether leather suitable for gloves was made from bark-tanned skins, prior to complainant's invention, but whether the *patented process* was known and used.

It appears from the testimony that the egg process used by Dodge made the best leather of any known treatment prior to complainant's invention, but it was more expensive than the patented process, and yielded to it.

(Dep. of Tinsley, p. p. 295 and 296, fol. 347.)

As an example of the deceptive character of much of the testimony for the defence, take the following question to Isaac V. Place, and his answer, viz :—

Q. "State whether or not, to your knowledge, soft, pliable leather made from bark-tanned sheep and lamb skins has been used for the manufacture of gloves by glove manufacturers in Gloversville ; and, if so, for how long ?"

A. "It has ; and has been so used for more than twenty-five years."

Testimony of this character is produced to establish the defence of a want of novelty; and it is given with a view of creating the impression upon the mind of the court, that such leather was prepared by a process substantially like complainant's; which impression is false both in logic and in fact.

But this line of proofs, and manner of questioning, impose the necessity of a careful scrutiny of the testimony, especially upon cross-examination.

PRIOR USE OF WARM FAT LIQUOR ON BARK-TANS.

Having in some measure prepared the way, we can now satisfactorily examine the testimony concerning the use of warm fat liquor upon bark-tanned skins, the only evidence of prior use bearing upon the issue now under discussion.

This testimony, while it fails utterly to sustain the the defence of prior knowledge and use, will be found on careful examination to establish very clearly the following propositions, viz :

First. That for a long time prior to complainant's patent there had been a *felt want* in the business, pressing and continuous, of some cheap and reliable process or method of fitting up bark-tanned sheep and lamb skins for gloves.

Second. That this want led to various modes and processes of treatment more or less feasible and valuable, and among others, to crude and unsatisfactory experiments with fat liquor.

Third. That this want was not met, nor was there any defined, understood process for the treatment of such leather with *warm* fat liquor as the basal element, until complainant's invention was perfected.

Fourth. That this invention just met the want, superceded other methods, and created a revolution in this branch of the glove making business; and that it is now passing through the ordeal of all valuable patented inventions which effect a large and powerful interest.

Fifth. That if warm fat liquor was used at all before complainant's invention, its use was merely incidental, or a matter of convenience; it was not thus used with a knowledge of the action or effect produced by heat upon the emulsion and the leather, or with any intelligent appreciation of the superiority of *warm* over *cold* fat liquor in the treatment of bark-tanned skins.

The effect and advantages of heating the liquor appears generally from all the evidence on the subject, and especially from ths testimony of Gillette, who speaks from practical knowledge and experience, and from the testimony of Dr. Porter, who gives the result both of his experimental and scientific knowledge.

(Dep. of Gillette, p. p. 337 and 338, fols. 394 and 395; dep. of Dr. Porter, p. p. 393 and 394, fols. 458 and 459.)

We will now examine the testimony of each witness for the defence upon this point.

SAMUEL DODGE, SEN.

His experience in the use of fat liquor alone, both warm and cold, upon bark-tanned skins prior to 1869, as given on his direct examination, is as follows, viz:

1. A lot of 300 or 400 treated for Jonathan Ricketts, about 24 years prior to his examination, says he treated some of them with warm fat liquor, and the others with carbonate of ammonia, oil, eggs and warm water.

(P. p. 191 and 192, fols, 238 and 239.)

2. A lot of 9 or 10 dozens for the Churchills in Gloversville, about 20 years prior to his examination.

(P. 192, fol. 239.)

3. A lot of 10 dozens for David Spaulding, about 20 years prior to his examination.

(P. 192, fols. 239 and 240.)

4. A lot of about 10 dozens for Edward Dunson, 16 or 17 years prior to the hearing.

(P. 193, fol. 240.)

5. A lot of about 6 dozens for Samuel Gilchrist, 16 or 17 years prior to the hearing.

(P. 193, fol. 240.)

6. A lot of 15 dozens for Chapman & Warring, about 15 years prior to the hearing.

(P. 193, fol, 240.)

7. A lot of 10 dozens for Chapman & Logan, about 15 years prior to the hearing.

(P. p. 193, and 194, fol. 241.)

8. A lot of 12 or 15 dozens for Daniel B. Judson, about 14 years prior to the hearing.

(P. 194, fol. 241.)

9. A lot of 10 dozens for D. & P. Heacock, about 14 years prior to the hearing.

(P. 194, fol. 241.)

10. About 10 dozens for one Nickerson, about 13 years prior to the hearing.

(P. 194, fol. 242.)

11. A lot of 25 dozens for Daniel B. Judson, nearly four years prior to the hearing.

(P. 195, fol. 242.)

Dodge, Jr., called to corroborate his father. fixes the time of these in the fall of 1869.

(P. 242, fol. 289.)

Samuel Dodge, Sen., is the main reliance of the defence, on this issue and also that of utility, as it was in the actions at law; but his testimony at the best, when carefully weighed, bears very lightly in the scale against the evidence of novelty and utility; and it is so confused, contradictory, improbable, and thoroughly impeached, as to render it wholly unreliable.

His testimony invites the following remarks and criticisms, viz:

First. In his testimony on the trial of the Klein case, at Utica, he undertook to name all the persons and firms for whom he had treated bark-tanned sheep and lamb skins with fat liquor prior to 1869, and entirely omitted from his list the names of Spalding, the

Heacocks, Chapman & Warring, Chapman & Logan, and Dunson, above named.

(P. 209, fols. 257 and 258; and dep. of Tinsley, p. 295, fol. 345.)

See, also, the extract of Dodge's testimony on the Klein trial, found at p. 304, and thence on to and including p. 310.

Second. Of the above list of persons, Gilchrist, Dunson and Sprague, were dead, and Nickerson had gone to parts unknown, so that they could not be summoned to confront Dodge.

(P. 238, fol. 285; and p. 239, fol. 286.)

Third. Daniel B. Judson. is called as a witness for defence, and testifies from his books that Dodge treated only one lot for him prior to 1869, instead of two as he testifies, and one lot of Cape sheep in 1869.

That he does not know how they were treated, but the "squeak" was not all taken out of the first lot, and they were only suitable for coarse mittens and common gauntlets. The second lot were what are known as "Bevington tans;" and he paid Dodge for treating both lots, $2.50 per dozen. The patented process treatment, be it remembered, costs only from 12 to 25 cents per dozen.

(P. p. 259 and 260, fols. 306 and 307.)

It is shown that the "Bevington tans" are not bark-

tanned skins, but are tanned in alum and salt, and simply colored on the surface with bark.

(Dep. of Cornelius A. King, p. 358, fol. 418; p. 363, fol. 423.)

Yet Dodge included these in his experience in treating bark-tanned skins with fat liquor, without alluding to the difference.

He also speaks of the other lot, from which Judson says the "squeak" was not all taken out, in the same terms that he does of all treated by him prior to 1869, as "rendered soft and pliable and suitable for golves."

The inference is irresistible that all his treatment with fat liquor, prior to 1869, was imperfect and unsuccessful; and that he did not understand and practice the patented process.

Fourth. It is shown by Eugene Guy, a brother-in-law of Dunson, one of the persons for whom Dodge says he treated bark-tans with fat liquor, that he was familiar with Dunson's business a year or more before the latter went to the war in the fall of 1861; and that he took the whole of Dunson's stock when he left.

That during this time Dunson had no such leather in his possession as that produced by the patented process; and that there was none such in the stock aforesaid; but there were goods made from the sheep skins in the bark-tanned state.

(P. 248, fol. 407.)

This tends strongly to show that Dunson, at the time spoken of by Guy, had no knowledge of the improved leather; and that if Dodge had previously treated any skins for him as he testifies, they were not treated according to the patented process.

Under all the evidence in the case touching the unfitness of sheep and lamb skins in the bark-tanned state for gloves, and their improved ~~treatment~~ condition under the patent treatment, at a trifling cost, it is simply absurd to suggest that any manufacturer, knowing of the improved leather, would have continued to use the unimproved bark-tans for gloves.

Fifth. The Churchills are in the list of those for whom Dodge says he treated skins with fat liquor. It is shown by David H. Cuyler, that in the fall of 1861 he made up for one of the Churchills about 200 dozens of gauntlets and gloves from sheep and lamb skins in the bark-tanned state.

That Churchill wished them made into button top gloves, but the leather proved too harsh for the purpose, and only about one third of the lot were made into that class of goods, the balance were made into gauntlets, a coarse article.

(P. 383, fol. 446.)

Defendants attempted to break the force of this evidence by showing that, in the latter part of 1861 and and in 1862, there was a great demand for gloves in

the army, and that they were often made from imperfectly dressed skins, and poor stock.

But this does not meet the difficulty; Churchill wanted all the skins made into button tops, a better class of gloves than the gauntlets; by the simple, speedy, and cheap patented process they could have been fitted for such goods, and rendered much more valuable; and undoubtedly they would have been so fitted had this process, or it substantially, been known in that community where Dodge carried on the business of skin-dressing.

Sixth. The attention of the court has already been called to the significant fact that Whiting, Green, and Putman, who worked for the Dodges at different periods, and during several years prior to 1869, covering time when they profess to have been using the patented process, and they all testify that they saw no fat liquor there prior to 1869.

(P. 42, fols. 74 and 75; p. 51, fol. 84; p. 55, fol. 89.)

They say that the Dodges *commenced* the use of fat liquor in 1870; and it is a coincidence worthy of note, that it was about the same time that Christie and Johnson commenced selling them fat liquor.

(P. 56, fol. 91; p. 65, fol. 101.)

It is also significant that defendants call none of their workmen to corroborate the Dodges on this point; while complainant calls the three above named,

and others, who, with every opportunity of knowledge, testify that fat liquor was not used by the Dodges in their business, as represented by them.

Cornelius A. King worked for them from the fall of 1853, to January, 1857, and again from December, 1862 to January, 1869, covering a period of over nine years, during which time they did not treat with fat liquor, but did with eggs and other materials.

(P. p. 357 and 358, fols. 417 and 428; p. 360, fol. 420.)

Francis Hevey worked for them from 1858 to 1861, and saw no fat liquor used except upon a few lots to affect the color; and this was applied in a *cold* state.

(P. 375, fols. 437 and 438; p. 377, fol. 440.)

The use of a preparation to change the color will be referred to in another connection.

Seventh. On Dodge's direct examination, he claims to have made fat liquor for his own use as often as once in four weeks for 27 years then past, and gives his formula for its preparation.

(P. 200, fol. 247.)

To the use of this preparation made by him, as well as to fat liquor from the mills, he referred indiscriminately in giving his experience in the use of what the defence claims was the patented process.

But it turned out that this preparation was *not fat liquor at all*, and was not used for the same purpose as the patented process; but that it was simply a *gum* used in the kid business as a surface dressing upon skins colored black, and for the purpose of giving them a deeper color, and a smooth glossy surface.

That while there are 40 or 50 different colors and shades of the kid, the gum is only used upon the black and dark colors, which are the poorest quality of leather.

See Dodge on cross-examination, and the testimony of King, an experienced skin dresser.

(P 225, fols. 272 and 273; p. 358, fols. 418 and 419.)

Eighth. In giving his experience on the direct, and stating the effect produced by the fat liquor treatment in the several instances mentioned by him he said nothing at first about its taking the "squeak" out; but subsequently, in reply to a direct question calling for such an answer, he said the "squeak" was removed.

(P. 200, fol. 247.)

Being asked on cross-examination why he had at first omitted the "squeak," he replied thus: "Because there was some "squeak" in them that I finished and buffed off; I only applied it on one side, sometimes there was some "squeak" in some on "em."

(P. 224, fol. 272.)

This was the first intimation given by him that there was any difference in the mode of treatment or effect produced in the several lots enumerated by him on his direct examination; but it now transpired that all the skins spoken of by him on the direct to which he applied the fat liquor with a brush,—and a large portion of them were so treated,—were afterwards buffed, and to such skins he applied the liquor sparingly, *so that it should not strike through the skin.*

(P. 231, fols. 278 and 279; p. 234. fol 281,)

It is obvious at a glance that this treatment was entirely different from the patented process, and for a different purpose; yet, on the direct, Dodge intentionally included this treatment in what he testified was his experience in the use of the patented process, and even swore positively that such treatment removed the "squeak," which, on his cross examination he admits to have been false.

It has been said in reply to this, it is immaterial, that the patent does not mention "squeak." True, this word is not in the specification; but the condition of the bark-tanned skin which causes "squeak" is described; and this term is employed because it is much used in the business to express that condition; and it is a convenient test of the condition of leather, and the efficacy of a given treatment.

But it is referred to in this connection to show the character of Dodge's testimony.

Ninth. He testifies that he treated three-fourths of the Ricketts' skins with fat liquor alone.

(P. 213, fol. 261.)

But Ricketts flatly contradicts him on this point, testifying in substance that Dodge treated all his, witness's skins, with fat liquor, eggs and soap.

(P. 73, fols. 111 and 112 ; p. 74, fol. 114.)

Tenth. His statements here, on the direct and cross, and on the trial of the Klein Case, in reference to the treatment of the Ricketts skins, are contradictory and wholly irreconcilable.

(P. p. 191 and 192, fols. 238 and 239 : p, p. 211 and 212, 259 and 260 ; p. p, 295 and 296, fols 346 and 347.)

Eleventh. It will be observed that in his testimony here, Dodge, commencing with Ricketts and continuing down to 1869, undertakes to discriminate between the instances in which he used fat liquor alone, fat liquor with other ingredients and other materials without fat liquor ; and also as to the kinds and classes of skins treated by the several processes. And this he does from memory alone, having no book or record to assist.

(P. p. 191 to 196 inclusive p. 220, fol. 268)

Yet, when testifying on the Klein trial, and under-

taking to give his knowledge and experience in the use of fat liquor, and in the treatment of bark-tanned sheep and lamb skins, he did not and could not discriminate.

(P. p. 206 and 207, fols. 254 and 255.)

And see reporter Tinsley's testimony, (p. p. 292 to 296, inclusive;) also the extract from Dodge's testimony on the Klein case, taken from the printed case by stipulation. (P. p. 304 to 310, down to fol. 363.)

Twelfth. His testimony here and on the Klein trial is wholly contradictory, in respect to what he told complainant eight or nine years before about the use of fat liquor.

(P. 202, fols. 249 and 250; p. p. 225 and 226, fol. 273; p. p. 296 and 297, fol 348.)

Thirteenth. On his direct examination, he says the next skins treated after Ricketts,' ~~was~~ were a lot of nine or ten dozens for the Churchills, and that they were reated with fat liquor alone.

(P. 192, fol. 239.)

On the Klein trial, as he partially admits on cross-examination, and as is shown by the reporter, he testified that this lot consisted of over 1,000 skins, and that in treating them, he sometimes used the fat liquor warm and sometimes cold, that he could not tell the

proportion of either; *and that he used his secret process or compound in connection with the fat liquor.*

(P. 215, fol. 263; p. 296, fol. 347.)

Fourteenth. On his direct examination, he specifies the next lot after Churchill's as done for David Spaulding.

(P. 192, fols, 239 and 240.)

But on the Klein trial, when asked to state the next lot after Churchill's treated by him with fat liquor, he answered that "he could not tell, that he kept on working at it more or less all the time; that he worked right along, sometimes at Churchill's, sometime at Judson's; that the work was mixed up, probably one day he would work at one man's work, and another day at another's, and that continued on for two or three years more or less."

(P. p. 215 and 216, fol. 264; p. 296, fol, 347 and 348.)

He further testified on the Klein trial, that he applied what he said of Churchill's in this respect, to the others just mentioned, Gilchrist and Judson; and this includes the use of the liquor warm and cold, and the use of his secret process with it.

(P. 216, fol. 264.)

Fifteenth. He testified to treating skins with fat liquor in 1869, for Daniel B. Judson.

(P. p. 200 and 201, fol. 248.)

On the Klein trial, he testified that he did not treat any with fat liquor in 1869.

(P. 296, fol. 348.)

Sixteenth. He says there is no difference between the use of fat liquor warm or cold, except that warm will do the work faster.

(P. 205, fol. 254.)

And he admits that on the Klein trial he testified that, in his use of fat liquor prior to 1869, he had sometimes applied it warm and sometimes cold, warm in the winter and cold in the summer; that whether he used it warm or cold depended upon *the season* and his *convenience*; and further, that it made just as good leather applied *cold* as *warm*.

(P. 206, fol. 255; p. 208, fol. 256.)

It is important to notice in this connection that since the patent, *he has always applied it warm*, except upon two of his exhibits in these suits, which were gotten up for the suits by the use of cold fat liquor, and other tedious and complicated treatment.

(P. 222, fol. 270; p. p. 227 and 228, fols. 274 and 275.)

This presentation is very suggestive:—

1. If Dodge did use the fat liquor, warm or cold indiscriminately, according to the season and his convenience, it shows conclusively that he had no intelligent notion of the use and benefits of *warm* fat liquor as patented by complainant; for it has been abundantly shown that this process has a value and efficiency not dependent upon *season*, or measured by *convenience*.

   If he did not use it as he states, then he falsifies under oath, and is entitled to no credit.

2. The uniform use by him of the liquor in a *warm* state since the patent, is susceptible of no explanation consistent with his use of it *cold* prior thereto, while possessing ~~one~~ an intelligent idea of the benefit of heating.

3. The fact that he still insists that cold fat liquor makes just as good leather as warm, assuming him to be honest in this opinion, shows that he did not understand the patented process prior to its publication; for if he does not now appreciate the benefit of heating, he could not then have understood it.

4. But, his use of it warm since the patent, and his efforts to conceal his manner of using it, painfully suggest something more than ignorance now.

5. Dodge and others use the patented process since its publication, to the exclusion of all other methods

of treating bark-tanned skins; had they understood its use and efficiency before, would they not have used it, instead of the numerous other tedious and more expensive processes that were employed, with far less satisfactory results? Especially as they could then have used it without "let or hindrance," while now they run against a patent and chance a law suit?

Seventeenth. Dodge testifies that in treating Ricketts' skins he left them in the liquor from fifteen minutes to half an hour, and that they were trodden in the mean time; that the first time of so treating them did not sufficiently soften and remove the squeak to render them suitable for mittens and gloves, and he subjected them the second time to the same process.

(P. p. 214 and 215, fol. 263.)

That in treating Spaulding's skins, he subjected them twice to the liquor, from half to three fourths of an hour each time, and trod them during half the time.

(P. 217, fol. 265.)

Dunson's he fat liquored twice, the first time for half, and the second time for three quarters of an hour.

(P. 217, fols. 265 and 266.)

Chapman & Warring's he dipped and trod twice, from half to three quarters of an hour each time.

(P. 220 and fol. 268.)

The same with those of Daniel B. Judson.

(P. p. 220 and 221, fol. 268.)

From this treatment, it is very clear that he did not understand or practise the patented process, or it in substance.

It is shown by the testimony of Gillette and Fulton, that, in the treatment of skins under the patent, they are immersed but once, and kept in the liquor from 5 to 15 minutes only; and that there is danger of clouding the leather and rendering it unfit for gloves by subjecting it too long to the warm fat liquor.

(P. p. 321 and 322, fol. 375 and 376; p. 272, fol. 322.)

And in this connection the fact is significant that since 1869, Dodge, by his own admission keeps his skins in the liquor from 20 to 30 minutes only, and says that they "*can do them now a little quicker than they could before.*"

(P. 222, fol. 270.)

But Whiting testifies that Dodge left the skins in the liquor from 3 to 5 minutes only, which is doubtless the truth and his present practice.

(P. 43, fol. 75.)

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(P. 43, fol. 75.)

Eighteenth. Dodge tries not only to give the impression, as we have seen, that he told complainant 8 or 9 years ago how to treat skins with fat liquor, but to have it believed that about 15 years ago he imparted the knowledge to James Chapman.

(P. 202, fol. 250.)

Chapman, a willing witness for the defence, says nothing about this communication, although he testifies to the treatment of some bark-tanned skins for himself and his partner Warring. But it does appear from his testimony that although he continued in the business for a year after the alleged communication to him, and made gloves from bark-tanned skins *in the bark-tanned state*, he neither practised Dodge's treatment himself, nor employed any body else to do it for him.

(P. 134, fol. 176.)

It is either true or untrue that Dodge imparted his mode of treatment to complainant and Chapman. If not true, then he is unworthy of credit on any point; and if true, then it is evident that his treatment was not the patented process, or Chapman would have used it and improved his bark-tan goods, and complainant would not have gone on experimenting till 1869.

Had Dodge understood a process so much demanded by the wants of the business, so valuable as complainant's is proved to be, and one by which he now thrives,

it is not probable that he would have communicated it so freely to others; and especially it is improbable when it is remembered that, on the trial of the Klein case, one of his preparations for treating skins, and one of no importance as appears when disclosed on this trial, could not be extorted from him.

(P. 206, fol. 255; p. 230, fols. 277 and 278.)

Nineteenth. If it be true, as he testifies, that in his prior use of fat liquor he applied it to lamb skins only, while he treated sheep and the heavier class of skins with eggs, his secret process, and other materials, it shows that he did not have or understand the patented process, for *it* has the same effect upon *sheep* as *lamb*, upon *heavy* as *light* skins.

(P. 207, fol. 255; p. 191, fols. 238 and 239; p. 273, fol. 323; p. 322, fol. 376.)

Dodge does not pretend that since 1869, he has made such distinction in his treatment of different classes; and on the trial of the Klein case, he testified that he did not then use the egg treatment because it was a little more expensive.

(P. p. 295 and 296, fol. 347.)

Now, it seems in the light of of complainant's patent, warm fat liquor is sufficient for heavy skins, even in the hands of Dodge.

Twentieth In 1856 Daniel S. Hulett took a lot of skins to Dodge to be softened and finished for gloves, and they were returned with "squeak" in them, and but little better than when taken to him.

And in 1862 or 1863, Hulett applied to him for some method of softening a lot of bark-tanned horse hides, and Dodge told him to dip them in strong soap suds, and then dry and stake them. The patentod process, had he understood it, would have been his prescription.

(P. 290, tols. 340 and 341.)

Twenty-first. In 1867 or 1868, Gillette and Combs consulted with both the Dodges in reference to some mode of softening bark-tanned sheep and lamb skins, and treated a lot at their shop, with their assistance, after a recipe which somebody had furnished Gillette.

The treatment was unsuccessful, but not a word did either of the defendants say about fat liquor treatment.

(P. 319, fol. 373 : p. 351, fol. 410.)

If it be said in answer to this that Dodge did not wish to disclose his fat liquor treatment, and hence said nothing about it, we reply that such an answer is barred, first by his testimony about communicating the process to complainant and Chapman, and, second by his pretence that the patented treatment was well known to the manufacturing public.

The fact is, that the patented treatment was not then known to Dodge, or any body else.

Twenty-second. By Dodge's own showing, taking his own statements on the direct without demur or abatement, the whole number of skins treated by him with fat liquor alone, fat liquor and water, or fat liquor mixed with other ingredients, prior to 1869, could not have exceeded 500 dozens; while since that time, by his own admission, he has treated forty dozens a week with warm fat liquor alone, amounting in the aggregate to more than 6,000 dozens. Five hundred dozens in 25 years, and over 6,000 dozens in 3 years! Why this great change, if he has not profited by complainant's patent?

Dodge does not even attempt to account for this wide difference, and no satisfactory explanation is afforded by any testimony in the case, consistent with the theory of the defence.

The foregoing are only specimens of Dodge, Sen., the great paixhan of the defence. His whole testimony is extraordinary, confused, contradictory and unreliable; and much of it is absurd.

In one respect, however, it is eminently successful; it demonstrates very clearly that he had no knowledge of conplainant's process prior to the patent.

It also, in many ways, tends strongly to show that

such knowledge did not exist in the glove manufacturing community.

SAMUEL DODGE, JUN.

This witness is the other defendant in No. 135; and an abridged edition of Samuel Dodge, Sen.

His testimony is too vague and uncertain to be of any value to the defence.

So far as it tends at all to corroborate his father, it is subject to many of the same criticisms, which need not be repeated.

First. He testifies to a few lots of skins treated by his father with fat liquor and warm water prior to 1860.

(P. p. 234, 235 and 236.)

But it turns out on cross-examination, that he was a boy of only fourteen or fifteen years at the time he refers to and knows but very little about the treatment.

Three lots are all that he can specify, and he did not prepare the liquor for these; cannot swear that it did not contain other ingredients than fat liquor and water, and he was not present during all the treatment.

(P. p. 237 to 241. inclusive; p. 243. fol 290.)

Second. On his direct, he states that his firm treated bark-tanned sheep and lamb skins, prior to 1869, for Daniel B. Judson, Solomon Jeffers, Albert Klein, Isaac V. Place & Co., and D. S. Tarr & Son.

(P. 236, fol. 283.)

But on cross-examination he denies having so stated on his direct, and says that if he did so state he was mistaken.

(P. p. 244 and 245, fols. 291 and 292.)

Third. While he can mention only a few lots fat liquored prior to 1869, and is very confused and uncertain about these, he is not willing to swear that they have not treated as many as two thousand dozens per year since 1869.

(P. 247, fols. 293 and 294.)

Fourth. This is the pious youth who, when secretly infringing complainant's patent, said that "*Mr. Russell could go to hell with his patent, he has got to find out how we do it.*"

(P. 45, fol. 78.)

JONATHAN RICKETTS.

This witness, an old English friend of Dodge, and a glove manufacturer, is called to sustain him, and at the

same time to assist in removing the patent out of his own way.

(P. 73, fol. 111; p. 79, fol. 117.)

First. The only use of fat liquor on bark-tanned skins to which he testifies, is that employed by Dodge, in connection with eggs and soap, on the skins treated for him by Dodge, to which the latter testifies, and which has been examined under his name.

In regard to these, as has been shown, he contradicts Dodge upon the only point connected with their treatment that is material in this controversy.

Dodge swore to treating three-fourths of them with fat liquor alone, reduced with water; while Rickets testifies, in substance, that eggs and soap were used on all of them in connection with the fat liquor.

(P. 213, fol 261; p. 73, fols. 111, 112; p. 74, fol. 114.)

Second. It appears, also, by his testimony, that these skins were kept in the liquor about an hour on the first immersion, and trodden with the feet about half the time during the immersion; that then, not being soft enough, they were subjected the second time to the liquor, and afterwards staked, mooned, and pumice stoned; and after all, made up into coarse goods.

(P. p. 76, 77; fols. 115, 116.)

Third. It appears also, that Dodge's treatment of these skins did not take the "squeak" out of all, and render them suitable for gloves.

(P. 74, fol. 114; p. 77, fol. 116.)

Fourth. It further appears, that since the treatment of these skins by Dodge, he had made gloves and mittens from bark-tanned sheep and lamb skins in the bark-tanned state; but had made none from skins treated with fat liquor, except one lot about two years ago from leather prepared for him by Dodge, treated he knows not how.

(P. 78, fol. 116.)

In addition to all the other evidence in the case showing the benefit to bark-tans of the patented treatment, it is specifically shown that for any glove or mitten, even for harvest mittens, the coarsest of all kinds, the value of bark-tanned sheep and lamb skins is increased by this process.

(Dep. of Philo Earl, p. p. 387 and 388, fol 451.)

This witness also speaks of the use of fat liquor in oil dressing, and to the "gum" treatment of kid, both of which subjects have been sufficiently ventilated.

JOHN FILMER.

This witness worked for Ricketts with Dodge. While there, in the *winter* time, he saw some skins put into

warm fat liquor, where they were stirred and trodden by Dodge, and after treatment they were "*more soft and pliable.*"

This is his characterization of the condition of skins which Dodge says had the "squeak removed from them," and which were "soft and pliable and suitable for gloves."

Filmer says the fat liquor used by them was "scoured out by hand;" and that in thus obtaining it by scouring, they "used the liquor warm." Thus, it seems, that the *heating* of the liquor was not for its effect upon the skins, but an incident merely, connected with its manufacture.

He did not assist in preparing the liquor for the reception of the skins, and does not know what ingredients it contained.

(P. p. 84 and 85, fols, 123 and 124.)

ISAAC V. PLACE.

Mr. Place is one of the defendants in No. 134; the man who engineered the combination and conspiracy against the patent in the out-set; who commenced his defence by asking for a construction of the patent that would exclude *cold* fat liquor, claiming that he had

never used it *warm*; but, convicted of an infringement on his own construction, changed ground, asked for the other construction, and claimed that he had *always* used *warm* fat liquor: the man who has counseled, stimulated, and supported opposition to the patent, and been the Napoleon of the defence, from the commencement of the fight down to the present time, whoever were the nominal parties.

Much of his testimony relates to the use of fat in oil dressing and tanning from the raw, which will be passed over as irrelevant. What he says on the direct in regard to the treatment of bark-tanned sheep and lamb skins is in substance briefly stated, as follows:

1. The first he remembers treating was in 1856; and thinks the liquor was applied *cold*; that they applied it *warm* in *winter* and *cold* in *summer*.

(P. 151, fols. 195 and 196.)

2. The next lot was in 1857; says the skins were dipped in warm liquor, left in a few minutes, and then taken out and dried and staked.

(P. 151, fol. 196.)

3. The next lot was in 1858; does not know whether the liquor was warm or cold; does not know how it was applied, but thinks it was put on with a sponge.

(P. 151, fol. 196.)

4. He then says, "we done it every year, but cannot fix any positive time after 1858, till we come to 1862."

(P. 151, fol. 196.)

To this he adds that in 1862 they made between 300 and 400 dozens of gloves and mittens of bark-tanned sheep and lamb skins, treated with fat liquor. That they applied the liquor with a sponge, and thinks they warmed it, but is not positive.

5. Says he cannot fix dates since, but *thinks* they have done it every year since 1862, that they applied it by dipping and with a sponge, and both cold and warm.

(P. 151, fol 196.)

6. Says the effect of fat liquor is the same whether applied *warm* or *cold*; that the reason why he ever warms it is, that it works quicker when warm, especially in the winter; *that in the summer it is warm enough without heating.*

(P. 152, fol. 196.)

7. He next launches out into the broad statement that bark-tanned sheep and lamb skins treated with fat liquor, had been used extensively by others than himself in the manufacture of mittens and gloves, at Gloversville, for more than 20 years.

(P. p. 152 and 153, fol. 197.)

8. Finally he sums up by saying that soft, pliable leather, made from bark-tanned sheep and lamb skins, had been used in Gloversville for more than 25 years.

(P. 153, fol. 197.)

This is the substance of his testimony on the direct. A few suggestions in regard to, and references to his cross-examination, will aid in estimating its value.

First. It is evident, on his own showing, that he had no intelligent idea of a defined process like complainant's for the treatment of bark-tanned skins with *warm* fat liquor. His treatment was varied and capricious; and the liquor was applied warm or cold according to the season of the year, or the convenience of the operator.

That he had some general and vague idea that fat liquor has a softening effect upon leather, is quite probable, as this must have been known by everybody acquainted with it. But this falls far short of a knowledge crystalized into a definite, formulated process, of great practical value, such as is embodied and set forth in complainant's patent.

Second. His statements, that "the effect of fat liquor is the same, whether applied warm or cold," and that "in summer it is warm enough without heating," show beyond all question that he did not understand the patented process, or that his testimony is untruthful.

This point has been sufficiently discussed in examining the testimony of Dodge, Sen.

Third. His statement, that "soft and pliable leather made from bark-tanned sheep and lamb skins, had been used in Gloversville for more than twenty-five years," is of no importance.

1. It has already been seen, and will more fully appear in the further examination of the testimony, that this formula is very uncertain, indefinite, and accommodating in its use and signification as employed by defendants' witnesses, that between the extremes in the condition of leather represented by it, there is room for several patents.

2. That even conceding leather to have been produced equal in quality to complainant's, would not aid the defence; for, the question is, not whether such leather has been made, but whether it has been made by the patented process.

The egg and soap treatment, and other tedious and expensive processes had been more or less in use for a long time, and crude experiments with fat liquor had been made; and there is nothing whatever to show, that the leather referred to by Place was not the product of some of these processes or experiments.

Fourth. The lots mentioned on his direct, as treated in 1866-7, are the same referred to by the witness Henry E. Krause in his testimony, and were treated

in the winter or spring, which accounts for the warming of the liquor, if it was warmed.

(P. 157, fol. 202.)

Fifth. He does not know in what season those mentioned on his direct as treated in 1858, were done; nor whether the liquor was applied warm or cold.

(P. 157, fol. 202.)

Sixth. The lot of 1862 were treated in cold weather, but by whom he cannot state.

(P. 157, fol. 202.)

It will be seen that his recollection on the subject is very imperfect.

If he had understood a definite, practical, and uniformly efficient method of treatment, such as the patent furnishes, he would not have been thus confused; nor would he have varied his treatment with the seasons, and convenience of the operator.

Seventh. On the direct, he says that he has recently examined his books to refresh his recollection, and leaves it to be inferred that he is thereby enabled to speak with more certainty in reference to his treatment of bark-tans with fat liquor.

(P. 153, fol. 198.)

But on cross-examination, it appears that this was a

piece of deception tending to mislead, as his books contained no entries that could aid him in that regard.

(P. 158, fol. 203.)

Eighth. Being asked, on cross-examination, to name the person, other than himself, by whom fat liquored bark-tans had been used for more than 20 years, he mentions a few goods seen by him at the shops of U. M. Place, David Spaulding, Mr. Dunson, Alanson Judson, and some skins of Russell, and Samuel Dodge; these and no more.

(P. p. 159, to 162 inclusive.)

In none of these instances does he know how the leather was treated; he did not examine the goods at the shops of Place, Spaulding, Dunson or Judson, in reference to the treatment of the leather with fat liquor or otherwise, and cannot swear that any of it had been so treated.

(P. 162, fol. 207; p. p. 164 and 5, fol 210.)

He says that on two or three occasions he squeezed the skins on Russell's fence, and there was fat liquor in them; but how they had been treated with it, whether it was used in a warm or cold state, or whether any other ingredient or material had been used in their treatment, he did not know, and would not venture to testify.

(P. p. 162-3, fol. 208; p. 164, fols. 209 and 210.)

This is the "*extensive use*" to which he refers in his broad assertion on the direct.

Ninth. Notice has already been taken of some testimony bearing upon the use of fat liquor by Dodge and Dunson; there will be something in another ~~communication~~ connection tending to show that Spaulding had no knowledge of the patented process; and defendants do not venture to examine U. M. Place in reference to his knowledge and practice.

Tenth. It is shown by Austin E. Porter, foreman and partner of Alanson Judson for 25 years past, that Judson did not, prior to 1869, make any such leather as is produced by complainant's patent.

(P. 367, fols. 427 and 429.)

Yet, Place speaks of Judson's leather in the same terms that he does of his own and others, which, he says, has been in "extensive use" in Gloversville for more than twenty years, and which he would have the court believe was the same as produced under the patent.

Eleventh. It appears in evidence that Russell had been experimenting with fat liquor, and other materials, for a long time, and did not produce a satisfactory result till 1869.

(P. 37, fols. 68 and 69.)

It was during these experiments that Place saw skins upon his fence, if at all. He classes this leather with

that seen by him at Judson's and other places, which he swears had been extensively used for more than 20 years. Showing, therefore, that Judson's and Russell's was not the same leather produced by the patent, shows that none of it was the same.

But, another and sufficient answer to all this talk about soft leather prior to the patent is, that, supposing it to have existed, there is no evidence to show how it was treated; unless it is to be inferred that it was treated by some of the imperfect or experimental processes shown to have been in use.

Twelfth. Place swears to the use of fat liquor in the treatment of bark-tanned skins, every year from 1856 to the date of his examination in 1872.

In this statement he is squarely contradicted by his own workman and witness, Charles B. Wessels. He worked for Place in his skin dressing and glove manufacturing business during the five or six years next preceding the winter of 1869-70; and testifies that during that period no bark-tanned skins were treated with fat liquor by Place or his men.

(P. 266, fol. 313 and 314, p. p. 267 and 8, fols. 314 and 315.(

Thirteenth. By Place's own admission, and the testimony of John W. Place, referred to under the head of infringements by defendants Place, it appears that they have done more since 1869, with bark-tanned sheep and lamb skins, treated by themselves and by Dodge

for them with warm fat liquor, than he treated in any way, or ever used or saw in all his previous experience.

Why this change, if he understood complainant's process prior to the patent?

Why have they uniformly used the liquor *warm* since the patent, while before, they used it cold or warm according to the season, and the convenience of the operator?

They have given no answer to these questions, and can give none consistent with the theory of their defence now under discussion.

JOHN W. PLACE.

This witness is a brother of Isaac V. Place, and one of the defendants in No. 134.

Some idea of his character as a witness may be obtained by reference to his cross-examination at p. p. 184 and 185; fols. 231 and 232.

A brief discussion of his evidence will suffice.

First. He testifies to the treatment of bark-tans with fat liquor in 1856; but it is quite apparent that this treatment was simply the "dampening down" process, which, as we have seen, has no likeness to the patented process. Moreover, the fat liquor was applied in its

that seen by him at Judson's and other places, which he swears had been extensively used for more than 20 years. Showing, therefore, that Judson's and Russell's was not the same leather produced by the patent, shows that none of it was the same.

But, another and sufficient answer to all this talk about soft leather prior to the patent is, that, supposing it to have existed, there is no evidence to show how it was treated; unless it is to be inferred that it was treated by some of the imperfect or experimental processes shown to have been in use.

Twelfth. Place swears to the use of fat liquor in the treatment of bark-tanned skins, every year from 1856 to the date of his examination in 1872.

In this statement he is squarely contradicted by his own workman and witness, Charles B. Wessels. He worked for Place in his skin dressing and glove manufacturing business during the five or six years next preceding the winter of 1869-70; and testifies that during that period no bark-tanned skins were treated with fat liquor by Place or his men.

(P. 266, fol. 313 and 314, p. p. 267 and 8, fols. 314 and 315.(

Thirteenth. By Place's own admission, and the testimony of John W. Place, referred to under the head of infringements by defendants Place, it appears that they have done more since 1869, with bark-tanned sheep and lamb skins, treated by themselves and by Dodge

for them with warm fat liquor, than he treated in any way, or ever used or saw in all his previous experience.

Why this change, if he understood complainant's process prior to the patent?

Why have they uniformly used the liquor *warm* since the patent, while before, they used it cold or warm according to the season, and the convenience of the operator?

They have given no answer to these questions, and can give none consistent with the theory of their defence now under discussion.

JOHN W. PLACE.

This witness is a brother of Isaac V. Place, and one of the defendants in No. 134.

Some idea of his character as a witness may be obtained by reference to his cross-examination at p. p. 184 and 185; fols. 231 and 232.

A brief discussion of his evidence will suffice.

First. He testifies to the treatment of bark-tans with fat liquor in 1856; but it is quite apparent that this treatment was simply the "dampening down" process, which, as we have seen, has no likeness to the patented process. Moreover, the fat liquor was applied in its

"natural state, just as they got it from the mill," i. e. in a *cold* state.

(P. 180, fol. 226 ; p. 182, fol. 229.)

On the Klein trial he testified that this leather was "not as nice or any thing like it" as the specimens there produced by complainant, which were treated according to his patent.

(P. p. 182 and 3, fol. 229; p. 294, fol. 345; p. 274 fol. 224.)

Yet, this treatment mentioned by Place is put forward as a prior use of the patented process, and is a fair specimen of all the testimony for the defence on this point.

Second. This lot is all he mentions as having been treated with fat liquor prior to 1869; and he knows of no other persons who so treated skins prior to 1869.

(P. 183, fol. 230.)

Third. He further states, in answer to a question framed to elicit such an answer, that bark-tanned sheep and lamb skins rendered soft and pliable by some process or treatment, had been in the market in Gloversville, and there used for the manufacture of mittens and gloves more or less for the last 16 years.

(P. 181, fol. 228.)

The value of this class of testimony has already been sufficiently discussed.

Fourth. But valueless as this broad statement would be, if true, a reference to his cross examination, in connection with other evidence, will show how recklessly he testified on the direct, even on this point, and will tend to characterize the testimony for the defence.

Being called upon to specify all the places where he had seen such leather, he can only name,

1. The shop of David Spaulding in 1856.

   (P. 157. fols. 233 and 234.)

   Of this leather, however, the only examination he made was to feel of a pair or two of gloves; he did not see the leather prepared, did not even see it in the skin after it was prepared, but only the gloves made from it; and he does not pretend to know how the leather was treated.

2. The shop of complainant, in 1856 or 7 he thinks; but he saw this only in the made up gloves, and examined but one pair of these; has no knowledge how the leather was prepared.

   (P. 188, fols. 234 and 235.)

3. In a laying off shop on Main street, just past the corner of Fulton, up stairs, in the summer of 1866 or 7; but he does not know whose shop it was, did not examine the gloves, and did not know how the leather was prepared.

   (P. 188, fol, 235.)

It was shown in rebuttal by two witnesses, Charles W. Rose and Jonathan A. Betts, that there was no laying off shop in the place mentioned by him ; or its immediate vicinity, in 1866 or 1867.

(Dep. of Rose, p. 355, fols. 414 and and 415 ; dep. of Betts, p. p. 373 and 374, fols. 436 and 437.)

4. Hyman's laying off shop, in 1869 ; but of this he gives no definite account ; and moreover, the time is about the date of the complainant's first patent.

(P. 188, fol. 235.)

This is all the basis of his sweeping assertion on the direct, and all he can say about such leather prior to the patent.

JAMES F. PLACE.

This witness is a brother of Isaac V. and John W. Place ; and it is not unreasonable or uncharitable to suggest that he strongly sympathizes with them in their fight against complainant's patent.

His testimony should have been entirely excluded from the case, for the reason that his name was not embraced in the answer setting up this defence.

(P. p. 9 and 10, fols. 16 and 17, ; p. 249, fol. 296.)

He seems to have been called to bolster up the testimony of Isaac V. Place, and his workman, Henry E. Krause.

As, however, he knows nothing *more*, but if anything at all, *less* than is embraced in their testimony, it will not aid the discussion to spend time with him.

Besides, his testimony is so much guess work, so confused and contradictory, such a medley of the different classes of skins, and the various ingredients and processes of treatment, that it defies analysis.

It may be noticed, however, in dismissing him, that he was, at the time of his examination, in the employment of John H. Putman, with whom he had conversed concerning the patent, and of whom the complainant claimed damages for infringement.

(P. 250, fol. 297.)

HENRY E. KRAUSE.

This man is a peripatetic German shoemaker, who worked for Isaac V. Place, and is called to corroborate him.

His testimony on the direct, is, in substance, as follows:

1. He worked for Place in 1856 and 1857, two years, and since then four or five years in all, down to January, 1863.

(P. 108, fol 148.)

2. In all these six or seven years, he can speak of only two occasions on which Place had bark-tanned sheep and lamb skins treated with fat liquor.

(P. 108. fol. 148.)

It will be remembered that Place testified on the direct to such treatment by him every year.

3. On the first ocasion referred to by Krause, he says that he assisted Place; that some of the fat liquor they heated in a kettle "for the purpose to strike through the leather quick," and left the skins in over night.

(P. 108, fol. 148.)

It has been shown by the testimony of Gillette and Fulton that to immerse skins in warm fat liquor, and allow them to remain so long, would injure the leather, and render it unfit for gloves.

(P. p. 321 and 2, fols. 275 and 6; p. 273, fol. 322.)

4. The second occasion was in 1862; he did not see this lot treated, but thinks from the appearance of the leather that they were fat liquored.

(P. 108, fol. 148.)

5. In speaking of both these lots, he says that after treatment the sheep skins were not suitable for "dog-skin gloves."

(P. 109, fol. 149.)

It is clearly shown that sheep skins treated by the patented process, make suitable leather for "dog-skin gloves."

(P. 273, fol. 323: p. 322, fol. 377.)

These two lots, therefore, could not have been treated according to the patented process.

6. Witness then says that Place used bark-tanned skins treated with fat liquor for five or six years, other than the two lots mentioned, but not extensively; cannot tell how many.

But he does not pretend that he saw these treated, or that Place treated them; nor does he intimate that they were any better, or even as good as the two lots first mentioned.

(P. p. 109 ond 110, fol. 150.)

7. He next speaks of some gloves shown him by Russell; some skins hanging on Russell's fence; some known as the "A. B. Giles' barn," in 1863 and 1864; some skins in Dodge's shop; gloves at Dunson's shop, in piles, and tubs containing what he judged to be fat liquor. at a shop

(P. 110, fols. 150 and 151.)

These are all he mentioned; and he speaks of them all, including Place's, in the same manner, making no discrimination either as to mode of treatment or quality.

To all this, it is pertinent to reply further.

First. As he saw none of the leather mentioned by him treated, except the one lot by Place, it is impossible for him to know how it was treated.

Indeed, upon his cross-examination, he admits that there had been various methods in use in Gloversville for softening bark-tanned skins, such as with oil, soap and warm water, and other processes, and that he cannot tell from an examination of the leather by what method or process it has been treated.

(P. 115, fols. 155-6.)

Second. As he speaks of all the leather above mentioned in the same terms, it follows that, so far as the matter can be determined by his judgment from inspection, none of said leather was treated according to the patent process; for he includes in the same categegory Place's and Russell's, which, it is plain enough from the evidence, were not products of the patent treatment.

Third. On the Klein trial, when speaking of skins which he assisted Place in treating, being asked how soft the leather was, he replied, "soft enough that we thought they would do for glove manufacturing, so that they would not break out the stitches."

(P. 115, fol. 156.)

Fourth. He did not examine the skins casually

noticed by him at Dodge's, or the liquor which he there saw in tubs, and hence, can only *guess* at the character or quality of either.

(P.-p. 117 and 118, fol. 158.)

Fifth. It is shown by the testimony of Hiram S. Cole and James M. Kennedy, that Dunson did not occupy the "A. B. Giles barn" at the time Krause mentions, and that there was no such leather as he speaks of on the premises.

(Dep. of Cole, p. 339, fol. 396; dep. of Kennedy, p. p. 342-3, fol. 400.)

Sixth. He testified in substance, on the Klein trial, that in treating the skins for Place with fat liquor, he applied some of it warm and some cold, some with a sponge and some were put in the liquor and soaked cold. And when asked with which, warm or cold, he treated the larger number, he replied that he could not tell, it depended some on the weather and the time he wanted to spend; and to these statements he adhered on his examination in this case.

(P. p. 113-14, fol. 154.)

Seventh. On his cross-examination in this case he says, that he put the skins in cold fat liquor the first time, and some days after they warmed some liquor for the purpose of striking through the skins quicker, and

making it more comfortable to work; that *it was too cold to work comfortably without heating.*

(P. 113, fol. 154.)

Krause is called to corroborate Place, and *does* corroborate him, but not in the way desired by the defence. It is quite clear from Place's testimony, that he had no prior intelligent notion of the patented process; that he used fat liquor,—so far as he used it at all,—in a cold or warm state, indiscriminately, according to the season and convenience, and had no idea of the benefit of heating in its effect upon the emulsion or the leather; and in this Krause fully sustains him.

Eighth. He testifies that Place brought him the fat liquor and told him to fat liquor the skins, without giving any directions as to the manner of preparing the liquor, or treating the skins.

(P. 113, fols. 153 and 154.)

This shows clearly that Place had no definite, intelligent method or process of treating skins with fat liquor, and especially of heating it, or he would have given directions to his workman, Krause, who had no previous experience in the business.

Ninth. Through a period of 13 years, from 185[illegible] to 1870, Krause was more or less in the employment of Ward & McNab, Daniel S. Tarr, Lowenstein, Mende Bros., and Alanson Judson, most of them large glove manufacturers; and the two lots of skins at Places, are the

only bark-tanned skins he can name as having, to his knowledge, been treated with fat liquor in any way prior to 1869.

(P. 112, fol. 153.)

This, too, is significant, bearing upon the pretended "extensive use" of fat liquor on this class of skins during that period.

WILLIAM H. MONROE.

A brief examination of the testimony of this witness will show the character of this defence, and the kind of instruments employed by the defendants and their co-conspirators, to break down complainant's patent.

First. On the direct examination he boldly testifies to the knowledge and use of fat liquor, both warm and cold, for 18 years past, in the treatment of bark-tanned sheep and lamb skins, as a process, for the purpose of rendering them soft and pliable, and removing the "squeak." That he practised it at Dedham, (now Norwood,) Mass., for twelve, and at Gloversville for five years.

(See his testimony on the the direct, from and including fol. 125, p. 85, to fol. 158 p. 88.)

Second. On his cross examination, it appears that the experience in Norwood to which he alluded on the

be taken from the leather, and no question or ponit was made about it in their business. That a skin prepared according to the patented process would be unfit, *entirely ruined for cotton rolls.*

(P. p. 312 and 313, fols. 354, 5 and 6.)

His testimony on this point is emphasized by the fact, drawn out by defendants on cross-examination, that he had treated bark-tanned skins with warm fat liquor, and knew its effect upon them.

(P. 316, fol. 369.)

This witness, also, introdeces two skeep skins prepared by him for cotton rolls from bark-tanned skins in the bark-tanned state, which are fair specimens of that kind of leather by his firm, while Monroe was with them. They are complainant's exhibits Nos. 8 and 9.

(P. 312, fol. 366; p. 316, fols. 369 and 70.)

He says further that complainant's exhibit No. 6; is not, he thinks, quite as good as a fair average of bark-tanned sheep skins in the bark-tanned state.

(P. 316, fol. 370.)

This witness also says, that exhibits 8 and 9 are not suitable for gloves, and could not be made so by staking, nor without some softening process. And so say

Fulton and Gillette, adding that the "squeak" is not out of the skins.

(P. 316, fol. 369; p. 287, fol. 338; p. 335, fol. 392.

It is shown that complainant's firm, (N. C. Russell & Co.) use this class of skins for gloves, but first subject them to the patented process.

(P. 288 and 289, fol. 239.

But to put this matter beyond question or cavil, complainant caused one of these skins, No. 9, to be thoroughly staked, after its production in evidence and identification, and it remained in an unsuitable condition for gloves; and it still speaks and *squeaks* for itself.

(P. 390, fol. 454; p. p. 391 and 2, fol. 456.)

Seventh. On being cross-examined as to his use of fat liquor in Gloversville, he is able to specify only five occasions, viz:

1. On about 50 dozens while at work for Dodge in 1864.

(P. 100, fol. 139.)

He says that while at Dodge's he treated about 200 dozens of sheep and lamb skins, and in so doing he tried a dozen different processes.

(P. 100, fol. 140.)

And the fat liquor here used was applied mostly *cold* he thinks.

(P. 101, fol. 140.)

2. A few skins treated at his shop in 1865.

(P. 101. fol. 141.

As to this lot he cannot remember whether the liquor was applied cold or warm ; but they were done by way of experiment.

(P. 101, fol. 141 ; p. 293, fol. 344.)

3. A few, from half a dozen to a dozen, done in 1867 or 1868, ot which he can give no particular account.

(P. p. 101 and 102, fol. 141.)

4. A few at the shop of George W. Gillette in 1867 or 1868,in connection with Gillette.

(P. 102, fol. 141.)

Says that he was showing Gillette how to prepare bark-tanned skins for gloves with fat liquor; but he does not remember whether the liquor used was warm or cold, or much about the treatment, in fact, although he was attempting to give Gillette a process by which such leather could be rendered suitable for gloves.

(P. p. 102 and 103, fol. 142.)

5. A lot of less than a dozen skins treated at his house, in 1860.

(P. 103. fol 142.)

Eighth. Gillette, and Combs, his partner, are called as witnesses by complainant, and testify that they purchased bark-tanned sheep and lamb skins of Monroe, and that he undertook to give them some process, by which the skins could be softened and fitted for mittens and gloves.

First he directed the use of fat liquor, castile soap, salt, and neat's foot oil, with which the skin was *dampened* for staking.

This did not answer the purpose, and he afterwards gave them different processes; among which were alum dissolved in water, eggs and neat's foot oil, fat liquor and water; the extract of tanning and a composition call "stuffing."

But none of these processes produced the desired effect; none of them killed the "squeak," or made the leather soft enough for gloves.

Monroe, in all his instructions to, and experiments with them, never told them to use the fat liquor *warm.*

(P. 319, 320, and 321, fols. 373, 374, and 375; p. 351, fols. 410 and 411.

Ninth. Monroe admits on cross-examination, that when on the direct he stated in substance, that "the

application of fat liquor to bark-tanned sheep and lamb-skins, had been a well-known and perfected process for softening such skins and making them pliable and removing the squeak from them for more than twenty years, and been understood by himself for more than eighteen years," he referred to the use of fat liquor by the persons, and in the manner he had then stated; i. e. on his cross-examination, which manner has been shown.

(P. 193. fols. 142-3.)

This furnishes a fair specimen of much of the direct testimony for the defence, which was given by willing witnesses in response to skillful interrogatories, framed in a manner to draw out wholesale conclusions upon the questions in issue.

Tenth. Monroe's testimony, so far as he pretends to a prior knowledge or use of the patented process, is utterly worthless; but it aids in illustrating other parts of the defence.

1. It shows that unscrupulous means are employed to sustain the defence, and defeat a valuable patent. Defendants must have well known that Monroe's pretence of prior knowledge and use was utterly false.

2. The formula used by Monroe in reference to the cotton roll leather, "soft and pliable and suitable for gloves," is the same employed by most of the witnesses for the defence, in reference to leather

prepared or seen by them. In every instance where complainant has been able to show the real character and condition of leather thus spoken of by them, it turns out like Monroe's; and, therefore, defendants cannot reasonably ask the confidence of the court in any of their testimony on that subject.

3. His experiments at Dodge's were prior to his instructions to Gillette; Dodge's pretended knowledge of the patented process runs back of Monroe's engagement for him in 1864; it is fair to presume that Monroe learned all Dodge knew at that time about dressing and treating skins, for he was there to learn that trade and business, (p. 241, fol. 288); Monroe *did not* understand the patented process, and, therefore, Dodge did not.

4. His testimony, also, reveals very clearly the felt want of such a process as the patent furnishes, and the blind but unsuccessful groping for it by manufacturers; especially does it show that the benefits of *warm* fat liquor were not understood.

HENRY HULL.

This witness testifies to certain skins treated by him at David Spaulding's, he thinks, in 1857, 1858, and 1859.

His account of it is, that he treated them sometimes with fat liquor; sometimes with soap, oil and eggs; sometimes he used salt with the liquor; sometimes he used the fat liquor cold, and sometimes about milk warm; sometimes he put it on with a sponge, and sometimes he dipped the skins; sometimes he would leave them in the liquor an hour, and sometimes not so long; there was no particular time.

(P. 121, fols. 162-3.)

He further testifies to ten or twelve dozens treated by Adam Quackenbush in 1865 or 1866; but he does not know whether in this case the liquor was used in a warm or cold state.

(P. 122, fol. 163.)

This witness does not aid the defence for several reasons:

First. Assuming all his statements to be true, and they show no defined, understood process for treating with fat liquor, and especially no knowledge of the benefit of *warm* fat liquor; for he sometimes used it with, and sometimes without other ingredients; sometimes cold and sometimes milk warm; he had, in short, no rule to guide him, but was blundering along in a series of crude experiments.

Second. It is evident that he did not strike the patented process, for he allowed the skins to remain an hour or more in the liquor, which, as has been shown

would have been fatal to the leather with *warm* fat liquor prepared and used according to the patent.

Third. On his cross examination, he says that he used the fat liquor mostly cold, and found it just as good cold as warm, only it took a little longer to penetrate the skin.

(P. 123. fol. 165.)

Fourth. That his treatment at Spaulding's was merely experimental, appears from his cross examination and his testimony on the Klein trial, when he said that he "first got some soap and soda, and tried that on the skins, and it did not appear to work good, didn't soften the skin to suit him, so he went to the mill, and got the fat liquor and tried that."

(P. 124, fol. 166; p. 294, fol. 345.)

Fifth. It is evident from his cross examination, that his treatment of the Spaulding skins was what is known as the "dampening process."

(P. 106, fols. 167 and 168.)

Sixth. He testified in this case that the skins which Quackenbush treated were all treated with fat liquor; but on the trial of the Klein case, he testified that five dozens of them were treated with fat liquor, and the other five with soft soap, soda, and oil mixed in, to see which would be the best five dozens.

(P. 122 fol. 163; p. 127, fols. 168 and 169; p. 294, fol. 345.)

First. It is quite evident on his own showing, that he had no definite idea of a process like the one patented, and especially of the efficacy of *warm* fat liquor.

Second. He does not say that *all* the "squeak" was removed from the skins treated by him, but that they "did not have that 'squeak' in them after treatment," i. e. that degree of "squeak."

On the Klein trial, when asked to state the effect produced upon these skins by the fat liquor, he did not say a word about the "squeak."

(P. 294, fol. 345.)

Third. Some of the lots treated by him were not suitable for gloves; it has been shown that skins treated by the patented process *are* suitable for gloves.

On cross-examination, he admits that a third of them were suitable only for mittens, and that the gloves made from the rest were of a coarse quality.

(P. p.. 172-3, fol. 218.)

Fourth. After this lot, he did not treat any more with fat liquor until 1870; yet in the meantime he did make gloves and mittens from skins in the bark-tanned state; which it is not supposable that he would have done, having a knowledge of the patented process.

(P. 166, fol. 212; p. p. 170-71, fol. 216.)

Fifth. He says, on cross-examination, that he sometimes used the liquor warm, and sometimes cold, according to convenience and circumstances, showing that he had no rule, no defined process, and no idea of the virtue in *warm* fat liquor.

(P. 172, fol. 218.

Sixth. It is apparent that a portion of the 25 or 30 dozens treated by him, were only subjected to the "dampening down process;" and on the direct he makes no distinction between them, either ignorantly or willfully confounding two kinds of treatment, wholly distinct in their character and purpose; or else, which is probably the fact, the whole lot were only "dampened down," and are now put forward as an instance of fat liquor treatment covered by the patent.

(P. 172, fol. 218.)

Seventh. It appears that complainant once called on him as an infringer of the patent, and it is not improbable that this circumstance stimulated his zeal for the defence.

(P. 173, fol. 219.)

Eighth. On the direct he swears unhesitatingly and unqualifiedly to seeing bark-tanned sheep and lamb skins that had been treated with fat liquor; but on cross examination he is compelled to admit that he had no personal knowledge how the leather referred to was treated, and that he testified from hearsay and

he treated a few more with fat liquor, and that these were the last that he ever so treated for himself.

(P. p. 66 and 67, fol. 103.)

On cross-examination, however, he says that he don't remember treating any in 1857, and that those done in 1856 were treated in the same way, substantially, as the first mentioned.

(P. 70, fol. 108; p. 73, fol. 111.)

3. He further testifies, in substance, that in 1862 he imparted his mode of treatment to P. C. & D. G. Heacock, of Kingsboro, and assisted them to some extent in treating one batch.

(P. 67, fol. 103; p. 69, fols. 106 and 7.)

A few suggestions and facts will, it is believed, satisfactorily dispose of his testimony, and leave the patent intact.

First. It is quite apparent that Mr. Northrup had no intelligent idea of the patented process, that his treatment was varied, capricious, experimental and unsatisfactory.

He had no previous experience in the use of fat liquor, for such a purpose; he treated but a few skins, all told; yet, in the treatment of these few, he sometimes used one ingredient and sometimes another; sometimes he applied the liquor *cold* and sometimes warm.

There is no explanation, excuse, or theory for the use of the liquor *cold*, in any instance mentioned by him, consistent with a knowledge on his part of the benefit of heating it.

Second. There is an attempted explanation for the use of other ingredients, to-wit: that light skins require fat liquor only, while thick and heavy skins require the addition of other ingredients.

(P. p. 67 and 68. 104 and 105.)

But, this explanation is fatal to the claim that he understood the patented process, for by that, as has been shown, thick and heavy skins are treated in the same manner as light, and with like effect.

(P. 273. fol. 323.)

This is also illustrated by complainant's exhibits. No. 1 is a bark-tanned sheep skin treated by the patented process. No. 6 is a like skin the bark-tanned state. No. 2 is a bark-tanned lamb skin treated by the patented process. No. 7 is a like skin in the bark-tanned state.

(P. p. 282 and 283. fols. 333 and 334.)

Third. It appears that his treatment is not like the patented process, from the fact that those designed for fine goods had to be mooned to fit them for gloves.

(P. 67. fol. 104.)

Fourth. The fact that the witness discontinued the treatment, and has never since resumed it in his own business, is pretty conclusive evidence that he never hit or understood the genuine patented process.

It is not a satisfactory answer to say that he discontinued it on account of an imported article that competed with the goods.

(P. p. 68 and 69; fols. 105 and 6.)

The imported article to which he refers, whatever it may have been, continued in the market down to 1871.

(P. 72, fol. 110.)

Yet, no other person, among the host of witnesses examined, makes any reference to it; and during all the time, by defendants' own showing, many persons have been experimenting with fat liquor on bark-tans, endeavoring to produce just such an article.

What is still more singular is, that Mr. Northrup, after having discontinued his fat liquor treatment on account of this competing article, and while it was still in the market, ~~undertook~~ to instruct his friends, the Heacocks in the mysteries of fat liquor, and actually set them to experimenting in the same direction.

Fifth. The experience of the Heacocks under the instructions and impulse given them by Northrup, related by Philander, a witness for defendants, will reflect light upon the knowledge of this witness, and the character of his fat liquor treatment at Broadalbin.

The testimony of Heacock will be considered next in order.

Sixth. It is in evidence that in 1857 and 1858, after Mr. Northrup discontinued his treatment, he made up sheep and lamb skin goods in the bark-tanned state.

(Dep. of Earl, p. 385, fol. 449.)

This fact is wholly incompatible with the claim that he had reached the patented process in his previous experiments; and, also, with the assumption that there was an article in the market with which the improved leather could not successfully compete. Either leather made by the patented process, or a competing article that could drive it out of the market, would be far superior to bark-tanned leather in the bark-tanned state.

Seventh. Philo Earl and James Newton are leather dressers and manufacturers, who carried on business in Broadalbin at the same time Northrup was treating the bark-tans. They did more or less work for him, and had an opportunity of knowing what he was doing; yet they never saw any such leather as complainants in his possession, or in Broadalbin, or anywhere else prior to the patent.

(P. 385, fol. 449; p. p. 388-9, fols. 452-3.)

It may, and doubtless will be said that, this is negative evidence, that Northrup may have made such leather as he describes without their knowledge. If

these witnesses were introduced to contradict Mr. Northrup, upon the fact of his experimenting with fat liquor, and producing some kind of leather as the result, this answer to their evidence would be pertinent and forcible, but they are not; there is no doubt that he felt the same want experienced by so many others, and dabbled with fat liquor and other things to meet it.

But the question is in regard to his knowledge of the *patented process*, and the *quality* of the leather produced by him; and upon this question such evidence has great weight.

It is *physically* possible, it is true, that Northrup might have produced leather equal to complainant's without the knowledge of his neighbors in the same business; but it is scarcely *morally* possible.

Manufacturers are wide awake and sensitive to every change and improvement; and no such process, producing such results as complainant's, could be practised by one without the knowledge of the others.

This is peculiarly true of the glove business, as it is confined mostly to Fulton County, within very narrow limits, and is subject to sharp competition.

The inquisitive spirit of some of the manufacturers has been disclosed by the testimony in this case; for, if Isaac V. Place and Uriel Case are to be credited, they were in the habit of squeezing and smelling of skins that they found hanging on their neighbors' fences.

PHILANDER C. HEACOCK.

This witness naturally supplements Mr. Northrup, as he is a member of the firm of Heacocks, to whom Northrup imparted his knowledge of fat liquor.

His statement is, in brief, that he commenced treating bark-tanned skins with fat liquor and other things in 1862; that he heated fat liquor *with the other ingredients put in it;* and that he kept the skins in the liquor *from* 12 *to* 24 *hours* as was convenient, sometimes leaving them in over night, and sometimes from morning till night.

That they did not continue in it long, only through 1862 and 1863, doing but a limited business at it in those years.

(P. 119, fols. 159 and 160.)

He further says that Mr. Northrup assisted them in preparing the first fat liquor, in 1862, and that they continued to prepare it in the same way thereafter; thatinits preparation they put in soap, eggs, and something else which he does not remember.

(P. 119, fol. 160.)

His testimony, thus stated, in connection with his cross-examination reflects light upon Mr. Northrup's testimony, and upon the character of the defence generally.

First. It is clear that he had no defined and understood process like the patented one; for he used other ingredients generally, if not always, with the fat liquor, including eggs.

Second. If he had no such process, then Northrup had not, for he learned of the latter, and followed his instructions. His testimony makes it clear that North rup generally used eggs and other ingredients, and considered them essential.

It will be remembered that the egg treatment was old and useful, but expensive.

Third. Heacocks left the skins in the liquor from 12 to 24 hours. It could not, therefore, have been the patented process, for had it been, this treatment would have ruined the leather for gloves, as has been shown.

Fourth. His description of the effect of their treatment shows that it could not have been the patented process.

He says, "treating them in fat liquor has a *tendency* to make them soft and pliable, and to do away with the squeak from the face. This treatment makes the skins so we can cut gloves out of them."

(P. 119. fol. 160.)

Soap suds has a *tendency* to do the same thing, and has sometimes been used for the purpose, but it don't do

it effectually, and it would not be the patented process if it did.

Fifth. He treated none with fat liquor after the two years mentioned, and, although asked why he discontinued it, he assigns no good reason, assuming their treatment to have been a success. He does not allude to an imported article that competed with this leather.

Sixth. During the years 1862 and 1863, and subsequently, they made mittens and gloves from bark-tanned sheep and lamb skins in the bark-tanned state.

(P. 120. fol. 160.)

Seventh. Mr. Heacock finally fixes the character of his use of fat liquor beyond all question, by saying that, during the two years designated, he "used it in different ways, *by way of experiment.*"

(P. 120. fol. 162.)

Had all the other witnesses for the defence been as honest as this one, it would have saved a good deal of trouble and expense.

Eighth. That the use of fat liquor by the Heacocks was quite limited, and ordinary in results, also appears from the fact that it did not attract the attention of their workmen.

Hiram Freeman, who worked for them from 1848 for about six years next ensuing, and had access to all parts of their business premises, saw no bark-tanned skins treated with fat liquor.

He did, however, see such skins treated with eggs or castile soap.

(P. 384, fol. 448.)

JAMES B. CHAPMAN.

This witness seems to have been called to corroborate Isaac V. Place, Samuel Dodge, Sen., and Northrup.

As their testimony, even if all true, fails to sustain the defence, it is of small moment what this witness says in corroboration.

He testifies to seeing Northrup treat skins at Broadalbin; that Dodge softened a batch for Chapman & Warring,—of which firm he was a member,—in 1857; and that he had sold goods for Place which had been softened by some process.

(P. 130 and 131, fols, 172 and 173.)

A few words in ralation to his position and testimony will suffice:

First. He was, at the time of testifying, and for ten years then past, had been, Isaac V. Place's mitten peddler.

(P. 131, fols. 173-4.)

Second. He was in the service of Mr. Place at the times the actions at law against the latter, and against Klein were tried, and knew of their pendency; yet it did not occur to Place, or to him, that he knew anything pertinent to the matters in issue, and he was not called as a witness in either.

(P. p. 131 and 2, fol. 174.)

Third. He had no interest in Northrup's skins, or his treatment of them; did not see the whole process, and, of course, is not competent to speak of it with any assurance of accuracy.

(P. 132, fol. 174; p. 133, fol. 175.)

Moreover, Northrup ought to know best about his own treatment of the skins, and we have his account of it illustrated by Heacock. There is no doubt about the fact that Northrup experimented with fat liquor.

Fourth. He brings out one fact, however, in regard to the character of the skins treated by Northrup with fat liquor, which is significant; he says they were the "*finest, thinest, and best skins, sorted out,*" and that *between*

these and the general average of bark-tanned sheep and lamb skins, there was considerable difference. The balance of the skins from which these were "sorted out," were treated by some other process.

This may account for the fact that the leather produced by Northrup's fat liquor treatment was *usable*; but it shows, at the same time, that the treatment employed by him was not the patented process which works as well, and produces as good results upon thick and heavy skins, as upon thin and light ones.

Fifth. Chapman was in the manufacturing business two years, in Amsterdam; the lot treated for his firm by Dodge was done in September of the first year; witness was personally engaged in the firm manufactory at Amsterdam, during the remainder of the two years; they had no more bark-tans treated for the purpose of softening them, during this time; yet they did make mittens and gloves of bark-tanned sheep and lamb skins in the bark-tanned state.

(P. 134, fol. 176.)

This suggests the statement of Dodge on his examination, that when Chapman took his skins away he informed him how to treat the skins himself with fat liquor.

(P. 202, fol. 250.)

The non-user of the process by Chapman is a significant comment upon the fat liquor treatment, both of Dodge and Northrup.

SIDNEY S. PLUMMER.

This witness was called by defendants on the issue of prior use. It turned out that all his use of fat liquor was in the *cold* state; and his testimony, therefore, would not be noticed at all in this discussion, but for some points in it which sustain complainant's ~~points.~~ patent.

On the direct, he testifies, in substance, that during the twenty years prior to 1869, he had experimented with fat liquor, upon bark-tanned skins, on four or five different occasions.

(P. p. 146-7. fols. 90-1.)

That in 1871 he delivered some skins to Russell & Co. for treatment, and also some to defendant Dodge; and that the latter were returned in the best condition.

(P. 148. fol. 192.)

This is the sum of his testimony in the direct, and it, in connection with his cross-examination, suggests the following comments, viz:

First. His use of fat liquor, as described by him, was purely experimental.

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First. His use of fat liquor, as described by him, was purely experimental.

On the cross-examination he speaks of it as experimental; and when asked on the re-direct what he means by the term "experiment," he replied, "I mean that I was trying to see if I could make bark-tanned skins soft by fat liquor."

(P. 149, fol. 193; p. 150, fol. 194.)

Second. These experiments were unsuccessful. He says, on cross examination, that he did not succeed in getting the "squeak" out; and that the leather produced was considerably inferior to complainant's.

(P. 149, fol. 193.)

Fourth. He experimented, it seems, not only for himself, but for others,—Burr, Hosmer and Mills.

(P. 149, fol. 193; p. 150, fol 194.)

These experiments on different occasions, add to the accumulated evidence of a want of some process by which to utilize bark-tanned sheep and lamb skins, which existed all through the history of the glove business, but was never met until complainant published his invention.

This witness had long been acquainted with the business in Gloversville and vicinity; yet the only use of fat liquor upon bark-tanned skins of which he could speak, was in the few crude experiments made by himself.

Fifth. It is worthy of notice that, when speaking on the direct, of the effect of fat liquor upon the skins treated by him, he uses substantially the same formula put into the mouths of most of the witnesses for defence, "it made them soft, plump and pliable, and suitable for dog-skin gloves."

(P. p. 146-7, fol. 190.)

His testimony shows how much their formula is worth when used by others.

Sixth. Suppose Dodge did treat a lot of skins in 1871, better than Russell & Co. treated another lot, what of it?

How Dodge treated his does not appear, and Russell & Co. may have failed, from accident, or slighted theirs. It does not prove that complainant's process is not a good one.

It is probable that Dodge treated his with the egg process, or in some other manner more elaborate and expensive than Russell & Co., for Plummer paid him $1.50 or $2.00 per dozen, which is more than Russell's treatment costs, and more than Dodge charges for his fat liquor treatment according to his testimony.

(P. 150, fol. 193-4; p. 318, fol. 372; p. 229, fols. 276-7.)

Besides, the leather treated for him by Russell & Co., poor as the defendants would have it, was superior to that produced by his experiments prior to 1869.

(P. 150, fol. 194.)

RESULT OF DEFENDANT'S TESTIMONY ON THIS POINT.

We have now collated and examined all the testimony for the defence on the subject of the prior use of fat liquor in preparing leather for glove purposes; and it is respectfully submitted that the propositions with which we started are fully established.

The felt want for some cheap and easy process by which bark-tanned sheep and lamb skins could be made available for the manufacture of fine gloves; the existence and pressure of that want through all the history of the business; the blind groping for the needed progress, resulting in numerous methods of treatment with a variety of materials, including repeated crude experiments with fat liquor; the unsatisfactory character of these methods and experiments; the failure to meet this pressing want, till the advent of complainant's patent; and the novel and satisfactory character of the patented process, demonstrated by the testimony of experts and practical men, and also by its immediate adoption and extensive use among manufacturers, are all shown beyond doubt.

In every instance shown of the use of *warm* fat liquor prior to the patent, it was thus used merely as a matter of accident or convenience, and not from any conception of the real benefit and advantage of heating the liquor.

Every person shown to have used it [illegible]
warm to cold [illegible]
or convenience o[illegible]
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say that he used i[illegible] of its superior-
ity over the *cold* s[illegible] the contrary, the leading witnesses claim, that *cold* fat liquor is just as good as *warm* for the treatment of this leather.

It is demonstrated, however, beyond doubt, that heating greatly benefits the the emulsion, and increases its favorable action upon the leather; so that, a person understanding it would not, in any season, or under any circumstances, use it in a cold state on bark-tanned skins to fit them for gloves.

By no use of warm fat liquor before the patent, disclosed by the testimony, was the public put in possession of the secret developed in the patent; and if not, then no prior use is shown that affects its validity.

This is the third attempt of defendants, combined with others, to overthrow this patent by establishing the defence of prior use. They have compassed the entire field of mitten and glove manufacture, and even gone to other kinds of business to find witnesses for their purpose. Many of the witnesses examined are extensive manufacturers, and had been quite familiar with the business for a long time past. Yet, all the leather to which they have sworn, covering a period of thirty years, known and *guessed* to be the product of treatment with fat liquor, both warm and cold, does

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Every person shown to have used it flucuated from warm to cold ~~conspicuously,~~ or according to the season, or convenience of the operator; and not one of the numerous witnesses for the defence, even now, rises to say that he used it in the *warm* because of its superiority over the *cold* state; on the contrary, the leading witnesses claim, that *cold* fat liquor is just as good as *warm* for the treatment of this leather.

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not amount to a tithe of the yield from the patented process, in a period of about two years.

The defendants have thus, it is respectfully submitted, aided in establishing both the novelty and utility of the patent.

REBUTTING EVIDENCE ON THIS POINT.

To render assurance "doubly sure," complainant has called numerous witnesses on this point.

All are more or less, and many of them are quite familiar with the glove business, and the various materials used in the manufacture, as much so as any of the witnesses for defence, and have been so for many years past.

These witnesses, and the places where their testimony on this point may be found, are as follows, viz:

John Fulton, p. 31, fol. 62.
George W. Gillette, p. 319, fols. 372-3.
Hiram T. Cole, p. 339, fol. 397.
James M. Kennedy, p. 343, fol. 401.
Lewis P. Johnson, p. 345, fol. 404.
Cornelius A. King, p. 359, fol. 419.
Theodore Welch, p 370 and 371, fol. 432.
Samuel Richardson, p. 379, fol. 442.
James Brownell, p. 381, fol. 445.
David H. Cuyler, p. 383, fol. 447.
Daniel S. Hulett, p. 289, fol. 340.

These witnesses all testify, in subtance, that they never saw or knew of such leather as is produced by the patented process prior to 1869, the date of the first patent.

This testimony, in connection with that of defendants' upon the same point, suggests several things worthy of note in this discussion.

First. All, or nearly all of complainants' witnesses on this point, were shown his exhibits of leather prepared according to the patent, and asked if any leather of that character, quality, and fitness for gloves, was in use or known to them prior to 1869.

On the other hand, none of defendants' witnesses on this point were shown the exhibits on either side, and asked to compare with these specimens the leather of which they testified. And none of them,—except, possibly, Krause and Case—were asked whether or not the leather of the past, to which they were testifying, equalled in quality that produced by the patented process.

They were merely asked, in the stereotyped formula, if it was "soft and pliable, and suitable for gloves."

This ommission is, for several reasons, quite material and significant.

1. On the question of prior use, the burden is on defendants; and it is for them to show, not that there was leather in use suitable for gloves prior

to our patent, but that it was leather substantially like the product of the patent, in character and quality; and, moreover, *that it was produced by substantially the same process.*

Had defendant's witnesses been asked to institute a comparison between the prior leather and the patented product, very different answers might have been elicited.

2. It is always difficult to compare or contrast accurately the character or quality of articles seen at different points of time, and in different places and circumstances, with [illegible] opportunity of placing them side by side; and this difficulty is increased in the ratio of distance of time between the respective observations.

3, The condition of quality and fitness for gloves, so far as it effects the validity of the patent, is *relative* and not *absolute.*

It might be conceded that an article suitable for mittens and gloves, was produced by the use of fat liquor prior to the patent, without affecting its validity. Between such a point and complainant's process, there is ample scope for invention and a valid patent.

If the patented process is an *improvement,* either in the *quality of leather produced,* or in the *facility and cost of production,* the patent is valid and should be sustained.

This point, the defendants have carefully and wisely shunned.

4. It has been seen in the testimony of Plummer and others, how convenient, facile, accommodating and deceptive, is the stereotyped formula of this defence, "soft and pliable and suitable for gloves." It represented anything, condition or quality known to the trade in all the past, according to the judgment, prejudice, interest, caprice, or conscience of the of the witnesses; respectively.

Second. It is said that in order to defeat the patent on the ground of want of novelty, it is not necessary that the quality of prior leather, relied upon for the purpose, should have equalled the product of the patented process.

Not, perhaps, if it be shown that such prior leather was produced by a process substantially like complainant's; but right here lurks the fallacy of the proposition. Defendants ask to have the *process of treatment* inferred from the *product*, and in this view, *qualiiy* is material. If this line of defence has any force at all, it is weakened in proportion to the inferiority of the prior leather relied upon.

Complainant, however, insists that the mere fact of the existence of leather prior to the patent, similar in character and quality to the product of the patented treatment, is entirely inconclusive, and scarcely worthy of notice; for, such leather may have been pre-

pared in any of the numerous methods shown to have been practised. The real question is not, did such leather exist but, "how was it prepared for gloves.

Third. It is also said that complainant's evidence on the point of prior use, is negative and hence of no value.

This is a mistake. True, much of it is negattve in *form*, but in *effect* it is positive and forcible. The value of this class of evidence will be referred to under another point.

Fourth. A slight attempt was made by defendants to account for the great increase in the use of prepared bark-tanned leather since 1876, from some other cause than complainant's improvement. One witness, Daniel B. Judson, and one only of their army of witneases, was questioned on this point.

He was asked if there was not a time from 1857 to 1869, when but few such skins were made into gloves, and the reason why. In his answer, he said there were but few "*comparitively with the time since* 1869." This is just what complainant says and proves; and he covers a period extending from 1869 far back of 1857.

As to the reason Mr. Judson says his "*impression* is that one reason for a *portion* of the time was the low price of deer skins and fleshers." Another reason was the increase of the glove business since 1868; and a third, the improvement in the dressing of leather. He adds, "I only give my own experience."

(P. p. 260 and 261, fol. 308.)

The witness does the best he can, conscientiously, for defendants; but their effort to break the force of the strong evidence against them on this point, is painfully feeble.

1. If any fact or state of things existed prior to 1869, different from what existed thereafter that would satisfactorily account for the great increase in the use of this class of leather immediately after the publication of complainant's patent, upon any other ~~thereof~~ than its novelty and utility, it could have been easily shown. Instead of one, defendants would have produced hosts of witnesses on the point.

/ theory

2. Judson's first reason fails on cross-examination; where he admits that all kinds of stock for the manufacture of gloves appreciated in price after the commencement of the war, deer skins more than sheep skins; and that they had never gone back to the old price.

(P. 261, fol. 308.)

This embraces about eight of the years between 1857 and 1869.

3. His second reason is no better. It is agreed on all hands that there had been a steady and constant increase in the glove business from a time back of 1857; and that this increase created a demand for material which sent manufacturers all over the world for a supply, before complainant's patent saw the light.

This demand led to the numerous attempts to utilize bark-tanned skins disclosed by the testimony for defence, which covered the entire period from 1857 to 1869.

Nor has any special increase in the manufacture since 1868 been shown. On the contrary, defendants have attempted to account for the use of skins in the bark-tanned state, by reason of the great and exceptional demand for gloves in the early part of the war. It is not, perhaps, directly shown by the testimony, but it is fair to presume that any exceptional increase caused by the war, ceased with the cause.

4. The third and last reason given by witness, the "improvement in the dressing of leather," is the true one, though not what defendants sought by the question.

It is true that there has been an improvement in the dressing of leather; but it is confined mainly to complainant's patented improvement as practised by him, his licensees, and infringers.

It is shown by Lewis P. Johnson, a oil dresser, that there has been no improvement in his department for the last ten years.

(P. 346, fol. 404; p. 347, fol. 406.)

There is no suggestion of an improvement in any other department of leather dressing than the two now named. It follows, therefore, that the

improvement in dressing referred to by Mr. Judson, which has increased the use of bark-tanned skins, is complainant's improvement; and this is in harmony with the whole drift of the testimony.

5. Even if there were improvements in other departments of leather dressing, it would not account for the increase in the use of bark-tanned sheep and lamb skins.

Indeed, such improvements would tend to *decrease* the demand for bark-tans by increasing the demand for the other classes of leather.

The only explanation left for the great increase in the use of the bark-tans since 1869, is complainant's improvement.

Fifth. The learned counsel for defendants, on the argument in the court below, attempted to account for the increase in the use of bark-tanned leather since 1869, by ingenious speculation, and a series of aphorisms on the "laws of trade," the "law of demand and supply," the "varying fancies of style and fashion," and other fancies.

This might all be very appropriate and instructive in a lecture on the science of political economy; but its pertinency in this discussion is not

so apparent. These cases are to be decided upon the *proofs* and the *law*. So far as the "laws of trade," of "supply and demand," or the demands of fashion have any legitimate bearing upon the point in question, they were matter for *proof*, and not of *speculation*. All the proofs on the subject sustain complainant's theory.

RULES OF LAW APPLICABLE.

First. On the question of a prior invention or use, the burden of proof is with defendants.

Washburne v. Gould, 3 St. 142.
Pitt v. Hall, 2 Bl. C. C. 231.

Second. To constitute such a prior invention or use as to invalidate a patent, the person alleged to have made or used it must have proceeded so far as to have entitled himself to a patent, in case he had made an application, and had been in other respects entitled to it.

Mere trials and experiments without obtaining the object for which the patent was taken out, without perfecting the invention, and giving it in complete, intelligent and practicable form to the world, will not defeat a patent subsequently obtained, although there "was the merest possible distance" between the point reached by such experiments, and success.

The abandonment of such experiments, or of the alleged prior use, before the date of the patent, affords a presumption that they rested in experiment and trial alone, the invention not having been perfected.

Curtis on patents, (4 ed.) §§ 87, 87a.
The Househill Co. v. Neilson, Webs. Pat., Case 708.
Galloway v. Bleaden, Webs. Pat., Case 526-2,
Hitchcock v. Tremain, 8 Bl. C. C. 440.
Hoffman v. Aronson, 8 Bl. C. C. 324, 330.
Hall v. Bird, 6 Bl. C. C. 438.
Agowon Co. v. Jordan, 7 Wall. 538.
Seymour v. Osborne, 11 Wall. 516.
Whitely v. Swayne, 7 Wall. 685.

Third. A very slight change or advance, will constitute a patentable improvement.

Its patentability does not depend upon the amount of thought, skill, ingenuity, labor or experiment on the part of the inventor, or whether it was discovered by accident.

And a new and useful *result* implies invention.

Curtis on Patents, (4 ed.) §§ 31, 32, 36, 41.
Forbush v. Cook, 2 Fish., 672.
Crane v. Price, 5 Scott, N. R. 339.

Fourth. On the question of prior use, evidence of a negative character is justly held to have great significance and value.

The patentee can only call persons who were in the way of knowing of the invention, if it had existed before, to testify that they had not known of it.

And the better the opportunity of those persons for knowing of the invention, if it had existed before, the stronger will be their evidence.

Curtis on Patents, (4 ed.) §§ 473-4.

ALLEGED INVALIDITY OF THE RE-ISSUED PATENT.

The answer of defendants alleges that the re-issue covers ground not embraced in the original patent, and claims improvements not made by the patentee; and further, that the surrender was made with the fraudulent intention of deceiving and misleading the public.

(P. 7, fol. 7.)

On the hearing, two witnesses, John W. Place and Charles B. Wessells, were called by defendants to show that Fulton was in the mill of Isaac V. Place between the issue and re-issue of the patent, and saw his men treating skins with warm fat liquor.

(P. p. 261-2, fols. 309-10; p. p. 265-6, fol. 313.)

It is argued from the original specification in connection with this evidence, that complainant did not originally intend to cover warm fat liquor alone, that Fulton imparted to him what he saw at Place's mill, and thereupon complainant made a surrender and obtained a re-issue covering what he had not invented.

To this defence there are two conclusive answers:

First. This question was settled in the case of Klein v. Russell, (19 Wall. 433,) and will not be re-opened:

The invalidity is claimed to arise from the alleged fact, that complainant did not originally patent the use of *fat liquor alone,* but only the compound embraced in the second claim of the re-issued patent; that the claim for fat liquor alone in the re-issue is for a new invention.

The same point was made and passed upon in the Klein case. See points of counsel for plaintiff in error. (P. 447.)

The court held, in substance and effect, that the original specifications did cover fat liquor alone, but that the claim was defective; and that the re-issue was for the same invention.

In speaking of the original specification and claim, (p. 465,) the court say,—"With this specification and claim, it was apprehended that the patent did not cover the use of heated fat liquor *alone*—which the patentee claimedas part of his invention—but that it would be held to cover the use of such heated liquor only in combination with the ingredients specified. If so, the omission of any one, or all, of the ingredients would have given immunity to an infringer. To remedy this defect the re-issue was procured."

surrendering

It is clear, therefore, that the question of law involved was settled by this court in the Klein case. That decision ought, also, to be held decisive of the whole question, *fact* as well as *law*. The alleged fraud, consists in ~~surrounding~~ the first patent for the purpose of procuring a re-issue covering fat liquor alone, which was no part of the invention.

The decision negatives this charge conclusively, by holding that the invention did embrace fat liquor alone,

Second. This objection to the patent never had any foundation, either in law or in fact.

1. The power and duty of granting a new patent for the original invention, upon a surrender of the old, is confided to the Commissioner of patents; and his decision is not re-examinable by the courts, unless it is apparent upon the face of the patent that he has exceeded his authority, or unless there is a clear repugnancey between the old and the new patent, or unless the new has been obtained by fraud and collusion between the Commissioner and the patentee. The presumption upon all the points is in favor of regularity and validity of the re-issue.

Potter v. Holland, 4 Bl. C. C. 242.
Battin v. Taggert, 17 H. 84.
O'Reily v. Morse, 15 H. 112.
Hussey v. McCormick, 1 Fish. 515.
Klein v. Russell, 19 Wall. 433, 436.

3. There is no proof of the existence of any the conditions invalidating a re-issue. Fraud cannot be presumed, and ought not to be attributed without very clear evidence, especially where the effect would be to destroy a valuable patent.

4. From the fact that Fulton went to the mill of Place, and there saw his workmen treating skins with warm fat liquor alone, the court is asked to infer that he communicated it to complainant, and that the latter thereupon proceeded to surrender and and obtain a re-issue for the purpose of covering this treatment, which he had never before understood,or thought of patenting.

   This proposition, too absurd in itself to merit consideration. is fully met by the testimony of Fulton, who says that he went to Place's mill to see if he was infringing Russell's patent; and that he was examined as a witness in the suit against the Places at Albany, where he testified to these visits.

   He further testifies that complainant made no change in the process or mode of treatment after his first application in 1869, and before the re-issue in 1870.

   (P. 275, fols. 324 and 5; p. 282, fol. 332.)

5. It was urged for defendants on the argument in court below, that variations in the re-issue from the description in the former specification, imply

that the re-issue is for a new or different invention.

This position is manifestly unsound; for the right to surrender is given for the very purpose of enabling the patentee to give a more perfect description, and the second necessarily varies from the first.

The defect entitling the patentee to a re-issue may be in the specification, the claim, or both.

O'Reily v. Morse, 15 H. 112.
Battin v. Taggert, 17 H 84.
Cower v. Braintree Manf. Co., 2 St. 439. 440.

OTHER ALLEGED DEFECTS IN THE PATENT.

On the argument in the court below, defendants attacked the patent, on the ground, that the specification does not describe the invention in such "full, clear, and exact terms," "as to enable any person skilled in the art or science to which it pertains," to use the same.

The particulars in which these alleged defects are supposed to exist, are: 1. That the specification advises the heating of the liquor "to or near the boiling point," at which temperature it would injure the skin.

2. That it does not fix the degree to which the liquor should be heated. 3. The proportion of the elements are indefinite.

These specifications embrace, it is believed, all the criticisms, albeit various changes were rung upon them in the argument.

First. These objections are old, familiar acquaintances. They have been met at every stage of the litigation under this patent, and as often successfully answered. They came up in the Place trial, and were disposed of by Judge Woodruff; on the Klein trial, and were overruled by Judge Hall; and subsequently by Judge Woodruff on the motions for a new trial in those actions; and finally on writ of error in the Klein case, and were conclusively settled by this court.

By reference to the case of Klein v. Russell, (19 Wall., 433,) it will be seen that these questions were up and disposed of.

Second. The rule of construction applicable is, that patents are to be construed liberally in favor of the patentee; so construed, if possible, as to make the claim co-extensive with the actual invention or discovery, and give the patentee the benefit of it.

Curtis on Patents, (4 Ed.) § § 225, 231.
Ames v. Howard, 1 Sum. 485, 6, 7.
Corning v. Burden, 15 H. 269, 270.
Pitts v. Whitman, 2 St., 621.
Klein v. Russell, 19 Wall. 433, 466.

Third. Nobody has had any trouble in applying the invention.

The patentee, his ~~licensees~~ licensees and workmen, and the *various infringers* have all used the process successfully.

Fourth. The specification does not, as erroneously assumed, require the application of the liquor to the skin at or near the boiling point.

This was the construction given by Judge Woodruff.

(P. 23, fol. 50.)

Such, also, was Judge Hall's construction in the Klein Case, which was subsequently approved by this court.

Any person of common sense would know that such an application would injure the skin, and wait for the liquor to cool before using it.

Mr. Dodge testifies that he tried the experiment on one skin of applying the liquor when it was near the boiling point, and found the effect injurious, just as he expected. His language is, "*I knowed that afore I put 'em in.*"

(P. 222, fol. 170.)

Mr. Gillette, a person "skilled in the art," testifies that, from reading the specification any person of ordinary skill and experience in the preparation of leather

for gloves, could apply the process without difficulty, and so as to produce substantially such leather as complainant produces from it.

This stands uncontradicted, and is conclusive.

(P. 335, fols, 391 and 2.)
Curtis on Patents, (4 Ed.) § § 478, 480.

Fifth. There is nothing in the objection that the specification does not point out the exact degree to which the temperature of the liquor is to be raised.

If the patentee had so restricted his claim, either in the preparation or application of the liquor, his patent would have been utterly worthless; for any person might have taken all the benefits of the invention by varying the heat half a degree, without infringing the patent.

The same answer applies to the objection that the exact proportion of ingredients are not fixed by the specification. Had they been, the omission of one, or a slight and practically unimportant variation in quantity, "would have given immunity to an infringer."

Klein v. Russell, 19 Wall. 443, 465.
Wood v. Underhill, 5 H. 1.
Ryan v. Goodwin, 3 Sum. 514.

DOUBLE USE.

On the argument in the court below, the counsel for defendants strenuously insisted that the application of the patented process to bark-tanned skins is obnoxious to the objection of double use; and numerous authorities were cited to support the position.

The existence of this rule is well understood by every patent lawyer; but its application is often a matter of no small difficulty, requiring nice discrimination.

Curtis on Patents, (4 Ed.) § § 55,56.

In the cases at bar, however, no discussion of the law is necessary; the facts relieve the question from all difficulty in this regard.

First. The entire purpose and object of the application of fat liquor to bark-tanned skins, is different from its use in oil dressing and Indian tanning, as has already been shown. In the latter cases, the liquor is used to *tan* the raw skin, *to make it into leather;* in the former case, if is used to give new properties and qualities to *leather* which has *already been made* by another process from the raw skin.

One process is the treatment of *skins* to convert them into *leather;* the other process is the treatment of *leather* to convert it into a *new article* possessing *new properties and qualities.*

The testimony of the chemist, Dr. Porter, is explicit on this point.

(P. 393, fols. 457 and 8.)

And such, also, is the result of all the evidence bearing upon the point.

Second. The *effect* produced by the patented process on bark-tanned skins is different from that produced by fat liquor in oil dressing and Indian tanning.

This is also made clear by Dr. Porter's testimony, and other evidence in the case.

(*a.*) It is no answer to this position to say that the *general* effect is the same, to-wit, *to soften* the skins. This statement involves a fallacy. The *softening* effect in *tanning* a skin, is merely incidental; the object not being to *soften* but to *tan*, and a skin thus tanned is generally suitable for gloves without any supplemental treatment. But tanning with bark, while it makes *leather* does not make an article suitable for gloves; and it has to be supplemented by another process, giving it new properties and qualities, which process, in common parlance, is termed "sofening it."

(P. p. 392-3, fols. 457-8.)

The fallacy consists in the use of the terms "soft" and "softening"; while in one sense, speaking in a general way, the effect of the two appli-

cations is the same; in another, and the true sense, within the meaning of the patent law, the effect is not the same.

(*b.*) The fact that fat liquor was sometimes used to remedy defects in oil dressing, does not vary the matter; for, in such cases, it was used to *complete the tanning*, as a cheap substitute for remilling in oil.

(*c.*) It was said on the argument that, "the *effect* produced upon the leather or skin by either treatment, is not the subject of a patent."

To this it may be replied:

1. The *effect* or *result* is evidence of ~~materiality~~ utility and novelty, and sometimes the test of invention.

2. We are replying to defendants' criticism that there is no difference in the effect produced in the two applications of fat liquor.

Third. But this question is entirely set at rest by the fact that in the use of fat liquor in oil dressing and Indian tanning, the liquor was always applied in a *cold* state.

The use of *warm* fat liquor, therefore, according to the patented process, not only produces a *new effect*, but does it by a *new process*. Even if the object were *old*, the *contrivance to produce it* was *new*, and hence patentable.

Curtis pithily says, "There is a very material distinction between applying a new contrivance to an old object, and an old contrivance to a new object."

Curtis on Patents, (4 ed.) § 55.

ABANDONMENT TO THE PUBLIC.

A feeble attempt is made to show that complainant used his patented process more than two years prior to his application for a patent, and abandoned it to the public.

The testimony for defence bearing on this point, was elicited from Krause, Isaac V. Place, Uriel Case, and Samuel Dodge, Sen.; and, with the exception of Dodge's, relates to certain skins hanging on complainant's fence, and a few specimens of gloves seen in his possession. Dodge speaks of giving complainant some directions about the use of fat liquor, which has been sufficiently discussed under another head.

Dep. of Krause, p. 110, fols. 150-1.
" of Place, p. p. 159 and 160, fols. 204, 5 and 6.
" of Case, p. p. 160, 169 and 170.

First. It has already been seen, in examining the testimony of these witnesses on the question of prior use, that they had no sufficient knowledge of this leather to warrant them in speaking of its quality, even; and they had no knowledge whatever of the

manner in which it had been treated; if with fat liquor, whether it was used alone or with other ingredients, or whether applied in a *cold* or *warm* state, they did not know, and would not venture to guess.

(*a.*) Krause says, in substance, on cross-examination, that there had been various methods in use in Gloversville and vicinity, for softening bark-tanned skins, and that no man by looking at a glove made from such leather can tell how the leather was treated.

P. 115, fols. 155-6.)

(*b.*) Place says that he does not know how the skins were treated, or whether other ingredients were used with the fat liquor or not; and finally admits, substantially, that he knows but very little about the skins or gloves supposed to have been treated by complainant with fat liquor.

(P. 160, fol. 205; p. p. 164-5, fols. 209-10.)

(*c.*) Case will not swear that no other ingredients were used with the fat liquor; whether the skins had been subjected to more than one process or not; nor to any thing more than that fat liquor had been applied to them in some way.

(P. p. 174-5, fol. 220.)

Second. Bark-tanned sheep and lamb skins had been treated by the egg process and various other methods,

including *cold* fat liquor, prior to complainant's application for the patent; and all the witnesses concede, when pressed, that they cannot tell from inspection of the leather, by what process, or in what manner it had been treated.

Defendants' witness Monroe, who prefesses great knowledge and experience in the use of fat liquor, says that he cannot tell by inspection of the leather how it was treated, unless he treated it himself.

(P. 101. fol 140.)

Third. William H. Combes testifies that sometime in 1865 and 1867, he saw a few skins and gloves in complainant's possession which had been treated in some way; and which were, doubtless, the result of some of the experiments mentioned by Fulton.

(P. 352. fols. 411 and 12.)

But this leather was inferior in quality, value, and fitness for gloves to complainant's exhibits prepared by the patented process; and he is unable to tell how it was treated.

(P. 353 and 4. fol. 413.)

This tends to characterize the *quality* of leather seen in complainant's possession, mentioned by the other witnesses.

Fourth. Austin E. Porter speaks of leather which he saw hanging out at complainant's and Gillette's prior to 1869. He characterizes the different lots in the same ~~the same~~ manner, and speaks of them as being of the same quality; although he does not undertake to say that it was the same as that produced by the patented process, and does not know how any of it was treated.

(P. 368, fols. 424 and 30; p. p. 369 and 70, fol. 431)

Gillette testifies that his leather was imperfect, and greatly inferior to the product of the patented process.

(P. 321, fol. 375; p. 333, fol. 389.)

From this, in connection with Porter's testimony, it follows that the leather seen by the latter on complainant's fences, was of the same inferior quality.

Fifth. The witnesses for defence, who speak of seeing leather on complainant's fences prior to the patent, class it with, and characterize it by the same terms applied to Gillette's and others', which has been shown to be quite inferior to the patented product.

Sixth. It is shown by the testimony of Fulton, that complainant was experimenting with fat liquor and other things, but did not perfect his invention until a short time prior to his application for a patent; and that the leather produced by these experiments was

gaeatly inferior in quality to that produced by the perfected process.

(P. p. 32, 3, and 4, fols. 63, 4, 15 ; p. p. 37 and 8, fols. 68 and 69.)

This sufficiently accounts for any leather or gloves seen in complainant's possession prior to his application for a patent, without inferrring from such possession the abandonment of an invention which he was diligently and persistently endeavoring to perfect.

Seventh. The fact that complainant did not offer himself as a witness on this point, and explain about this leather in his possession, is made the subject of adverse criticism.

It is respectfully submitted that this is unjust. There was nothing calling for explanation ; and, if the little testimony for defence on the suject needed explanation there was abundance in the case explanatory of it without thrusting complaining forward as a witness in his own case. No right minded man will make himself a witness in his own case, except from necessity.

Besides, had he been examined as a witness, he could have added nothing to Fulton's testimony on the point. He could have said, only, that he had been experimenting for a long time with fat liquor ; had produced an inferior quality of leather and made it into gloves ; but that he had not reached satisfactory results till a short time prior to his application for a patent.

Eighth. The experimental use of an invention, for the purpose of perfecting it, for more than two years prior to the application for a patent, does not constitute a dedication to the public, or invalidate the patent.

Curtis on Patents, (4 Ed.)§§ 389, 389*a*.
Wyeth v. Stone, 1 St., 273.
McCormick v. Seymour, Law's Dig., (Ed. of 1870.) p. 314.

Ninth. Abandonment or dedication is in the nature of the forfeiture of a right, which the law does not favor, and must be established beyond all reasonable doubt to render it available as a defence.

Pitts v. Hall, 2 Bl. C. C. 238.
McCormick v. Seymour, 2 Bl. C. C., 256.

Tenth. The manufacture and sale of goods from leather produced by complainant's process would not, of itself, amount to an abandonment; for it would not disclose the process or treatment by which the leather is prepared.

The invention consists in the *process of preparing the leather;* and all the evidence shows that goods made from such leather might be sold to an unlimited extent without disclosing the process.

There is no evidence in the case that even tends to show that complainant made his experiments, or the process of preparing his leather, public.

Goodyear v. Day, Mr. Grier, J.; N. J.
Found in Law's Digest. (Ed. 1870.) p. 302.)

This was the case of vulcanized rubber, which did not, on its face, disclose the nature of the compound, or the mode of producing it; and the court held that the sale of the article did not constitute an abandonment.

Dodge, Place, and Hull testify, in substance, that there is no benefit in heating the liquor; and that *in a cold*, it is just as efficacious as in a *warm* state, and to sustain this position, Dodge introduces a skin which he testifies to having treated with cold fat liquor.

(P. 205, fol. 254; P. 152, fol. 196; p. 123, fol. 165; p. p. 208 and 4, fols. 251 and 2.)

~~WHAT~~ OF UTILITY.

The defendants claim that there is no benefit in heating the liquor; and that, if the construction of the patent limits the process to *warm* fat liquor, then it is void for want of utility.

First. Under the allegation of prior use, defendants undertook to show that warm fat liquor had been used more than two years prior to application for the patent.

To this complainant replied, that in all such use shown, the heating was merely *casual*, for the convenience of the operator or other temporary reason, and not from an intelligent appreciation of the benefits of heating. That heating the liquor and using it in a warm

state, was never so understood and adopted by any body as to give the process to the public, *with a knowledge of its benefits;* for, had it been, the use of fat liquor would not have fluctuated between warm and cold; as it did, being mostly used cold; and, moreover, it would have come into general use among manufacturers, as it did at once on publication of the patent.

This position is fortified by the fact that defendants and their leading witnesses still insist that there is no utility in heating. If heating *is* beneficial, it certainly was not understood by the public; for had it been, these witnesses selected by defendants as most familiar, with the use of fat liquor, would not now come forward and claim that *cold* is beneficial as *warm*.

Second. If defendants had acted upon the theory that there is no benefit in heating the liquor, the patentee would not have complained of them; but since the patent, they seem to have believed in *warm* fat liquor, for thus they have uniformly used it.

Dodge testifies that he has applied the liquor in a warm state since 1869, except in case of some of the exhibits prepared expressly for this trial.

(P. 222, fol. 270.)

So have Place, and other infringers. Why have these parties used it thus *since*, if they understood the benefits of heating *before* the patent? And why do they now always take the trouble to heat the liquor, if its application in a cold state is just as efficacious?

Third. But, there is a decided benefit in heating the liquor, and applying it in a warm state, both in its effects upon the emulsion and the leather.

Dr. Porter so testifies, both from experiment and science.

(P. 392, fol. 457; p. 393 and 4, fol. 458.)

Mr. Gillette so testifies, also, from practical knowledge and experience.

(P. p. 335 and 6, fol. 392; p. 337, fol. 394; p. 338, fol 395.)

The uniform practice of heating the liquor since the patent, by defendants and all who use the process, puts the question of utility beyond dispute.

Fourth. Mr. Dodge introduces some exhibits which, he says, were treated with cold fat liquor.

(P. p. 203 and 4, fols. 251 and 2.)

These exhibits, together with those treated with warm fat liquor, were prepared by him about two weeks prior to his examination; yet, on cross-examination, he was unable to state whether or not he had added cold water to the warm fat liquor used, or what he had stated on the direct, and was confused generally in regard to the matter.

(P, p. 228 and 229, fols. 275 and 6.)

But he makes it quite clear, however, that his cold liquor treatment is far inferior to the patented process.

It will be seen by reference to his testimony, that he subjected these exhibits twice to the liquor, pounded them during each immersion with a heavy hard-wood pounder made for the purpose, and subjected them to various other processes, the whole of which occupied a week.

(P. p. 227 and 8, fols. 274 and 5.)

It appears, also, that the skins so treated by him were number one in quality.

(P. 205, fol. 253.)

There is no doubt, but with a selected skin of prime quality, peculiarly adapted to the purpose, cold fat liquor repeatedly applied, combined with other tedious and expensive processes, will produce a very good article of leather.

But, between Dodge's treatment of exhibits 3 and 4 and complainant's process, there is a wide margin for a valid patent on the latter, even though the former shows an article of equal value for gloves.

(a.) It is proper to notice in this connection, that complainant's exhibits, before treatment, were not above the average quality of skins in the bark-tanned state, were treated in the same manner that he treats all his skins under the patent, and

after treatment present fair specimens of the improved leather.

(P. p. 282-3, fols. 333-4; p. 315, fol. 369.)

IX.

The Circuit Court erred in holding and deciding that the trial and judgment in the action at law, between this complainant as plaintiff, and the defendants Place as defendants, was not a bar, or conclusive evidence in this suit, upon the issues involved and litigated in said action, covering the questions touching the validity of the patent.

(Record in No. 134, p. 418.)

The same defences of want of novelty, &c., involved in this suit, were set up and litigated in the former action.

(No. 134, p. p. 19, 20 and 25.)

First. The well established doctrine is, that the judgment or decree of a court possessing competent jurisdiction, is, as a general rule, final not only as to the subject matter thereby actually determined, but as to every other matter which the parties might have litigated in the cause, and might have had decided.

If there are exceptions to this rule in special cases, the suit at bar does not come within them.

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Gould v. The Evansville & Crawford R. R. Co., decided by this court in March, 1876. See 13, Albany Law Journal, No. 13, p. 214.
Embury v. Connor, 3 N. Y., 512, 522.
Sickles v. Mitchell, 3 Bl. C. C. 552.
Sickles v. Young, 3 Bl. C. C., 297.
Parker v. Brant, 1 Fish 51.
Birkhead v. Brown, 5 Sandf. 134.
Dows v. McMichael, 6 Paige, 139, 145.

(*a.*) In Gould v. The Evansville & Crawfordsville Railroad Co., cited *supra*, the court say:—"Where the parties and the cause of action are the same, the *prima facie* presumption is that the questions presented for decision were the same, unless it appears that the merits of the controversy were not involved in the issue, the rule in such case being, that where every objection urged in the second suit was open to the party, within the legitimate scope of the pleadings, in the first suit, and might have been presented in that trial, the matter must be considered as having passed *in rem judicatum*, and the former judgment in such a case is conclusive between the parties."

Second. In the Court below it was claimed that the record is not conclusive for two reasons:

1. That in the trial of the action at law before Judge Woodruff, the question of infringement under either or both claims of the patent was open; and that it does

not appear under which claim the patent was infringed, and the judgment rendered.

2. That two constructions had been given to the patent; one by Judge Woodruff limiting it to *warm* fat liquor, and the other by Judge Hall, extending it to fat liquor in any condition, either warm or cold. That a verdict based upon one construction, would not involve and decide the same questions, as one based upon the other construction; and that it does not appear upon which construction the issue of novelty was tried before Judge Woodruff.

To this view of the question, it seems, the court yielded.

(No. 134, p. 418, fol. 480.)

It is respectfully submitted that, for several reasons, these views are untenable.

1. The issue of want of novelty, made by the pleadings, covered both constructions, and both claims of the patent. The plaintiff's *title*, the *validity* of the patent, was in issue upon *both* claims, under *either* construction of the patent, and it was adjudged valid.

This comes clearly within the rule governing the question of estoppel by record, just stated, and illustrated by the authorities cited.

If there are exceptions to this rule in special cases, the suit at bar does not come within them.

1 Otto 526

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This comes clearly within the rule governing the question of estoppel by record, just stated, and illustrated by the authorities cited.

2. It is erroneous to assume that a verdict based upon one construction, would not involve and decide the same question, as one based upon the other construction.

Either construction involves the question of *novelty*, and therefore both involve the *same* question, to wit, the *validity* of *the patent*.

True, there may be certain subordinate questions differing with the different constructions, involved ~~with~~ the principal and ultimate question; but the main and ultimate question is the one to be considered in applying the rule.

Suppose that on the trial before Judge Woodruff, the infringement proved had been under the *second* claim, only; still defendants could have attacked the patent under the issues, by showing want of novelty in the *first* claim; and this defence would have prevailed, unless plaintiff had shown in reply, under the provision of the act of 1837, that said claim was not thus made too broad willfully and knowingly, and with intent to defraud and deceive the public.

Thus it appears that the validity of the patent was involved in the issues, without regard to the questions, which construction was given, or which claim infringed.

3. It is a mistake to suppose that it does not appear under which claim the patent was infringed, or upon which construction the issue of novelty was tried, in the former action.

The infringement there proved was under the the first claim, and the cause was tried under Judge Woodruff's construction, limiting the patent to *warm* fat liquor.

This appears clearly from the opinion of Judge Woodruff on the motion for a new trial.

(No. 134, p. 25.)

After speaking of the fact that his construction of the patent was in accordance with the request of defendants, he says:—"Whether correct or not, it did not prejudice them, but narrowed the plaintiffs chance of recovery, and drove him to satisfy the jury that the defendants have injured the patent under that construction."

That is to say, by the construction limiting the patent to *warm* fat liquor, plaintiff was driven to prove an infringement under the first claim as thus construed. There was never any question but what the compound in the second claim required heating.

(See Klein v. Russell, 19 Wall. 433.)

In speaking of the finding of the jury, he says:—"they have found that the employment of the heated fat liquor in the treatment of skins, substantially as described in the patent, was not in public use, or known, before the invention of the plaintiff, and that in fact he was the first inventor."

Again he says:—"Undoubtedly fat liquor had been employed before to soften leather, and experiments had been made with that, and with that in connection with other means to make bark-tanned skins suitable for gloves, etc., but there was much foundation for the inference that the results were wholly imperfect and unsatisfactory, and that until the plaintiff succeeded, the art was substantially unknown."

(*a.*) The opinion of the court may be resorted to as evidence of the question involved, and the grounds of the judgment.

Birckhead v. Brown, 5 Sandf. 134, 151.

4. In the exceptional cases, where evidence is admissible to show what issues were tried and decided, where a given question is fairly embraced in the proceedings, the presumption is that it was litigated and decided; and the burden is on the party resisting the estoppel, to show the contrary by parol proof or other competent evidence.

Burwell v. Knight, 5 Barb. 267, 270.
Wood v. Jackson, 8 Wend. 9.
Gould v. The Evansville and Crawfordsville R. R. Co., *supra.*

The same doctrine is clearly implied in some of the cases cited by defendants' counsel in the court below; in which the party resisting the estoppel assumed the burden of proof, and the question mooted was, its admissibility.

McDonald v. Langdon, 3 Gray, 513.
Burton v. Shannon, 99 Mass., 202.

Third. The point was made in the court below, that complainant could not avail himself of the former judgment because it was not pleaded.

This point was not well taken.

1. The former judgment is pleaded in this suit. It is set up in the bill of complaint; and in equity, this is the proper and only mode of pleading it.

   Griffith v. Clinton Line Extension Railroad Co.
   1 Western Law Monthly, p. 31.
   Blandy v. Griffith, 3 Fish., 609.

2. Special replications are not now in use. If the former adjudication had not been set up in the bill of complaint, and defendants' interposing the defence of want of ~~morality~~ merits, this court, under its rules and practice, would have allowed an amendment of the complaint setting up such adjudication, provided it were necessary to render the proof admissible in evidence.

   Equity Rule No. 45.
   Story's Eq. Pl. Sec. 878.
   Dupont's v. Mussey, 4 Wall. C. C. 128

3. But, it is submitted that the record would have been admissible in evidence without being pleaded.

Dows v. McMichael, 6 Paige, 139.
Wright v. Butler, 6 Wend. 284.

(*a.*) In Dow v. McMichael, (p, 145), in discussing the question of the admissibility and effect of the record of a former judgment *as evidence*, when not specially pleaded, the Chancellor says: "The record in this case is not given in evidence for the purpose of establishing the fact of a recovery in the former suit, which was not put in issue by the replication. But the decision of the same question in a former suit against the defendant is given in evidence for the purpose of establishing conclusively, that the allegation in the defendants' plea in this suit cannot be true.

(*b.*) The special matters which, under the provisions of the patent law, a defendant may give notice of, with the general issue, and prove on the trial, go to plaintiff's *title*, the *validity* of the patent.

They have precisely the same effect, no other or different, no greater or less, than several matters of defence available under the general issue, without notice. The object of the notice is to prevent surprise at the trial; and, in case of alleged prior use, to give plaintiff an opportunity for investigation.

It is provided by the act of 1870, that "like defences may be pleaded in a suit in equity; and proofs of the same may be given upon like notice in the answer of defendant, and with like effect."

Act of 1870, Sec. 61.

From this it appears, that the notice in an answer in equity is the same in object and effect, as a notice with the general issue, in an action at law.

As no replication is requisite or proper in the latter case, it is a fair inference that none is required in the former.

If, in an action at law, the plaintiff could put in evidence a former adjudication, without pleading it, he can do the same in a suit in equity.

X.

The Circuit Court erred in allowing the following questions, put by defendants to their witness, William H. Monroe, under objection, viz:—

1, "State, if you know, whether or not the application of fat liquor to bark-tanned sheep and lamb skins has been used as a process to render such skins soft and pliable and to remove the squeak from them; and if so, for what length of time, and by whom?"

(P. 86, fol. 126.)

2. "State whether or not the use of fat liquor upon bark-tanned sheep and lamb skins has been understood and adopted by you in the manner stated by you, as a process for rendering such skins soft and pliable and removing the squeak therefrom, for any number of years; and if so, for how many years?"

(P. 87, fol. 127.)

3. "State, if you know, whether the application of fat liquor to bark-tanned sheep and lamb skins has been a well known and perfected process for softening such skins and making them pliable and removing the squeak from them; and if so, for how long a time have you known and understood such process?"

(P. 87, fol. 127.)

These questions, similar in character, are all clearly leading; and each calls for the *opinion* or *conclusion* of the witness, instead of *facts;* and this, too, upon matters which go to the very pith and essence of the controversy. With just as much propriety might defendants have put in evidence directly, the opinion of this witness upon the merits of the case, and thus have relieved the court from the labor of examination, and the exercise of its judgment.

XI.

The Circuit Court erred in allowing the following questions, put by defendants to their witness, Henry Hull, under objection, viz:—

1. "State whether or not, in the use of fat liquor by you since 1869, you used it in substantially the same manner as you did that used by you prior to 1869?"

(P. 129, fol. 171.)

2. "State, if you know, whether or not it produced substantially the same effect upon the skins?"

(P. 129, fol. 171.)

These questions are subject to the same objections as those just considered, addressed to Monroe; although, perhaps, not quite so marked in their objectionable feature.

The examination of these cases required some nice discriminations in regard to treatment and the effect produced, as a slight variation might cross the boundary line between the patented process and something short of it.

Hence, it became important to restrict witnesses to a statement of *facts* instead of *conclusions*.

These questions called for the conclusion of the witness as to treatment and effect, by comparison from memory. He should have been asked to state his manner of treatment, and its effects, leaving the court to draw conclusions as to similarity or dissimilarity.

XII.

The Circuit Court erred in allowing the following questions, put by defendants to their witness, Uriel Case, under objection, viz:—

1. "State, if you know, whether or not Russell, the plaintiff, has, ever since he moved from Fulton street on Bleecker street, used in his business the same kind of skins, treated in the same manner as those you saw on the fences, heretofore mentioned by you in your testimony in this case?"

(P. 169, fol. 215.)

2. "State, if you know, whether the plaintiff, Russell, about the time of the commencement of the war and prior thereto, manfactured gloves, extensively or otherwise, from the kind of skins you saw on the fences on Fulton street, as detailed by you, and treated as those were?"

(P. 170, fols. 215-16.)

This witness had casually seen some skins hanging on Russell's fence, which he guessed had been treated with fat liquor in some manner; but he did not see them treated, and had no knowledge of the manner of their treatment except what he judged from inspection. Now, he is asked leading questions, calling for his conclusions in regard to other skins seen in Russell's possession, of which he knows nothing except from casual observation; which questions embrace the kind of

skins, the manner in which they were treated, the length of time covered by Russell's use of them, the extent to which he manufactured gloves from them, and their likeness in kind and manner of treatment to the skins seen by him on Russell's fence many years before.

It cannot be denied that this mode of examination is highly objectionable, and very dangerous.

XIII.

The Circuit Court erred in allowing the following questions, put to the witness, Charles G. Tinsley, under objections, viz:—

1. "In your answer, on your direct examination, to interrogatory No. 21, did you give the question asked the witness and his answer thereto in full? And if you did not, please do so, together with the four following questions and answers?"

(P. 298, fol. 350.)

2. "Please give the next four questions and answers following the answer given by you on your direct interrogatory No. 54?"

(P. 299, fol. 356.)

This witness was the official stenographic reporter on the trial of the Klein case, and was called in this to show contradictory and inconsistent statements made by some of defendants' witnesses on the respective trials.

The complaint is, that on cross-examination he was permitted to state testimony of these witnesses given on the former trial, not connected with, or necessary to explain the contradictory statements drawn out by complainant.

Defendants were thus enabled to put in evidence affirmatively on this, what their witnesses testified to on the former trial, and also to give their own independent declarations in evidence.

This is manifestly erroneous.

XIV.

The Circuit Court erred in denying complainant's motion to strike from the testimony of the witness, Nathaniel Bentley, that portion which related to a conversation between his brother and John Fulton, not heard by witness, and to which he testified from hearsay.

(P. 140, fol. 184.)

This witness was called by defendants to show that a certain lot of skins treated for him by Russell & Co. did not turn out well; and thus, it is supposed, to strike, by implication, at the utility of the patent.

On his direct examination, he related a conversation that took place between his brother and John Fulton, of the firm of Russell & Co. But, on the cross-examination, it transpired that the witness did not hear the

conversation to which he had been testifying; that he had been repeating what his brother told him.

Thereupon, complainant's counsel moved to strike out this hearsay testimony, and the motion should have been granted.

XV

The Circuit Court erroneously permitted the witnesses, Nathaniel Bentley and Sidney S. Plummer to testify to the comparitive condition and quality of skins treated for them by complainant and defendants, Dodge, respectively.

(Dep. of Bentley, p. p. 140, 141 and 145.)
(Dep. of Plummer, p. 148, fol. 192.)

From the testimony of these witnesses, it appears that complainant's firm had, on a single occasion, treated for each a lot of skins; and also that defendants, Dodge, had treated skins for them; but how any of these lots were treated they did not know, nor was it shown by any testimony in the case.

Yet, these witnesses were permitted to speak of the relative condition and quality of the leather treated by the respective firms. This, it is insisted, was erroneous, so long as the mode of treatment did not appear.

XVI.

The Circuit Court erroneously denied complainant's motion to strike out the testimony of defendants' witness, James F. Place.

(P. 249. fol. 296.)

This witness was called to sustain the defence of want of novelty, but his name was not in defendants' answer. Owing to the large list of witnesses named in the answer—over seventy,—the omission of this witness' name was overlooked by complainant's counsel until the close of his direct examination.

Then, a motion was made to strike out his testimony; which motion, it is respectfully submitted, ought to have been granted.

The decrees of the Circuit Court, dismissing the bills of complaint, should be reversed, and judgment given for complainant for three times the amount of his actual damages, together with costs; and also for a perpetual injunction.

By section 24 of the Judiciary Act of September 24, 1789, it is provided that when a judgment or decree is reversed in the Supreme Court, that court shall proceed to render such judgment or pass such decree as the court below should have passed; except where the reversal is in favor of the plaintiff or petitioner in the original suit, and the damages to be assessed, or matter to be decreed, are uncertain.

In the cases at bar, the testimony furnishes all that is requisite for the assessment of damages; and it is so collated and presented in the brief, under the head of "damages," that the court will find no difficulty in readily arriving at a satisfactory result.

The cases have been long delayed, and have made complainant much cost and trouble; delay is gain to the defendants, but irreparable loss to complainant; he respectfully prays, therefore, that the cases may not be remanded to the court below, for further proceedings there, but that he may have justice and judgment in this court.

By section 55 of the Act of July 8, 1870, (16 U. S. Stat. at large, 206.) it is provided, in substance, that in suits in equity, the court may assess complainants' damages, and shall have the same power to increase the damages in its discretion, as is given by the act to increase the damages found by verdicts in actions upon the case.

The cases at bar, it is respectfully submitted, appeal strongly to the discretion of the court for an increase of the actual damages.

The patent is shown to be a valuable one to the community, and to complainant if he were permitted to enjoy it; a powerful combination to break it down has existed from its first publication, of which these defendants were the organizers, and have been active

supporters; complainant has had to contend with this combined opposition through a tedious and expensive litigation; by two verdicts and judgments he has sustained the validity of his patent; these defendants have infringed knowingly, willfully, and persistently; and now, they ought to make complainant all the indemnity which the court has power to decree, and which, at the best, will be small compared with the injury sustained.

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for Appellant.